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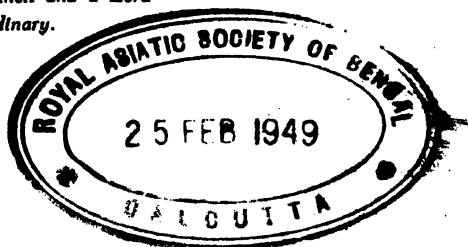
*To Mr. J. A. Edgley Esq*  
*Legal Remembrance of Bengal*  
*with the compliments of*  
THE *the Author:*  
LAW OF PATENTS *Edgley*  
IN INDIA

IN RELATION TO INVENTIONS

WITH COMMENTARIES ON THE INDIAN PATENTS  
AND DESIGNS ACT, 1911 (ACT 2 OF 1911) AND  
ON THE INDIAN PATENTS AND DESIGNS  
RULES, 1933 AND INDIAN SECRET  
PATENT RULES ETC. ETC.

BY  
E. CHARLES ORMOND,  
*of Gray's Inn, Barrister-at-Law and an Advocate*  
*of the Calcutta High Court*

WITH A FOREWORD  
BY  
THE RIGHT HON'BLE LORD ATKIN,  
*of His Majesty's Privy Council and a Lord*  
*of Appeal in Ordinary.*



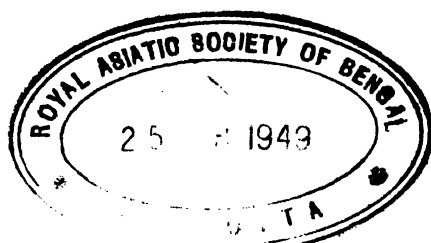
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## FOREWORD

BY

THE RIGHT HONOURABLE LORD ATKIN,

*of His Majesty's Privy Council and a Lord of Appeal in Ordinary.*

This book though primarily a law book has not merely a legal outlook. The author contemplating the spread of education in the sciences and the industrial growth of India envisages in the near future greater activity of inventors and further and profitable use of inventions. He has addressed himself to the needs of inventors and manufacturers alike and has pointed out the salient points in Indian patent law in a practical form and intelligible language. The book should prove invaluable to those non-lawyers who are interested in patentable and patented inventions.

But the author has spared no pains to make the book a complete exposition of the law of patents in India. The Indian statutes have followed closely but not slavishly the corresponding English law and it is obviously impossible to expound the Indian law without a knowledge of the English statutes and decisions. The writer appears to have mastered the history and principles of the English law: and his interpretation of the Indian law is fortified by full quotations from English cases on corresponding problems, and by pointed references to distinctions between the two codes where they exist.

This is obviously a book into which the author has put unremitting labour and skill. It is likely to prove a necessary part of the equipment of persons in India interested in patents, lawyers and non-lawyers alike, and I cordially recommend it.

*A. V. Thirumala*





**To my Father**

**whose life ended on the 18th December 1930,**

**and**

**to my son**

**whose life began on the 21st December 1933,**

**this work is**

**dedicated.**





## PREFACE.

The Patent Law of England has done much for the industrial development of England: more than is commonly realised. It is partly the belief that the Patent Law of India can be used to the great benefit of Indian industries, that has impelled me to undertake this present work. If by making better known the law and system of Patents in India this book should to any extent help in thus adding to the common wealth and to the common good of the industries of India, besides affording, (as primarily intended, as a law book for the legal community), a sufficiently comprehensive and lucid exposition of the law of Patents for Inventions as it exists to-day in India, to be of use to the profession, the labour involved will be doubly rewarded.

I desire here to record my obligation to the Right Hon'ble Lord Atkin for his generosity, in spite of all the other insistent calls that he has upon his time, in being good enough to read this book prior to publication and to write for it a Foreword, thus conferring an honour, which has been to me of the greatest encouragement.

To C. Stratton Cross, Esq., Chartered Patent Agent, of Calcutta, and formerly of London, with whom I have had numerous discussions on many points as they have arisen during the progress of the work, I am, even more than to any one else, most greatly indebted. From start to finish he has accorded to me his unstinted help; and while in no respect responsible for the views expressed, he has afforded numerous suggestions of the greatest possible practical value.

I have to thank my friend Sachindranath Roy Chowdhury, Esq., Barrister-at-Law of the Calcutta Bar, for his help in compiling the Index; and certain other very good friends who have kindly completed the tedious task of arranging in alphabetical order the table of cases.

I have gratefully to record my thanks to Mr. K. Rama Pai, M.A., the Controller of Patents for India, for his kindly and generous assistance in several instances; and for graciously affording me the use of various publications.

I have to thank my friend Mr. A. L. Collet, Registrar of the Original Side, of the Calcutta High Court for having ungrudgingly given me the full benefit of his experience and knowledge on several points regarding the practice of this Court; and the Registrar on the Appellate Side, also, of the Calcutta High Court, for generous assistance on certain points. I wish also to thank the Registrars and Officers of various District Courts throughout British India for affording me certain accurate information on certain points relating to certain matters (contained in Chapter XVII) which might have been otherwise not easy to obtain.

I have to thank my friend W. W. K. Page, Esq., Barrister-at-Law, of Calcutta, for kindly having given me during the time I have been at work on this book, as he has done at all times for many years, the full use of his excellent library.

I have to acknowledge the facilities afforded to me by the Board of Trade, in London, and the Controller, His Majesty's Stationery Office, London, for permission to reproduce the terms of the International Convention for Protection of Industrial Property. I also have to make the usual acknowledgments to the authors and publishers of the previous works on Patents to which I have referred in the text; and in particular to Messrs Sweet & Maxwell of Chancery Lane, London. And I have to thank my clerk Babu Sudhir Kumar Lahiri, who has himself typed out from my manuscript almost the whole of the book.

These acknowledgments would still be incomplete were I to omit to mention the name of my friend N. F. Barwell, Esq., Barrister-at-Law, of Calcutta; since it was the association with him many years ago in a Patent matter that constituted a first introduction to Patents in India which resulted in an early zest for this branch of the law.

I have finally to record here my sorrowful tribute to the memory of the late Mr. Indra Narain Dey who was to have published this book; whose sad and sudden death occurred last year before its completion. I would like to record that a relationship which originated through a chance business connection as author and publisher had developed into a real friendship, which on account of his integrity, efficiency, extreme energy and capacity for work, and enthusiasm for life, as well as his mental power, his charming and very engaging

personality, and, not least among his other qualities, his whimsical good humour and wit, the author will always remain very proud to have owned.

The scheme of arrangement of the present work will, it is hoped, be readily appreciated on a perusal of the table of contents.

E. C. ORMOND.

10, OLD POST OFFICE STREET, }  
CALCUTTA. }  
*November, 1936.*



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■

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## INTRODUCTION.

In these days many eyes are turned towards the future of India: watching the gigantic and unprecedented political experiment now being made and eyeing its political result. But equally important with its political development at this epoch is India's future development in the commercial, agricultural and industrial spheres. It is not too much to say that unless a satisfactory future for this country in these respects is achieved, all political development will count for nothing.

In Bengal, especially, there is the widespread chronic complaint of the perpetual unemployment of the Bhadrakol young men: and all the distress and evil consequences that follow from the fact that far the greater proportion of that very material to which any country is entitled to look for its greatest source of work, power and development, lies unwanted and unused. Just as, in time of war, it is on this man-power that a country depends principally for victory, so in time of peace it is to them that the country should look primarily for its prosperity. Only on this reasoning can the vast annual sums that are spent in a civilised country on the education and maintenance of its upper and middle class young men be economically justified. In Bengal in its present condition this expenditure may be criticised as being uneconomic: and, in fact, (except in so far as it may be said to prove successful in promoting a standard of knowledge, philosophy or conduct which, in itself, when valued for its non-material worth, justifies its cost), it may be said to be entirely unwarranted. The question to be solved remains the hitherto insoluble question: how this highly educated man-power should be profitably employed, or even employed at all.

To increase employment in India it has long been recognised that the growth of indigenous Indian industries should be promoted. A policy of increased development of indigenous industries appears to be being energetically pursued by Government. In pursuance of this policy the Indian Legislature has in recent years passed into law many Acts designed for the sole purpose of assisting the growth of new Indian industries. One notable example is the tariff legislation



putting a practically prohibitive tax on the import into India of sugar; whereby the starting-up of very many new sugar mills in India has resulted, and it would be no exaggeration to say that a totally new sugar-manufacturing industry has been actually created. Another feature of Government assistance in pursuance of this policy has been its legislation through numerous individual Acts making grants in aid of particular industries in India.

It would seem however that the danger to an individual or company embarking on a new manufacturing industry on a small scale lies in the direction of subsequent internal competition from competitors in India, who will all eagerly start up in the same line of manufacture, soon after they have seen him start, provided he is at first successful. From this quarter a pioneer may apprehend just as great a danger—and in the long run just as ruinous—as the competition from competitors abroad. By the Tariff Acts the new manufacturer is protected against competitors abroad: he is not protected at all from what may be equally disastrous competition within India.

In England, before the industrial development of that country became established, the original scheme of the Patent system in England together with the charters to certain guilds and City Societies, was to protect such a new manufacturer equally against competition from outside or from within, during a specific period over the first few years of his enterprise. This was to be a reasonable reward for his pioneering risk. May it not be that India is now at a stage of industrial development, when some such protection to new manufacturers would be nothing but beneficial to the country?

Is not a judicious system for the granting of protection against undue internal competition the reasonable, if not the essential, corollary to tariff protection? Having eliminated the risk of undue competition from the overseas manufacturer, is it not only the next logical step to eliminate also the feature of the risk, equally great and equally incalculable in practical business, of undue and speculative competition from financial adventurers inside India? May it not otherwise be found that the elimination of the one without the elimination of the other will fail to be fully effective in achieving the main purpose of encouraging the healthy growth of fresh industries; because of its failure in many instances to afford the requisite margin of safety

which may be expected to prevail on the mind of the potential new manufacturer to induce him to risk his capital on a new venture?

The Patent system contains means which may be readily utilised for the purpose of eliminating this risk to a great extent for the pioneer: furthermore it contains means which may be effectively utilised to afford ample protection for the public against any abuse of any monopoly by the Patentees.

It is to be observed that a valid Patent can only be obtained for a matter which is within the meaning of Patent Law "a manner of new manufacture." By "new" is meant new in India: no matter whether the thing is old or well-known outside India. This principle is well established. Unfortunately if the description of a thing has been published on paper in India this prevents its being regarded as "new" in India: no matter whether the knowledge of the thing has really passed into the real life of the people or has merely remained pigeon-holed on paper, out of mind. So far is this so that it has even been suggested that any invention of which a description is contained in any one of the thousands of the English Specifications of English Patents of which a copy is filed at the Indian Patent Office in Calcutta, must in law be regarded, by reason of its publication in such a paper, as public knowledge in India: and that this will be so even though it were positively shown that no one in India had in fact ever read the particular paper.

It would not, it seems, be a difficult matter to make provision in the Indian Patent Law to the effect that nothing should be deemed to amount to publication such as to constitute public knowledge in India merely by reason of the fact of its being contained in a British Specification filed in the Patent Office in Calcutta. This would in all probability at once open up a wide field for manufacturing enterprise; since it would probably allow the manufacture in India with the protection of an Indian Patent of many things which would be for all practical purposes new to India, but for which at present no Indian Patent may be granted.

If desired the advisability of additional legislation further in the same direction might be considered, to enable an Indian Patent to be granted and the consequent protection thereby to be afforded, on terms, for the manufacture in India of things, or under processes, which were new in this sense, that while theoretical knowledge on paper existed

in India concerning them, there had not been any manufacture of these things or under these processes previously at all in India. At the present time, of course as is well established, such things are not held to be "new" in India within the meaning of Patent Law; and consequently no Indian Patents may be granted for such things or processes.

These are however matters strictly outside the scope of a law-book. They concern rather those whose business it may be to make the law of the future than those who are only interested to interpret or administer the law as it stands to-day.

Matters of even greater insistence and of practical importance concern the pressing problems of Federation.

As remarked in a later passage in this book (see p. 205) the name "Indian Patent Office" for the Patent Office situated at No. 1 Council House Street in Calcutta is at present to some extent a misnomer. For its powers and functions extend only throughout British India: and not at all in the large area of India which is covered by the Indian States. Under the new constitution of a Federation of India it may be that the Patent Office, styled even now the Indian Patent Office, will, like other similar institutions, come more closely to fulfil the qualities of its name: functioning as the Indian Patent Office in the sense of being the Patent Office of the Federation of India.

Hitherto, it is to be observed, an Indian Patent has created a monopoly which runs only throughout British India. In British India, as part of the territory over which an Indian Patent was hitherto effective, was included Burma, the Shan States and Aden. An Indian Patent has had up to the present no effect in any of the large portions of India which comprise the Indian States.

In future, as Burma is to be separated from British India, the monopoly created by the grant of an Indian Patent will after the separation becomes effective cease to be of any effect in Burma. The territory of the Shan States will presumably also automatically be excluded from British India with the separation of Burma. Aden also, which under the Government of India Act, 1935 (Section 288) is to cease to be a part of British India, will consequently also become territory over which an Indian Patent will cease to run.

It has been stated that it is the intention of the Burmese Government to pass legislation setting up a system of Burmese Patents which will have effect throughout Burma only; just as is the case already in Ceylon. Aden, presumably, will also legislate for a new Patent system of its own, if this is desired.

The effect in Burma and Aden of Indian Patents granted prior to the separation may have to be settled and determined.

Further and even greater alterations than these in the extent of the territory over which an Indian Patent will run in future may well result, if there is a Federation of India, from the consequences and incidents of Federation.

Hitherto certain Indian States, such as Baroda, Cochin, Hyderabad Deccan, Indore, Kashmir, Marwar, Mysore and Travancore, have had independent Patent Systems of their own. Other Indian States have had none. Under the Government of India Act, 1935 (Sections 100 & 104 and the Seventh Schedule, Arts. 27 & 34) it is provided that "copyright, inventions, trademarks and merchandise marks" also the "development of industries, where development under Federal Control is declared by Federal law to be expedient in the public interest" are to be subjects in the Federal Legislative List. It is thus expressly provided that for Patents for inventions the Federal Legislature is to have, and the Provincial Legislatures are not to have, power to make laws.

The result of this may well be therefore that in future, after Federation, a grant of an Indian Patent will be effective throughout the whole territory which will constitute Federated India; including as well as British India, the Indian States which will have joined the Federation.

On the other hand it is still quite open for special stipulations to be agreed between individual States and the central Government concerning the system to be worked for the administration of Patents. This is one of those matters which will call for discussion in connection with the settling of the Instrument of Accession of every individual State. There seems nothing to prevent arrangements being made under such an Instrument of Accession which might result in any individual State retaining its independent Patent system or its right to set up such an independent system in the future. In which case

the territory of such a State would continue, as now, to remain outside the territory over which the grant of an Indian Patent would be effective.

Other questions which may require to be settled in the individual Instruments of Accession (if an Indian Patent is to be effective as a monopoly throughout any of the Indian States) will be how the receipts from the renewal fees paid by Patentees and other income from the Patent system, hitherto received by the Government of India, are to be proportioned between British India and those States over whose territory the Indian Patent runs. Also, similarly, how the costs of administration of the Patent system over Federated India are proportionately to be borne. And what alterations, if any, may require to be made of a legal, executive or financial nature in the arrangements for the administration of the Patent system after Federation.

Time will show whether after Federation an Indian Patent is to carry a monopoly having effect in all or any of the federalised states of India.

## CHAPTER I



## CORRIGENDA AND ADDENDA.

- Page 8, line 21, for "King's Bench Division" substitute "Court of King's Bench".
- „ 15, footnote, delete the word "infra".
- „ 23, line 10, for "EDWARD VIII" substitute "George VI".
- „ 33, line 24, for "effected" read "effective".
- „ 112, line 15, for "requisities" read "requisites".
- „ 137, 6th line from end of page, after "product in" insert "question".
- „ 142, to footnote 31, add:  
     "See the recent case of *In the Matter of Applications for Patent by Rau G.m.b.H.*, (1935) 52 R.P.C. 362."
- „ 143, footnote, for "(1929)" read "(1923)".
- „ 169, line 7, for "patient" read "patent".
- „ 171, footnote, for "Morling" read "Marling".
- „ 177, footnote, for "Eange" read "Range".
- „ 183, line 4, after "If this" insert "be".
- „ 187, line 9, for "33" read "38".
- „ 223, 4th line from end of page, for "26(1)(e)" read "26(1)(a)".
- „ 255, 7th line from end of page, delete the inverted comma before "It may be observed".
- „ 266, 4th line from end of page for "24(1)(f)" read "26(1)(f)".
- „ 433, line 1, for "468" read "368".
- „ 454, line 4, delete the number "23" and insert this number "23" in line 29, after the words "to present the petition".
- „ 556, line 27, for "(1890) 7 R.P.C." read "(1900) 17 R.P.C.".
- „ 579, 6th line, from end of page, for "533" read "553".
- „ 606, footnote No. 25, for "21 R.P.C. 192" read "12 R.P.C. 192".
- „ 620, line 5, for "Youny" read "Young".
- „ 652, footnote No. 16, for "Dainler" read "Daimler".
- „ 776, line 18, for "81" read "31".
- „ 776, 6th line from end of page, for "84" read "34".
- „ 788, footnote 4, for "Dulgeon" read "Dudgeon".
- „ 927, 6th line from end of page, for "1933" read "1932".
- „ 1141, line 11, for "certiorari" read "certiorari" and then insert "790-804".
- „ 1141, line 25, after "prohibition" insert "790-804".
- „ 1152, line 33, after "as to," insert "454".
- „ 1156, line 20, after "in infringement suit" insert "454, 647, 733".





# THE LAW OF PATENTS IN INDIA

## CHAPTER I.

### HISTORY AND NATURE OF PATENT RIGHTS OBTAINABLE IN BRITISH INDIA.

**Position in law of a man in possession of a bare invention without grant of Patent. Under English Law.**

Apart from such rights, if any, as may be bestowed on him by direct individual grant from the Crown, no man has of his own right any private property under English Law in any, even his own, invention. In this respect the product of a man's mind which takes the form of an invention which may or may not become the subject of Letters Patent differs from the product of a man's mind which takes the form of a book; since an author as soon as his book is created has private property in the copyright of his book at Common Law apart from any grant.<sup>1</sup> An inventor, no matter to what extent he may have perfected the creation of his invention, has no right in the invention unless he can go one step further and obtain the grant of Letters Patent. It is of course legal in every respect for an inventor to keep his invention to himself and work it in secret. But, if he does so, he does so at his peril; and if it is discovered, he has no right to prevent or object to the discoverer, or all the world, making it or using it or selling it, just as if he himself had never invented it.

It is unnecessary, if not inaccurate, to say that he does so "at the peril of losing his rights in the invention if it is discovered"; since, as mentioned above, he has no rights to lose.

Having no rights himself against the rest of the world in his invention, it follows also that he cannot under English Law effectively assign any rights in his invention to another party.

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<sup>1</sup> As to distinctions between Patent Rights and other exclusive rights see further at Ch. II.

Of course where A is an inventor of a secret invention which he does not himself wish to patent or exploit, there is nothing to prevent A entering into a valid contract with B, under which A, in consideration of money or other reward paid to him by B, imparts the secret to B and agrees that he, A, will not impart the secret to others; and that he, A, will not take out any Patent in his own name but will assist B in any necessary way to obtain the requisite patent; and if necessary will allow an application to be made for a Patent in the joint names of A (who, being the true and first inventor, is therefore the proper applicant for any such patent) and B. But in such case there has been no assignment of any rights properly speaking in the invention as against others at all to B. Just as A had no rights against the world in the invention until the acquisition of such rights as might be bestowed on him by grant of Letters Patent, so B is in no better legal position than A was in, in the first place. And in truth B as against the world in general is in no better legal position himself after the transaction than he was in before the transaction. B has of course certain personal rights under the contract against A: but no more. Such a transaction, in which an inventor A, may give up such rights as he may have, qua inventor, to apply for a grant of Letters Patent, to B, may popularly be spoken of as "an assignment by A of his invention to B;" but it is important to note that there is no assignment in the sense of an assignment of any rights of property or of any rights which will stand against the world in general; since the inventor has no such rights without express grant.

It is necessary to emphasise at the outset this legal position at Common Law of an inventor before grant of Letters Patent in order to obtain a proper perspective of the foundations of English Patent Law upon which in its turn all Indian Patent Law is based.

### Origin and meaning of the word "Patent".

The word Patent (derived from the Latin *patere* to be open) merely signifies an open record of the grant made by the Crown: open that is for all the world, on proper application, to see. The origin and meaning of Letters Patent or "*litteræ patentēs*" is referred to by Sir William Blackstone in his treatment of "the Rights of Things" in the following passage:—

"The King's Grants are also matter of public record.

These grants, whether of lands, honours, liberties; franchises, or aught besides, are contained in charters, or letters patent, that is, open letters, *litteræ patentēs*: so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom; and are usually directed or addressed by the King to all his subjects at large. And therein they differ from certain other letters of the king, sealed also with his great seal, but directed to particular persons, and for particular purposes: which therefore, not being proper for public inspection, are closed up and sealed on the outside, and are thereupon called writs close, *litteræ clausæ*, and are recorded in the close-rolls, in the same manner as the others are in the patent-rolls.”<sup>2</sup>

Letters Patent or Patents are thus merely the name given to a document in which the Crown confers special rights or privileges upon a subject. Patents or Letters Patent are requisite for the grant of a peerage: or for the conferment of titles of honour: or for a change of name: or for the appointment of Judges and certain other officials such as Ministers of the Crown: or for the grant of certain special privileges or of certain charters of incorporation to certain public bodies: to mention only some of many various purposes which have nothing whatever to do with what is ordinarily known as Patent Law or with inventions. In this book and with reference to Patent Law the use of the word “Patent” means merely the Letters Patent by which (broadly speaking) a grant is made to a person known as the Patentee of the monopoly for a fixed period to manufacture and/or sell goods made in accordance with a certain specified invention.

## The Development of Patent Law in England.

### Monopolies at Common Law.

The Crown has always possessed, as an inherent part of the royal prerogative, the sole right to grant monopolies. It is difficult or impossible to determine with certainty when monopolies were first granted to inventors, although the exercise of the prerogative in this way is undoubtedly very ancient. As an example of an early grant it is stated that King Edward III, in the year 1366 A. D. on the representation of some alchemists, granted a commission to two friars and two aldermen to inquire whether a philosopher’s stone

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<sup>2</sup> Blackstone’s Commentaries (16th Edn. 1825) Vol. 2, page 346.

might be made ; and, on their reporting that the project was feasible, granted to the two aldermen a patent of privilege, that they and their assignees should have the sole making of the philosopher's stone.\* The earliest form of these grants of privilege seems to have been that of exclusively conducting new trades or dealing in objects of commerce hitherto unknown.

**The adjustment between the Crown's right of Prerogative and the rights and liberty of the subject.**

At first there were no defined limits as to the extent to which the Crown might grant such monopolies. As the exercise of the prerogative was a source of revenue to the Crown and a means of raising money which could be employed without discussion in Parliament by a single stroke of the pen at the pleasure of the Sovereign, it is natural that at some periods there was a tendency on the part of the Sovereign or the courtiers of the Sovereign to extend the use of the prerogative.

In the nature of things, if the Crown were to make grants of monopolies without limit, such grant would inevitably interfere with the personal rights and liberty of other persons who might be competitors in business of the grantee or prospective purchasers.

There seems little doubt that in some instances the Crown sanctioned the most oppressive monopolies with a view to reward favourites or to raise money.

The position of matters by the time of the reign of Queen Elizabeth is referred to by Edmunds as having been described by Hume as follows :—

"It is astonishing to consider the number and importance of those commodities which were thus assigned over to patentees. Currants, salt, iron, powder, cards, calf-skin, pouldavies, ox shin bones, train oil, lists of cloth, potashes, aniseeds, vinegar, sea coals, steel, aqua vitæ, brushes, pots, bottles, saltpetre, lead, accidences oil, calamme stone, oil of blubber, glasses, paper, starch, tin, sulphur, new drapery, dried pilchards, transportation of iron ordnance, of beer, of horn, of leather ; importation of Spanish wool, of Irish yarn. These are but a part of the commodities which had been appropriated to monopolists. When this list was read in the House,

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\* See Edmunds (1890 Edn.) p. 3 citing Year Book Part IV 40 EDW III fol. 17, 18 and Hindmarch p. 4.

a member cried. 'Is not bread in the number?' 'Bread', said every one with astonishment. 'Yes; I assure you,' replied he, 'if affairs go on at this rate, we shall have bread reduced to a monopoly before next Parliament'. These monopolists were so exorbitant in their demands that in some places they raised the price of salt from sixteen pence a bushel to fourteen or fifteen shillings. Such high profits naturally begat intruders upon their commerce, and in order to secure themselves against encroachments, the patentees were armed with high and arbitrary powers by the Council, by which they were enabled to oppress the people at pleasure, and to exact money from such as they thought proper to accuse of interfering with their patent. The patentees of saltpetre, having the power of entering every house and of committing what havoc they pleased in stables, cellars, or wheresoever they suspected saltpetre might be gathered, commonly extorted money from those who desired to free themselves from this damage or trouble, and while all domestic intercourse was thus restrained, lest any scope should remain for industry, almost every species of foreign commerce was confined to exclusive companies, who bought and sold at any price they themselves thought proper to offer or exact."

It is true that the view has been stated, notably by Prof. S. R. Gardiner in his *History of England from 1603-1642*, that many of the monopolies and grants that were complained of at the time about which he is writing, that is under James I, were quite defensible in principle and that the grant of them by the Crown was entirely fitting and proper; and that it was not the granting of them which was the cause of the grievances of the people but the abuse of privileges by the grantees. No doubt it must have been very difficult if not impossible for the public to obtain any redress against the grantees in cases of oppression owing to the lack of any effective system of regulation of the use and working of the monopolies after grant. In any case whether it was that the monopolies were granted in a manner in which they should not have been granted, or whether it was principally that the monopolies were used by the grantees without check oppressively, these monopolies became a source of grievance to the people; and a series of attacks was made upon them.

Shortly previous to the year 1601 these grievances aroused the

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\* Edmunds (1890 Edn.) p. 5 citing 5 Hume 386.

attention of the House of Commons and a petition was presented to Queen Elizabeth complaining of the monopolies. This petition being ineffective a Bill was introduced in the House of Commons for the purpose of abolishing all the obnoxious grants.

A clear idea of the views then held concerning the two opposing principles, of the unimpeachable royal prerogative on the one hand, and of the liberty of the subject on the other, may be well had in Hume's own words which are cited by Edmunds in stating a view of the proceedings which took place on the introduction of the Bill. He says :—

“As the former application had been unsuccessful a law was insisted on as the only expedient for correcting these abuses. The courtiers, on the other hand, maintained that this matter regarded the prerogative, and that the Commons could never hope for success if they did not make application in the most humble and respectful manner to the Queen's goodness and beneficence..... It was asserted that the Queen inherited both an enlarging and restraining power : by her prerogative she might restrain what was otherwise at liberty : that the royal prerogative was not to be canvassed, nor disputed, nor examined, and did not even admit of any limitation : that absolute princes, such as the Sovereigns of England, were a species of Divinity : that it was in vain to attempt tying the Queen's hands by laws or statutes, since by means of her dispensing power she could loosen herself at pleasure ; and that even if a clause should be annexed to a statute excluding her dispensing power she could first dispense with that clause ; and then with the statute. After all this discourse, more worthy of a Turkish divan than of an English House of Commons.....the Queen, who perceived how odious monopolies had become, sent for the Speaker, and advised him to acquaint the House that she would immediately cancel the most grievous of these patents”.

Thereupon an address of thanks was at once voted and was delivered to Her Majesty by the Speaker attended by about 180 members on 30th November 1601. The answer sent by Queen Elizabeth to this address is of interest as showing the Crown's view of these matters at the time and its regard for the rights and liberty of the subject and its appreciation of the proper limits of its prerogative. The following extract may be quoted :—

“I never put my pen to any grant, but upon pretence and

semblance made unto me, that it was both good and beneficial to the subjects in general, though a private profit to some of my ancient servants who had deserved well : but the contrary being found by experience, I am exceedingly beholden to such subjects as would move the same at first..... That the grants should be grievous to the people, and oppressions. etc., be privileged under colour of our patents, our kingly dignity shall not suffer it : and when I heard of it I could give no rest to the thoughts till I had reformed it".<sup>5</sup>

As a result of these events the greater number of the monopolies complained of were revoked under Queen Elizabeth.

After the accession of James I the same trouble began over again owing to fresh grants of further monopolies by the King.

The King in 1608 by letters patent created a monopoly in respect of the whole trade of alum in England and took the whole trade into his hands ; other monopolies were also granted. A flagrant instance is the case of Mompesson and Mitchell, being Sir Giles Mompesson and Sir Francis Mitchell, to whom a patent was granted for the sole making and selling of gold and silver lace. An account of the affair which may be taken from the Parliamentary Report 1829 page 167, cited in Edmunds, is to the following effect :—The patentees grossly abused their privilege, "making sophisticated lace of copper and base materials, and procuring others (who made good lace) to be fined and imprisoned for infringing their patent. Great complaints were made to Parliament ; and in consequence Mitchell was imprisoned, but Mompesson escaped, and a proclamation was issued, offering a reward for his apprehension. The King informed the Parliament that he was ignorant of the abuse of his patent and would revoke it. The Lords confiscated the estate of Mompesson who had escaped, and degraded him of his knighthood. Mitchell was also degraded, fined £1,000, carried through the streets of London on a horse, with his face to the tail, and imprisoned for life. The patent for gold and silver lace and some others were revoked by Royal proclamation".

As a result of such fresh grants by the King the whole question came up again. It was during the reign of James I in this controversy that precise limits came to be settled concerning what monopolies might properly and lawfully be granted and what might not.

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<sup>5</sup> See Edmunds (1890 Edn.) p. 6 citing Hume ubi supra.



The general principles of these limits are aptly defined in Coke's definition of an unlawful monopoly.

### Coke's definition of an illegal monopoly.

An illegal monopoly, according to Sir Edward Coke, is "an institution or allowance from the King by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying or selling, making, working, or using of anything whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before or hindered in their lawful trade".<sup>6</sup>

Similar principles were evolved, fixed and given the authority of law in certain well known cases concerning monopolies which during the course of the same controversy under James I came before the Courts for decision. The first leading case was the case of *Darcy v. Allein*.

### *Darcy versus Allein*.

In the year 1602 the disputes above referred to came before the Courts in the case of *Darcy v. Allein* known as "the case of Monopolies", which was heard and argued in the last year of the reign of Queen Elizabeth and in which judgment was delivered in the first year of James I. The case was decided in the King's Bench Division.<sup>7</sup>

The Plaintiff in this case was one Edward Darcy a groom of the Privy Chamber to Queen Elizabeth; and the Defendant one T. Allein, haberdasher of London. The Plaintiff's case was that the Plaintiff had been granted the monopoly by Letters Patent for 12 years (subsequent to the grant for a previous period of 12 years to another) for the sole manufacture and sale in the realm of Great Britain of playing cards; and that the Defendant had infringed his monopoly by manufacture and sale. The Plaintiff declared "that Queen Elizabeth intending that her subjects being able men to exercise husbandry, should apply themselves thereunto, and that they should not employ themselves in making playing cards, which had not been any ancient manual occupation within the realm, and that by making such a multitude of playing cards card-playing was

<sup>6</sup> See Edmunds (1890 Edn.) p. 10, citing Coke 3 Inst 181, c. 85.

<sup>7</sup> *Darcy v. Allein*, (Trin : 44 Eliz :) The case of Monopolies, 77. E. R. 1260, 1. e. 11. Co. Rep 25.

become more frequent and especially among servants and apprentices and poor artificers ; and to the end that her subjects might apply themselves to more lawful and necessary trades ; by her letters patent under the Great Seal..... the said Queen granted the Plaintiff his Executors and Administrators and their deputies etc. the same privileges authorities and other the said premises (as had been granted to the previous grantee : i.e. a monopoly of manufacture, importation and sale).....for 12 years after the end of the former term. That the Plaintiff caused to be made 400 grosses of cards for the necessary uses of the subjects to be sold within the realm and had expended in making them £5,000/-. That the Defendant knowing the said grant and prohibition in the Plaintiff's letters patent.....without the Queen's license, or the Plaintiff's, at Westminster caused to be made 80 grosses of playing cards and..... 100 other grosses.....”.

The defence of the Defendant was in effect a denial of the acts complained of except as to one half gross and as to that he pleaded “that he was entitled to sell the cards” by reason of a custom in favour of the Society of Haberdashers in the City of London. After the disposal of a point on demurrer, which is not material for present purposes, the case was heard and decided on the merits ; and it must be taken as if the defence pleaded was, in modern parlance, a plea among other points, that the patent was invalid. Among the issues raised in the case were the following :—

(i) If the said grant to the Plaintiff of the sole making of cards within the realm was good or bad ?

(ii) If the license or dispensation to have the sole importation of foreign cards granted to the Plaintiff was available or not in law ?

As to the second issue, there appears to be some authority, in spite of the wording of Coke's report, for the view that actually the second issue was not fully adjudicated upon by the Court :<sup>a</sup> in any event that issue turned partly on a construction of a particular statute (3. E. 4. Chap. 4.) which imposed a forfeiture upon the importation of playing cards, which is not for present purposes material. In these circumstances the importance of the case at the present day is confined to the discussion of and decision on the first issue, to which the following comments are, therefore, confined.

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<sup>a</sup> See the note in the English Reports at p. 1265.

For the Plaintiff it was argued as to this issue "that the said grant of the sole making of playing cards within the realm was good for three reasons :—(1) Because the said playing cards were not any merchandise, or thing concerning trade of any necessary use, but things of vanity, and the occasion of loss of time, and decrease of the substance of many, the loss of the service and work of servants, causes of want which is the mother of woe and destruction, and therefore it belongs to the Queen.....to take away the great abuse, and to take order for the moderate and convenient use of them. (2) In matter of recreation and pleasure, the Queen has a prerogative given her by the law to take such order for such moderate use of them as seem good to her. (3) The Queen in regard of the great abuse of them, and of the cheat put upon her subjects by reason of them, might utterly suppress them, and by consequence without injury done to any one, might moderate and tolerate them at her pleasure. And the reason of the law which gives the King these prerogatives in matters of recreation and pleasure was because the greatest part of mankind are inclinable to exceed in them".

And reliance was placed on various cases and statutes.

For the Defendant it was argued that the grant was void.

The judgment of the court was delivered by the Lord Chief Justice of England (Popham. C. J.) in favour of the Defendants. The effect of the judgment may be summarised, retaining as far as possible the original phraseology of boke's report, as follows :—

"That the said grant to the Plaintiff of the sole making of cards within the realm was utterly void and that for two reasons :—

(1) That it is a monopoly and against the common law : for four reasons :

(i) All trades, as well mechanical as others, which prevent idleness (the bane of the commonwealth) and exercise men and youth in labour, for the maintenance of themselves and their families and for the increases of their substance, to serve the Queen when occasion shall require, are profitable for the commonwealth, and therefore the grant to the Plaintiff to have the sole making of them is against the common law, and the benefit and liberty of the subjects.....

(ii) The sole trade of any mechanical artifice or any other monopoly, is not only a damage and prejudice to those who exercise the same trade, but also to all other subjects for the end of all these

monopolies is for the private gain of the patentees ; and although provisions and cautions are added to moderate them, yet.....it is mere folly to think that there is any measure in mischief or wickedness : (*"res profecto stulta est nequitiae modus"*). That therefore there are three irreparable (evil) incidents to every monopoly against the commonwealth : (*viz.* (a) rise of price (b) fall of quality, (c) unemployment). That the King's grant which tends to the charge or prejudice of the subject is void.....

(iii) The Queen was deceived in her grant ; for the Queen, as by the preamble appears, intended it to be for the public weal, and it will be employed for the private gain of the patentee and for the prejudice of the weal public. Moreover the Queen meant that the abuse should be taken away, which shall never be by this patent, but rather the abuse will be increased for the private benefit of the patentee, and therefore.....this grant is void *Jure Regio*.

(iv) This grant is *primæ impressionis*, for no such was ever seen to pass by letters patent under the great seal before these days and therefore it is a dangerous innovation.....And it is observed that this grant to the Plaintiff was for twelve years so that his executors administrators wife or children or others inexpert in the art and trade will have this monopoly. And it cannot be intended that Edward Darcy, an Esquire, and a groom of the Queen's Privy Chamber, has any skill in this mechanical trade of making cards ; and then it was said that the patent to him was void, for to forbid others to make cards who have the art and skill and to give him the sole making of them who has no skill to make them will make the patent utterly void.....It was also observed : "as to what has been said that playing at cards is a vanity, it is true, if it is abused, but the making of them is neither a vanity nor a pleasure but a labour and pains.....And it is evident by the preamble of the said Act of 3. E. 4. c. 4, that the importation of foreign cards was prohibited at the grievous complaint of the poor artificer card-makers, who were not able to live of their trade if foreign cards should be imported... ..And therefore it was resolved that the Queen could not suppress the making of cards (forasmuch as it maintained divers families by their labour and industry).....no more than the making of dice, bowls, balls, hawks hoods, bells, lures, dog couples, and other the like, which are works of labour and art, although they serve for pleasure, recreation and pastime, and cannot be suppressed but by

Parliament, nor a man restrained from exercising any trade but for Parliament”.....

(2) That it is against divers Acts of Parliament.....“such charter of a monopoly against the freedom of trade and traffic (being) against divers Acts of Parliament : (9. E. 3. c. 1 & 2. 25. E. 8. c. 2 being cited). And it is further (by the same act) provided that if any statute, charter, letters patent, proclamation, command, usage, allowance or judgment be to the contrary, that it shall be utterly void, *Vide Magna Charta* Cap 18 : 27 E. 3. Cap 11 etc”.

Thus the Judges exercising their traditional independence, held that the Crown could not have intended in that case to grant a monopoly which would be to the prejudice of the Crown's subjects and accordingly held that the grant of the monopoly in question was void at law. The decision in this case established finally the illegality in law of monopolies for trades or manufactures which were not new ; and pointed the way for the Statute of Monopolies and laid the foundations of the basic principles on which modern Patent Law is based.

### **The King's Book.**

The next step in the history of the dispute was marked by the declaration of James I, made in 1610 in a book published by the King himself, by which it was notified that monopolies in general were bad, and, in the language of the time “things contrary to our laws and things for which we expressly command that no suitor presume to move us ;” an exception however being expressly made of the following :—“Projects of new invention so they be not contrary to the Law, nor mischievous to the State by raising prices of commodities at home or hurt of trade or otherwise inconvenient”.

It may be noted that Coke suggests definitely that the publishing of the King's book was a direct result of the judgment in *Darcy v. Allein*.<sup>9</sup> The result of the declaration was in effect to declare that all monopolies were bad except those to be granted to inventors.

Even after 1610 however it appears that grants of monopolies, such as were complained of, were continued to be made.

Finally in 1624 advantage being taken of the good feeling then existing between James I and his Parliament and of the declaration to which he had committed himself in 1610, the famous enactment

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<sup>9</sup> See Edmunds (1890) page 629 citing Coke 3 Inst. 182.

was passed in Parliament known as the Statute of Monopolies (21 Jac. 1, Ch. 3) which gave effect to the declaration already mentioned.

### **The Statute of Monopolies.**

It is important to understand that the Statute of Monopolies did not create any Monopolies which were not good at Common Law before ; nor did it abolish any Monopolies, it seems correct on the whole to say, which at Common Law alone would have been or ought to have been sanctioned before. Long before the Statute of Monopolies it had been a principle of the Common Law that the Crown had a right to grant monopolies in certain cases though it had no right to grant monopolies in other cases : as where their grant would be mischievous to the State. Accordingly the Statute of Monopolies was passed in the form of a codifying Statute declaratory of the state of the Law then existing and saving the rights of the Crown then existing : and not as a Statute which was creating any new state of Law or any new rights.

The Statute did however make alterations of a practical nature in certain other directions : in particular by enacting that thereafter all disputes regarding monopolies should be triable according to the Common Law and in the Common Law Courts.

Prior to the passing of that Statute all disputes between the Crown and its subjects regarding monopolies were heard and decided before the Star Chamber. From the circumstances in which that judicial body had been created in the time of Henry VII in 1487 through his Statute (3 Hen 7 Ch. 1) and in which it had functioned until it was abolished by Charles I in 1640 by his Statute (16 Car. 1. Ch. 10) the Star Chamber, which was in effect an instrument of the Crown, being its creation and subservient to the Crown for its existence, had not proved a satisfactory court for the ordinary people. It was largely because of this that many bad monopolies had been enforced and that the gross abuses in regard to them had become common.

As rightly remarked by the Commentator in Halsbury's Laws of England, the political situation of those times is now of more than passing interest to anyone making a study of Patent Law to-day ; since the whole modern structure of Patent Law in England, which has been taken as a model in many other parts of the world, springs

from the famous Section 6 of the Statute of Monopolies which in its turn was the outcome of the political strains and stresses of the period preceding it ; and furthermore the interpretations which the Courts came to put on that section were largely due to the lively existence at the time of Sir Edward Coke ; not only on account of the strength of his intellect and the forcefulness with which he pressed his views but also on account of the chance which caused those views to carry a considerable bias. In this matter he was a violent partisan. The result is that in his writings he seeks to narrow the meaning of a valid monopoly beyond the limits given to it on the face of that Section 6. The result is that certain of his propositions are no longer law and several of the difficulties and anomalies of modern English Patent Law formerly arose from the dilemma in which the Courts had been placed of rejecting such a famous authority or of accepting propositions which have no other support in law.<sup>10</sup> It is not necessary however here to pursue such matters in further detail. It is of primary importance to consider the terms of the section itself and the broad nature of the monopolies which it authorised. From this it will be seen that the requisites postulated in the Statute of Monopolies for the grant of a valid Patent may be in the main summarised as follows :—

(1) The grantee was required to be the true and first inventor.

(2) Novelty was a requisite for the manufacture for which the monopoly was to be given.

(3) The manufacture was not to be contrary to law ; nor mischievous to the State by raising the price of commodities at home ; nor hurtful to trade ; nor generally inconvenient.

The full text of this 6th Section is as follows :—

“Provided also, and be it declared and enacted, that any Declaration before mentioned shall not extend to any Letters Patents and Grants of Privilege for the Term of Fourteen Years or under, hereafter to be made, of the sole working or making of any manner of new Manufactures within this Realm, to the true and first Inventor and Inventors of such Manufactures, which others at the time of making such Letters Patents and Grants shall not use so as also they be not contrary to the Law, nor mischievous to the State, by

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<sup>10</sup> See Halsbury Vol. 22 Art. 269 and Note K and the case there cited *Boulton v. Bull* (1795.) 2 Hy. Bl. 463 at p. 491.

raising Prices of Commodities at home, or Hurt of Trade, or generally inconvenient ; the said Fourteen Years to be accounted from the Date of the first Letters Patents, or Grant of such Privilege hereafter to be made, but that the same shall be of such Force as they should be, if this Act had never been made, and of none other.”<sup>11</sup>

The part of the Statute with which we are now concerned was thus in the form of a statement of the exceptions to the general proposition that monopolies in general were bad and of no legal effect. It is on the exceptions mentioned in the Statute of Monopolies that the whole structure of modern Patent Law has been raised. The positive rights to create grants of Patents have been all along those of the Crown at Common Law. These rights were the same in their nature before the Statute of Monopolies as after it. They are the same in their nature to day. Since all subsequent legislation has preserved those rights of the Crown which were possessed by the Crown at Common Law and without creation by any Statute, “in relation to the granting of Letters Patent or the withholding of the grant thereof”. So it is in England, as is emphasised by the opening words of the form of English grant,<sup>12</sup> that at the present day notwithstanding the various statutes which have been passed in relation to Letters Patent for inventions, these monopolies are still granted upon the “mere motion” of the Sovereign in the exercise of his royal prerogative and that all that has been done has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining Letters Patent for inventions.

So it is that the subsequent English Statutes passed after the Statute of Monopolies have adopted largely the definitions contained in that Statute. Another reason for this being, as has been cogently suggested, that the Legislature in adopting the old and not altogether perfect definition has been influenced to some extent by the great number of important cases which have been decided on the construction of section 6 of the Statute of Monopolies and by consideration of the enormous expense and labour and learning which have been devoted to obtaining those decisions and by the realization that those decisions had thus obtained a definite judicial meaning.

<sup>11</sup> For the full text of the Statute reference may be made to Appendix No. 1 *infra* below where for convenience it is set out at length.

<sup>12</sup> See Ch. 2 *infra*.



**Modern Statutory Law of Patents in England.**

It is unnecessary here in detail to consider the various Statutes which have been passed since the Statute of Monopolies, since these have now all been consolidated in England in one Statute of 1932 (being 22 and 23 Geo. 5 Ch. 32), which came into force on 1st November 1932. The amendments made by the Act of 1932 in the Statute of 1907 (referred to in the amending Act as the principal Act) and the complete text of the principal Act as amended by the previous Acts of 1914, 1919 and 1928 are now cited officially as one complete act known as the Patents and Designs Acts 1907 to 1932. The full text of that complete act is set out for convenience of reference in an Appendix.<sup>13</sup>

It is this Act which now embodies the whole Statutory Patent Law in England.

**The Development of Patent Law in British India.**

Turning now to the development of Patent Law in British India, it will be at once seen that all Indian Patents are creations solely of the Statutory enactments of the Indian Legislature ; which may be regarded as being in the same sphere as similar English statutes, as laying down the manner and procedure in which the prerogative right of the Crown to grant monopolies for inventions will be exercised in British India. Constitutionally the power to grant the monopolies still springs from and rests in the prerogative power of H. M. the King Emperor. By the grant of Letters Patent in England the grantee is at the present day given patent rights which extend over the United Kingdom of Great Britain & Northern Ireland and the Isle of Man but no further. The right to grant Patents being in the Crown at Common Law, it is difficult to understand why Patents could not be granted in England which would be validly current in India. There appears to have been considerable discussion on this point. As stated in the Indian Patent Office Handbook there was a considerable agitation in India for several years preceding 1856, and it was as a result of such agitation that the Act of 1856 was eventually drawn up and passed. Prior to that there was of course from a practical point of view no machinery for the administration or enforcement of Patents in India. Whether or not the Crown might have validly granted Patents in England which

<sup>13</sup> Appendix No. 3 *infra*.

would have been current in India is now immaterial. In the first Indian Act which was passed the Indian Legislators were careful to state in the body of the Act that it was not to interfere with the Royal Prerogative : (See section 35 of Act VII of 1856 referred to below). But actually no attempt has been made by the Crown either to create or to enforce the grant of Patents in England so as to make such grants to be current in India. For all practical purposes it is now sufficient to note the very definite wording of the English grant showing that the rights granted therein are local and are restricted geographically as stated.<sup>14</sup>

### Summary of the old Indian Acts since repealed.

The first provision for anything in the nature of Patent Rights in India was the Act of 1856 : being Act VI of 1856.<sup>15</sup> By that Act it was intended that certain rights styled "Exclusive Privileges" should be granted to inventors for a period of 14 years in India. That Act was however introduced without the previous sanction of H. M. the Queen. The Law Officers of Her Majesty advised that the Indian Legislative Council was not competent to pass the Act. The Court of Directors of the East India Company under their powers disallowed the Act. The Act was accordingly formally repealed in toto in 1857 (by Act IX of 1857).<sup>16</sup> Soon after that, in 1859, another Act being Act XV of 1859 free from the formal defects of the Act of 1857 was duly passed. Since this Act of 1859 may be regarded as the first real beginning of the creation of Patent rights in India it is, though since repealed, set out in full for purposes of reference in an Appendix.<sup>17</sup>

On general lines the Act of 1859 followed the scheme of the Act of 1856. There was no need however for any mention of the Royal Prerogative, the royal sanction having been obtained.

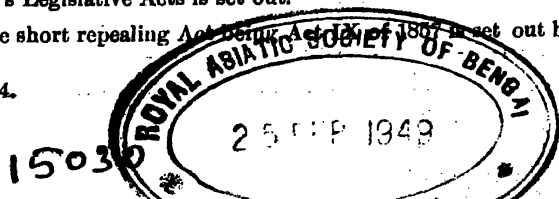
By the Act of 1859 effective provision was made for the first time for the grant of certain monopolies in India. This Act was founded on the English Patent Law of 1852 contained in the Statute

<sup>14</sup> For the form of grant of Letters Patent in England see Chapter II *infra*.

<sup>15</sup> The nature of this Act may be seen from Appendix No. 4 below where an extract from Theobald's Legislative Acts is set out.

<sup>16</sup> The text of the short repealing Act being Act IX of 1857 is set out below in Appendix No. 4.

<sup>17</sup> See App. No. 4.



16 & 17 Vict c 115. Under the Act of 1859 the monopolies were styled "exclusive privileges". The general scheme under which these might be obtained was this. The inventor of any new manufacture might apply to the Governor General for leave to file a specification thereof. Before dealing with such application the Governor-General might refer it to any person or persons for enquiry and report. The Governor General might then make an order authorising the applicant to file a specification. After such order the inventor had merely to file the specification within six months and he automatically obtained the "exclusive privileges of making, selling and using the invention in India and of authorising others to do so for the term of 14 years from the time of filing such specification". Five copies of the specification were required to be filed, one of which in every case had to be sent to and filed by the Secretary to Government in Bengal, Fort St. George (Madras), Bombay, and North West Provinces, respectively, and was to be open to public inspection upon payment of a fee of one rupee. A record of all such applications and specifications and of all orders made was required to be kept in the Office of the Secretary to the Government of India. This book was to be open to inspection by the public on payment of a fee of one rupee. And on payment of the expenses of copying, a certified copy of any entry in the book might be obtained from the Secretary to the Government of India. The Act gave a right to an inventor to sue for infringement in the principal civil Court of original jurisdiction within the local limits of whose jurisdiction the cause of action should accrue or the defendant should reside as a fixed inhabitant. The Act also gave rights to an opponent to apply by motion to any of Her Majesty's Courts of Judicature for a rule to show cause why the Court should not declare that an exclusive privilege had not been acquired under the provisions of the Act on certain grounds specifically mentioned in the Act. The Act also gave a right of application to the Advocate-General of Bengal, Madras or Bombay and to any person by order of the Governor General to move the Court to investigate the question whether there had been a breach of any special condition upon which the grant had been made or any other question of fact on which the revocation of the exclusive privilege might depend (Section 26). The Act also gave power to the Governor-General to declare that the exclusive privilege should cease if mischievous to the State or generally pre-

judicial to the public or for breach of any special condition upon which it had been obtained : (Section 16). The Act also contained many other detailed provisions. Reference may be made to the full text of the Act as passed which is set out below in an Appendix.<sup>18</sup>

The provisions of the Act of 1859 were in 1872 added to by the further provisions of Act XIII of 1872 entitled "the Patterns and Designs Protection Act 1872". This Act was passed in the form of an Act amending Act XV of 1859. All its amendments were amendments of addition. This Act of 1872 related solely to Designs. It gave to any person entitled in the United Kingdom to an exclusive right in any pattern or design similar rights in British India. Since we are not in this work, which is confined to Patents for inventions and does not deal with Designs, directly concerned with it, further comment is unnecessary.<sup>19</sup>

The Act of 1859 was further supplemented in 1883 by Act 16 of 1883 entitled "the Protection of Inventions Act 1883". This Act was enacted as a direct preliminary to the International Exhibition which was to be held in the years 1883 and 1884 at Calcutta for the purpose of protecting inventors who might wish to exhibit their inventions at the Exhibition, so that they would not be deprived of the opportunity of obtaining monopolies for such inventions merely through having exhibited them in public at the exhibition before filing their Specification under the Act of 1859. The Act was drawn in a form which might also in future afford similar protection in regard to "any Exhibition to be held in India which the Governor-General in Council might on the application of any persons desirous of holding the Exhibition by notification in the Gazette of India declare to be in the judgment of the Governor-General in Council, calculated to promote Indian art or industry and to prove beneficial to the mercantile agricultural or industrial classes of Her Majesty's subjects in India".

In 1888 all three of the abovementioned Acts of 1859, 1872 and 1883 were superseded by Act 5 of 1888 entitled "the Inventions and Designs Act 1888." This Act consolidated the previous law and also effected considerable amendments : especially in regard to the practice to be followed in the various proceedings connected with the

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<sup>18</sup> App. No. 4 *infra*.

<sup>19</sup> App. No. 4 *infra*.

application for and grant of exclusive privileges and their regulation and control. The full text of the Act as passed, though it has been since replaced, is set out for reference in an Appendix.<sup>20</sup>

### Modern Indian Acts, now current.

It was not until 1911 that the system of Patent administration which is now in force in British India was instituted. It was true that in England in 1883, that is to say five years before the Indian Act of 1888, the English Patent Law had been consolidated and a system enforced by Legislation of a nature which was considerably more advanced than the provisions made in the Indian Act of 1888. At the time of the passing of the Act of 1888 it had been considered that "the time was not ripe in India for introducing the English practice in its entirety as the volume of Patent work in India was then small"; (see the reference to this in the Objects and Reasons of the Indian Act of 1911.)<sup>21</sup> But meanwhile the comprehensive consolidating Statute of 1907 had been passed in England; and in 1910 in view of the growth of the volume of Patent work in India it was considered advisable to overhaul the Indian system of Patent administration. In March 1910 therefore was introduced the Bill (being No. 9 of 1910) which eventually culminated in the Indian Act 2 of 1911 entitled the Indian Patents and Designs Act 1911 which is in force to-day.

It was under this Act of 1911 that the office of the Controller of Patents in British India was for the first time created.

Since 1911 there have also been passed, in the nature of legislation supplementary to that Act, certain Amending Acts as follows :—

- (i) Act 19 of 1920 entitled "The Indian Patents and Designs (Amendment) Act 1920."
- (ii) Act 7 of 1930 entitled "The Indian Patents and Designs (Amendment) Act 1930".

Of these the Act of 1920 was confined to the provision of reciprocal arrangements between India and other countries : while the Act of 1930 made considerable amendments to the Act of 1911 over a wide field.

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<sup>20</sup> App. No. 4 *infra*.

<sup>21</sup> App. No. 5 *infra*.

In addition there may be mentioned, as having a bearing on the subject, certain formal repealing Acts, such as are passed from time to time to give proper shape to progressive legislation, as follows :—

Act 17 of 1914.

Act 31 of 1920.

Act 11 of 1923.

Act 12 of 1927.

These last mentioned repealing Acts may for all ordinary working purposes be ignored.

### Reference to the Acts.

For purposes of reference the full text of the Act of 1911 and of the Acts of 1920 and 1930 ; also the Objects and Reasons of Bill No. 9 of 1910 which culminated in Act 2 of 1911 and the Objects and Reasons of Bill No. 31 of 1920 which culminated in Act 29 of 1920 and the Objects and Reasons of Bill No. 33 of 1928 which culminated in Act 7 of 1930 ; also the Report of the Select Committee on the Bill which culminated in Act 7 of 1930 (this being the only Bill of the three for which a select committee was appointed) ; are all set out in an Appendix below.<sup>22</sup>

### Rules.

It will be noted that under Sections 57 and 77 (i) of the Act of 1911 certain powers were given to H. E. The Governor General to prescribe fees and to make Rules. In exercise of such powers certain Rules have been made. The first Rules originally made were known as the Indian Patents and Designs Rules 1912.<sup>23</sup>

Those Rules have now, since 1933, been replaced by other Rules being the current Rules which are known as the Indian Patents and Designs Rules 1933. These Rules came into force on 1st April 1933 ; and have legislative effect as if enacted in the body of the Indian Patents and Designs Act itself.<sup>24</sup> For purposes of reference a copy of the Rules is set out in an Appendix below.<sup>25</sup>

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<sup>22</sup> See Appendix No. 5 *infra*.

<sup>23</sup> First Published on 23rd September 1911, Gazette of India Part II.

<sup>24</sup> They were published on 11th February 1933 in the Gazette of India Part. II.

<sup>25</sup> See Appendix No. 5 *infra*.

**Act of 1911 and the Rules thereunder. The present system.**

It is the law now current in British India under this Act of 1911 as amended as above, with the Rules thereunder, and the Patent administration which is now in force by virtue of this Act and these Rules, which are to be considered in the following pages of this book.

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## CHAPTER II.

### EXTENT OF PATENT RIGHTS NOW OBTAINABLE IN BRITISH INDIA.

#### The Form of Letters Patent.

It may now be convenient for purposes of reference and comparison and as showing how modern Patent Law is developed from the historical origins, of which brief mention has already been made, to note here the usual form in which a Patent is now granted in England.

This reads as follows :—

“EDWARD VIII by the grace of God, of Great Britain, Ireland, and the British Dominions beyond the Seas, King, Defender of the Faith, Emperor of India. To all to whom these presents shall come greeting : *WHEREAS* ( name of Patentee) of (address) in the county of (etc.), (occupation), hath declared that he is in possession of an invention for (description of purpose of invention), that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief : *AND WHEREAS* the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention : *AND WHEREAS* the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of the said invention : *AND WHEREAS WE*, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request :

*KNOW YE*, therefore, that We, of our especial grace; certain knowledge, and mere motion, do, by these presents, for Us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee, by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United



Kingdom of Great Britain and Northern Ireland, and the Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of 16 years from the date hereunder written of these presents : *AND*, to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for Us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Northern Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of 16 years, either directly or indirectly, make use of, or put in practice, the said invention, or any part of the same, nor in anywise imitate the same, nor make, or cause to be made, any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned : *PROVIDED* always, that these Letters Patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking Letters Patent granted by Us, and the same may be revoked and made void accordingly : *PROVIDED ALSO* that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these Letters Patent, or in respect of any matter relating thereto, at the time or times, and in manner for the time being by law provided ; and also if the said patentee shall not supply, or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then and in any of the said cases, these our Letters Patent and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained : *PROVIDED ALSO* that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted : *AND* lastly, We do by these presents for Us, our

heirs and successors, grant unto the said patentee, that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee. *IN WITNESS* whereof We have caused these our Letters to be made Patent and to be sealed as of the                      day of                      , one thousand nine hundred and                      ”.

It will be observed that this form of Letters Patent consists when dissected of six different parts which may be referred to as follows :—

The address.

The recitals.

The grant of monopoly.

The prohibition.

The provisos.

The direction for the construction of the grant.

### The Address.

The address is a public address from the King to the public being worded “to all whom these presents shall come.” It is suggested by Hindmarch that the reason for this is that the Letters Patent contain a bargain between the public and the patentee. This view is stated, to quote his own words<sup>1</sup> as follows :—

“The only thing which a patentee gives to the public is a knowledge of his invention, and a patent is, in effect, a bargain between the patentee and the public, in which the public, in consideration of an invention, so that they may afterwards be enabled to practise it, grant to him the sole use of his invention for a limited time. But if an invention is not new, the patentee does not communicate anything to the public which they did not know before, and therefore the patentee gives them nothing which can be considered as a consideration for the grant, and therefore the patent is wholly void.”

Even apart from this it is natural that the address should be by the King to all his subjects since the Letters Patent not only contains a grant to the single patentee but a prohibition, necessary in order to make the grant effective, which is issued to all the public.

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<sup>1</sup> Hindmarch (1846) page 103.

### The Recitals.

The recitals contain what are called "the suggestions" which are deemed to have been made to the Crown as the basis of the representations on which the Patent has been granted. An analogy might be made with the proposal made by an assured to an Insurance Company as the basis on which a policy of insurance is issued. If a suggestion has been made which is false, the patent will be void : whether this has been made wilfully or innocently.

In this English form of Letters Patent it is seen that there are four separate recitals to the following effect :—

(i) That the Patentee has declared that he is in possession of an invention, that he claims to be the true and first inventor and that it is not in use by any other person to the best of his knowledge and belief.

(ii) That the Patentee has applied for a patent.

(iii) That the Patentee has particularly described the nature of the invention in a complete specification.

These first three recitals clearly indicate the representations and statements deemed to have been made by the Patentee.

(iv) That the Crown "being willing to encourage all inventions which may be for the public good" has out of such motives made the grant. This fourth recital is worded in the form of a declaration of what has been done by the Crown. In this it is the statement of the Crown's motive which is important. There may be said to be implied in this recital also a representation by the Patentee that the grant of his Patent will not be immoral or illegal. Under section 75 of the English Act of 1907-1932 which has its counterpart in section 69 of the Indian Act of 1911, the Controller is empowered to refuse a grant if contrary to law or morality.

By reason of these four recitals, also, the Patentee may be said to be deemed to represent that his invention is novel and in all respects the proper subject matter and material for a Patent and that it has been properly described. It will be observed on further consideration of such matters in another chapter that there are very definite requisites called for in respect of an invention and of the relative application for a Patent in order that an applicant may be properly entitled to a good Patent. In the absence of such requisites any Patent which may have been granted will be either invalid entirely or

of only partial validity. Whether it is more proper to say that in such a case the Patent is invalid because of the misrepresentations made by the Patentee concerning the necessary requisites or because without the existence of the necessary requisites the Crown has no proper prerogative to make a valid grant is for practical purposes immaterial. The practical result whichever way the matter is viewed is the same ; the complete or partial invalidity of the Patent.

### **The Grant of monopoly.**

This consists of the following words :—

*"KNOW YE*, therefore, that We, of our especial grace, certain knowledge, and mere motion, do, by these presents, for us, our heirs, and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee, by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make use, exercise, and vend the said invention within our United Kingdom of Great Britain and Northern Ireland, and the Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of 16 years from the date hereunder written of these presents :"

It should be observed, though obvious, that in spite of the above wording in the form of a grant, the Patentee himself was fully as much entitled to "make, use, exercise and vend" his invention before the grant as he is after the grant. He requires no "License, power, privilege or authority" to be granted him from the Crown to enable him to do this. The grant therefore in a sense is no grant at all in this respect ; and is no grant of any additional rights of property to the Patentee. The resulting monopoly which is given to the Patentee is made effective by the prohibition on others but himself. For this reason it has been said that a Patentee's rights constitute a mere chose in action and do not in the proper sense amount at all to any right of property.

### **The Prohibition.**

This consists of the following words :—

"And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for US, our heirs, and successors, strictly com-

mand all our subjects whatsoever within our United Kingdom of Great Britain and Northern Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of 16 years, either directly or indirectly, make use of, or put in practice, the said invention, or any part of the same, nor in anywise imitate the same, nor make, or cause to be made, any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

As previously observed the effective area of the prohibition is limited to the United Kingdom of Great Britain and Northern Ireland and the Isle of Man. The period of time is limited to 16 years.

### The Provisos.

It is essential for the proper understanding of Patent Law and Patent Rights to appreciate that the grant of letters Patent is not final or irrevocable.

It has been already indicated when considering the Recitals that the Patent may be at a future date held to have been invalid *ab initio* for lack of certain requisites called for in and concerning the invention itself.

The provisos also expressly indicate certain events in which a grant that may have been made will be held to be invalid. The whole essence of the grant of Letters Patent may be said to be that the grant is only made by the Crown, subject to the proviso that if thereafter it should be found that the circumstances in which the grant was made are proved to have been such that at the time no grant ought properly to have been made, then the Patent will be invalid and may be revoked. Also that the grant is only made by the Crown subject to the proviso that the Patentee will not abuse his monopoly rights given to him under the Patent ; and similarly that if he is proved to have abused his monopoly rights then these rights may be taken away from him and the Patent revoked. The grant is also only made subject to the proviso that the requisite fees are paid and if not the Patent will be revoked. The grant is also subject to the proviso that the Crown reserves to itself the right to grant licenses

in spite of the monopoly. This power the Crown is only likely to exercise either for use by contractors under Government departments or as a remedy against abuse of the monopoly by the Patentee in cases where it is proved that he is not himself manufacturing articles relating to his invention either in sufficient quantities for the good of the State and public service or at proper prices.

### **The Construction.**

After the provisos are found the following words :—

“And lastly We do by these presents for Us, our heirs and successors, grant unto the said Patentee, that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said Patentee”.

It may be remarked that this beneficial construction, for what it is worth, applies only to the Letters Patent and not to the specification.

### **Other forms of English Patents.**

The form of a Patent of Addition differs slightly in wording but not materially from the above.

The form of Patent which is granted under Section 91 of the English Acts 1907-1919 by way of reciprocal arrangements also differs slightly in the recitals.

### **The form of Letters Patent in India.**

The form in which a Patent is now granted in British India is as follows :—

## **“GOVERNMENT OF INDIA.**

### **Patent.**

No.....of.....19.....

Whereas A. B. of.....hath declared that he is in possession of an invention for.....(quote title) .....  
.....and that he is the true and first inventor thereof (or the legal representative or assign of the true and first inventor) and that the same is not in use by any other person to the best of his knowledge, information and belief.

And whereas he hath humbly prayed that a patent might be granted to him for the said invention.

And whereas he hath by and in his specification (of which a copy is hereunto annexed) particularly described and ascertained the nature of the invention and the manner in which the same is to be performed.

The Governor General in Council is pleased to order by these presents that the above said petitioner (including his legal representatives and assigns or any of them) shall, subject to the provisions of the Indian Patents and Designs Act, 1911, as patentee, have the exclusive privilege of making, selling and using the invention throughout British India (including British Baluchistan and the Santhal Parganas) and of authorizing others so to do for the term of sixteen years from the .....day of.....19.....subject to the condition that the validity of this patent is not guaranteed by Government and that Government shall have the right to use the invention either without payment or on such terms as it may consider reasonable) and also provided that the fees prescribed for the continuation of this patent are duly paid.

In witness whereof the Governor General in Council has caused this patent to be sealed as of the.....day of.....  
.....19.

Signature of Controller.....

Date of sealing.....

[Note.—*Renewal fees will be due on this patent, if it is to be continued, on the.....day of.....19.....and on the same day in each year thereafter.*”]

### Comparison of the Indian Form with the English.

#### The Address.

In the Indian form there is no address. It must be taken for granted.

#### The Recitals.

The general effect of the three recitals is the same in the Indian as in the English form.

It will be noted however that in the Indian form the following additional words are inserted:—“or the legal representative or assign of the true and first inventor”. The result may be some confusion as to who is the proper person to apply for a Patent. This matter is more fully considered in another place.

If the Indian form loses something in exactitude through the omission of the words—"the sole use and advantage of"—in the second recital, the sense remains the same.

The remaining differences in wording are chiefly due to there being in India only one specification and not, as under the English system, the possibility for a provisional specification as well as a complete specification.

### **The Grant of Monopoly : and the Prohibition.**

Though in less formal words, the Indian Form must be considered to have the same legal effect as the grant and prohibition of the English form taken together. The grant and prohibition are in the Indian form contained in the following words :—

"The Governor General in Council is pleased to order by these presents that the above said petitioner (including his legal representatives and assigns or any of them) shall, subject to the provisions of the Indian Patents and Designs Act, 1911, as patentee, have the exclusive privilege of making, selling and using the invention throughout British India (including British Baluchistan and the Santhal Parganas) and of authorizing others so to do for the term of sixteen years from the.....day of.....19.....".

### **The Provisos.**

It is important to observe that these provisos put in less formal language are to the same effect as those already discussed when considering the English form.

### **The Construction.**

The clause referred to in the English form as "the construction" is omitted from the Indian form. This therefore makes it unnecessary further to trouble with that somewhat obscure clause.

### **Period of Patent.**

The term of all Patents now granted in India is 16 years. This is as provided by Section 14 of the Indian Patents & Designs Act of 1911 and amended by Section 9 of the Indian Patents & Designs (Amendment) Act of 1930 (Act 7 of 1930).

Before the Act of 1930 the term was 14 years. The amending Act of 1930 came into force from 1st July 1930. By that Act it was also provided that the period of 16 years should also be the period of operation for any existing patents which were unexpired on 1st July



1930. Also that existing licenses should similarly be extended if the licensee so desired. These and certain other provisions are now embodied in subsections (1), (1A), and (1B) of Section 14 of the present Act as amended.

A patent is made automatically to cease if the prescribed fees are not paid within the prescribed times. But provision is made in the Act for an extension of time in such a case up to a maximum period of three months on application to the Controller made within three months after such expiration of time.<sup>2</sup>

In the case of patents of addition such patents are, unless converted into original patents, only effective for the period for which the patent for the original invention remains in force and no longer. See section 15 of the Act. (Further reference to patents of addition will be found under the chapter dealing with application for patents.)

#### **Curtailment of term.**

After a Patent has once been granted it can only be terminated before the expiry of its full term in the following ways :—

- (i) It may cease for non-payment of fees : (under Section 15.)
- (ii) The Patentee may offer to surrender the Patent. This may be done at any time by giving notice to the Controller. Revocation under these circumstances if made is made by the Controller : (under section 24 of the Act.)
- (iii) The Patent may be revoked by order of the High Court made on application for revocation. Such revocation can only be granted for the grounds stated in section 26. Such application may apparently be made in India at any time during the currency of the Patent. But it can only be either by the Advocate General or any person authorised by him or by certain persons who allege themselves to be interested in the matter in certain circumstances as stated in the section.
- (iv) The Patent may be revoked on the ground that the demand for the patented article in British India is not being met to an adequate extent and on reasonable terms, or, (but in this case only if the requisite application is

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<sup>2</sup> See Section 14 *ibid*.

made after four years from the grant of the Patent) on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside British India. The application for revocation in either case is required to be made to H. E. the Governor General in Council. Revocation under these circumstances if made is made by H. E. the Governor General in Council : (under section 22 or section 23 of the Act).

- (v) Provision is also made under the Act for power for the Patent to be revoked on public grounds. This is under section 25 the wording of which is as follows :—

“A patent shall be deemed to be revoked if the Governor General in Council declares, by notification in the Gazette of India, the patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public”.

#### **Extension of Term.**

In exceptional cases the term of a Patent may be extended. Application for this purpose is required under the Act to be made to H. E. the Governor General in Council. He may then either dispose of the application himself or refer it to a High Court for decision. (See Section 15 of the Act.) The main ground contemplated for the prolongation of a Patent in this way is that the Patentee has not been fairly remunerated by his Patent.

#### **Territory over which the Patent is effected.**

A Patent sealed with the seal of the Indian Patent Office confers on the Patentee the exclusive privilege of making, selling and using the invention throughout British India and of authorising others to do so : British India for this purpose includes British Baluchistan and the Santhal Parganas : and the territory covered extends also to the Shan States.

See Section 1 (2) also section 12 of the Act : also the model form of Patent quoted above.

The extension to the Shan States was made under the Burma Laws Act 1898 as amended by Regulation II of 1910. The notice effecting such extension which was published in the Burma Gazette dated 6th September 1919 Part I page 696 and the Indian Gazette dated 18th October 1919 Part II page 1778 reads as follows :—

“In exercise of the powers conferred by section 10 of the

Burma Laws Act, 1898, as amended by Regulation II of 1910, the Lieutenant-Governor is pleased to extend to the Shan States the Indian Patents and Designs Act, 1911 and the Rules thereunder, subject to the following modification :—

### Modification

If any proceeding is taken in respect of an infringement in the Shan States of a patent, which antedates the extension of the Indian Patents and Designs Act, 1911, to the said Shan States, against any person who may have availed himself of the subject matter of that patent before the lapse of one year from the date of the extension, the Court before which the proceeding is taken, may, if it thinks fit, refuse to award any damages in respect of such infringement.

By order, C. M. Webb, Chief Secretary to the Govt. of Burma.  
(Dated) RANGOON, The 5th September 1919”.

### Difference between Patent Rights and certain other exclusive rights.

In all cases where there is in existence a copyright, or a trade-mark, or a registered design, or where under the common law any particular manufacturer or merchant has acquired a reputation for a specific and distinctive get-up under which his goods are marketed, a certain person, that is to say, the owner of the copyright, or of the trade-mark, or of the registered design, or the person who has acquired the reputation in respect of the particular get-up, as the case may be, is entitled to certain exclusive rights of manufacture or sale or both : just as, where there is in existence a Patent, the Patentee is entitled to certain exclusive rights of manufacture or sale or both. Exclusive rights such as those now under consideration would not appear to be obtainable except for : (1) copyright, (2) trade-mark, (3) registered design (4) distinctive get-up such as to sustain an action at Common Law for Passing-off and (5) for a Patent. But the nature of the rights and the circumstances in which and the subject matter over which such rights are obtainable differs in each of these cases.

The right in the case of copy-right and in the case of a distinctive get-up such as to sustain an action for passing-off is not an artificial right but a right of property held by the individual at Common Law. The right is created under natural force of law as soon as the thing or chattel to which the right relates is created :

precisely as the legal rights of a parent over an infant are created as soon as the infant has life. The right in the case of a registered design or Patent or in the case of an English statutory trade-mark is an artificial right (created by Statute or grant of Letters Patent) which does not come into existence with the creation of the mark or design or invention but only after registration of the trade-mark or design or after grant of Patent.

Patent rights are granted from the Crown by virtue of its inherent prerogative; they are now granted according to certain well defined regulations in accordance with certain Statutes; in this sense Patent rights are purely statutory since no individual possesses them inherently by virtue of any inherent right of private property before grant. In another sense Patent rights do not depend upon Statute since the Crown has and has always had an inherent power to confer these rights before any Statute existed and they depend therefore in essence on the will of the Sovereign. Trade-mark rights are purely the creation of Statute. In India there is no Trade Mark Act: consequently in India there are strictly speaking no Trade Mark rights, such as are conferred by Statute in England and the person using a Mark in India is relegated to such rights as he may possess at Common Law as a result of the building up of a reputation. The legal right which comprises "Copyright" being a right of private property owned by the individual as a part of his inherent rights at Common Law, needs neither statute nor grant from the Crown or from anybody for its creation. As soon as any thing susceptible of being the subject of copyright is brought into existence, the right of copyright is simultaneously and automatically brought into existence. Copyright is as much a part of a new book as its cover or its title; just as much as, say, the right of inheritance belongs to a new-born child without grant from the Crown or any Statute. The extent of this copyright is now also largely regulated by Statute. Regarding rights relating to Passing-off, the exclusive right in commerce to a particular form of get-up for particular goods such as is required to sustain an action for passing-off against a competitor is a right which arises, when it arises at all, without grant and without the aid of any statute at Common Law. It is only created in certain circumstances and, in particular, only if a certain special reputation has in fact been created then the owner of the reputation is automatically possessed of certain rights at Common Law which

protect him against interference from competitors by passing-off. Unlike copyright it cannot be said to be strictly a right of property. Thus the origin of the exclusive right in the case of a Patent Right is in the Crown's prerogative ; in the case of Statutory Trade-Marks is in the Statute ; in the case of Copyright this is in a right of personal property at Common Law but regulated by Statute ; and in the case of rights relating to Passing-off these rights have their origin in the Common Law not as rights of property but as personal rights, similar to the personal rights which an individual has against being run down in the street.

Regarding the nominal period of currency of these various exclusive rights, Patent Rights run for 16 years ; statutory Trade-Mark rights in India, being non-existent for no period ; Copyright for a period up to 25 years after the death of the author ; and Passing-off rights (including common law rights in trade-marks) continuously as long as the existence of the requisite reputation.

The Patent Rights begin from the date of the grant of Patent : Statutory Trade-Mark rights in England from the date of registration : Copyright from the date of publication : while Passing-off may in a sense be said to begin from the date of the creation of the required reputation.

### **Importance of the effect of the grant of a Patent.**

It is the monopoly and the certainty of the monopoly for a fixed time and place which is the outstanding benefit obtainable by taking out a Patent for an invention. In no other way can an inventor arrive at such an advantageous legal position except by obtaining a Patent. The Patentee through his grant not only requires a passive legal right to a monopoly which authorizes him to hold a monopoly : the law also gives him an active right to prevent others from encroaching on his monopoly. When the time, that is 16 years, in which the monopoly will run with certainty is considered as a period in proportion to a man's life, for example the life of the inventor, it is appreciated that it is no small period for the protection of an invention. When the area over which the monopoly will run, that is to say the whole of British India which is in the neighbourhood of 1,096,000 square miles, is considered in proportion to the whole inhabitable world it is found to be no mean territory over which an Indian Patent gives its protection.

If by obtaining an Indian Patent the benefit of a monopoly may be obtained over a sales territory comprising approximately one seventh part of the world's inhabitants,<sup>3</sup> who may conceivably be every one a prospective purchaser, is it good business for the inventor or the business man to leave the Patent Law and the system of Patent Administration in India uninvestigated ?

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<sup>3</sup> The population of the world being taken at about 1,997,000,000 and the population of British India being taken according to the 1933 census at 271,526,933.

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## CHAPTER III.

### CONDITIONS IMPOSED ON THE PATENTEE.

Having taken a general view in the previous chapter of the scope of the benefits obtainable by a Patentee from the holding of a Patent, it will be convenient now to note broadly the extent of the conditions imposed on a Patentee and the obligations and duties to be fulfilled by him on his side during the continuance of the grant. It will be possible then to judge in any given circumstances whether a particular invention is worth patenting. In many cases it is likely that a prospective Patentee will be surprised at the large scope of the benefits and the lightness of the obligations.

The only conditions imposed by the Crown on the Patentee for the continuance of the grant of the Patent to him are of two kinds. For one thing, in order to prevent abuse by him of his monopoly, certain obligations are imposed upon him making it necessary in certain events that he will either work the Patent himself or allow others to do so. For another thing certain taxes are levied from him which are known as renewal fees.

#### Terms as to Compulsory working.

Since one of the chief objects of any Patent system is to promote new inventions in the country to the benefit of its people, it is clear that this object is entirely defeated if after grant of a Patent to any individual that individual then takes no further interest or action. The result then would be, if the Patentee does not work and sell his invention or arrange for this, no one in the country might do so. So far from adding to the wealth or comfort of the public, the thing sought to be added would be placed under total prohibition throughout the length and breadth of the country. It is clearly desirable that there should be some provision of law which will prevent or discourage Patentees from leaving their Patents to lie fallow in such way.

Different countries favour different systems. It may be that with peoples of different habits and different states of culture the same provisions of law will have widely different effects. The policy

of Patent Law in any country ought to be that best suited to effect the biggest development and best use when developed of all inventions for the benefit of that country. The best means of doing this may be found to vary among different peoples.

Certain features of the problem are these. After an inventor first receives the grant of a Patent it is bound to take him some time before the invention can be put on the market effectively. Arrangements not only have to be made for manufacture, which may entail considerable work, and for negotiations in his getting in touch with the right persons to work the manufacture, and, possibly, for various negotiations as to the licenses or other terms on which the manufacture is to be done; but arrangements will also have to be made, whether by the inventor or by the manufacturer, for making the invention sufficiently known for a demand to be created. In any case it may be to a considerable degree a question of time before the invention becomes known: this will be so even if the inherent merit of the invention is such that the finished article will to some extent sell itself. Hence it is clear that if the Government of a country were to impose too severe terms in respect of compulsory working of the invention immediately from the grant of the Patent, the only result would be that in many, if not most, cases the invention would never be worked at all but merely abandoned: the practical result being the same as, or worse than, if no provisions for compulsory working were put in operation at all.

In India the provisions directed to ensuring the working of Patents granted are on lines similar to the provisions which have been evolved from experience of such legislation in England. The Patentee is allowed a period of four years almost entirely free from any compulsion; during which period (except for one minor exception) no complaints can be made against him by anyone for his idleness, and no steps can be taken by anyone against him on the ground of his non-working of his Patent. After these four years if he continues to fail to work his Patent, provision is made under the Act for persons interested to make complaint to the Governor General in Council for certain remedies to be enforced against him. The remedies provided under the Act are of two kinds: the one is by way of total revocation of his Patent, the other by the ordering of the issue by him of compulsory licenses in respect of his Patent to a Petitioner. The circumstances in which either of these reme-



dies may be enforced are described in Sections 22 and 23. These remedies will only be applied under section 22 where it is found that the demand for the patented article in British India is not being met to an adequate extent and on reasonable terms. It will be observed, after a petition has been lodged every opportunity is given to the Patentee to come to an arrangement with the aggrieved party ; and that no order will be made and in fact the Petition is not to be adjudicated upon if the parties come to such an arrangement between themselves. It will also be observed that the more drastic remedy of revocation is not to be resorted to except where it is found that the issue of compulsory licenses will not suffice. It will be observed that it is necessary for the party aggrieved to establish a case that a trade or industry in British India is being prejudiced under section 22 ; or else that the Patented article or process is carried on or manufactured exclusively or mainly outside British India under section 23.

Revocation under either section can in no case be ordered before the expiration of four years from the date of the Patent ; nor can the alternative remedy by issue of compulsory licenses be enforced before such four years in any case where the ground of complaint is manufacture outside British India under section 23. It appears that there is no protected season in which the filing of petitions for compulsory licenses is forbidden where the ground of complaint is that a trade or industry has been unfairly prejudiced under section 22. Section 23A gives statutory efficacy to any order which may be made under section 22 or section 23.<sup>1</sup>

The scale of Renewal Fees now in force in British India under the Act is to be found in the first schedule to the Rules made under the Act : this first schedule was enforced under the authority of a Notification by the Governor General in Council No : A-197 dated 17th July 1930. The scale is as follows :—

For the 1st, 2nd, 3rd and 4th years after				
the date of the Patent.	...	...		Nil.
Before expiration of 4th year in respect of				
the 5th year	...	...	...	Rs. 50 0 0

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<sup>1</sup> These matters are further considered in Chapter VIII and Chapter XI.

**Terms as to Renewal fees.**

Before expiration of 5th year in respect of the 6th year ... ..	Rs.	50	0	0
Before expiration of 6th year in respect of the 7th year ... ..	Rs.	50	0	0
Before expiration of 7th year in respect of the 8th year ... ..	Rs.	50	0	0
Before expiration of 8th year in respect of the 9th year				
In respect of patents the application for which was made before 1st July 1930 ...	Rs.	50	0	0
or, In respect of patents the application for which was made on or after 1st July 1930	Rs.	100	0	0
Before expiration of 9th year in respect of the 10th year ... ..	Rs.	100	0	0
Before expiration of 10th year in respect of the 11th year ... ..	Rs.	100	0	0
Before expiration of 11th year in respect of the 12th year ... ..	Rs.	100	0	0
Before expiration of 12th year in respect of the 13th year :— ...				
In respect of patents the application for which was made before 1st July 1930 ...	Rs.	100	0	0
or, In respect of patents the application for which was made on or after 1st July 1930 ...	Rs.	150	0	0
Before expiration of 13th year in respect of the 14th year :—				
In respect of patents the application for which was made before 1st July 1930 ...	Rs.	100	0	0
or, In respect of patents the application for which was made on or after 1st July 1930 ...	Rs.	150	0	0
Before expiration of 14th year in respect of the 15th year ... ..	Rs.	150	0	0
Before expiration of 15th year in respect of the 16th year ... ..	Rs.	150	0	0

The fees for two or more years may be paid in advance.

The above are the Renewal Fees which have to be paid by any Patentee in India so long as his Patent is current. No other fees are payable by him during its currency.

It will be observed that, as in the case of the provisions in force to effect compulsory working (by compulsory licenses or revocation), so with the renewal fees; the Patentee is given the benefit of a protected season of four years after the grant of the Patent during which he is entirely free from having to pay any renewal fees.

### Statutory authority.

Section 57 of the Act is the Statutory authority under which these fees are payable. The section makes obligatory in respect of the grant of patents "such fees as may be prescribed by the Governor General in Council"; subject to a proviso that the fees so to be prescribed shall not exceed a certain maximum scale of fees which is referred to in the section and set out in a Schedule to the Act itself.

Thus no alteration of the renewal fees now in force which should go beyond the maximum scale could be effected except by an Act of the Central Legislature in the form of an Act amending the Act of 1911: any alteration within the limits of the maximum scale could be effected by an executive order of the Governor General in Council.

The maximum scale referred to by Section 5 is as follows :—

#### FEES.

On application for a patent	...	...	Rs.	10
Before sealing a patent	...	...	Rs.	30
Before the expiration of the 4th year from the date of the patent	...	...	Rs.	50
Before the expiration of the 5th year from the date of the patent	...	...	Rs.	50
Before the expiration of the 6th year from the date of the patent	....	...	Rs.	50
Before the expiration of the 7th year from the date of the patent	....	...	Rs.	50

Before the expiration of the 8th year from the date of the patent ... ..	Rs. 100
Before the expiration of the 9th year from the date of the patent ... ..	Rs. 100
Before the expiration of the 10th year from the date of the patent ... ..	Rs. 100
Before the expiration of the 11th year from the date of the patent ... ..	Rs. 100
Before the expiration of the 12th year from the date of the patent ... ..	Rs. 150
Before the expiration of the 13th year from the date of the patent ... ..	Rs. 150
Before the expiration of the 14th year from the date of the patent ... ..	Rs. 150
Before the expiration of the 15th year from the date of the patent ... ..	Rs. 150
Provided that the fees for two or more years may be paid in advance.	
On application to extend the term of a patent ...	Rs. 50
Before the expiration of each year of the extended term of a patent or of a new patent granted under section 15 ... ..	Rs. 150

It will be seen that the scale now actually in force is in only certain few instances lower than the maximum scale.

### English Scale.

For purposes of comparison it may be of interest to note the scale of renewal fees which are payable on English Patents under the English Act in the United Kingdom. The English scale of renewal fees is as follows :—

### Renewal Fees.

Before the expiration of—						£.	s.	d.
4th year from the date of Patent, and in respect of the 5th year						5	0	0
5th "	"	"	"	"	6th "	6	0	0
6th "	"	"	"	"	7th "	7	0	0
7th "	"	"	"	"	8th "	8	0	0

8th year from the date of Patent. and in respect of the 9th year						9 0 0
9th	"	"	"	"	"	10th " 10 0 0
10th	"	"	"	"	"	11th " 11 0 0
11th	"	"	"	"	"	12th " 12 0 0
12th	"	"	"	"	"	13th " 13 0 0
13th	"	"	"	"	"	14th " 14 0 0
14th	"	"	"	"	"	15th " 15 0 0
15th	"	"	"	"	"	16th " 16 0 0

In England there is a further provision in force under which if the Patentee notifies the Patent Office that he desires his Patent to be endorsed "Licenses of Right", the renewal fees which become subsequently payable are only half the amounts stated in the above mentioned English Scale.

There is no similar provision in British India for Licenses as of Right or for the endorsement of a Patent in that manner ; or for such reduced fees.

#### **General considerations affecting scale of renewal fees.**

The imposition of renewal fees and the provision that if the fees are not paid the patent will cease may be looked upon as a desirable means in the public interest of preventing the continuance of useless patents. If a patent is unremunerative and useless to its owner, it is unlikely that he will continue to pay the renewal fees. Thus the patent is wiped off the books without waste of time and labour. This may save the country from having to employ such additional officials as might otherwise have to be employed in connection with the records of a mass of useless patents. It also ensures that the register is an effective one showing for the most part effective patents only. It also ensures that whatever benefit may exist in relation to inventions which do not form the subject of continuing effective patents, falls back at once into the stock of public knowledge and is available for public use. As soon as the renewal fees are high enough for this, they are high enough altogether from the point of view of mere jurisprudence. Apart from this it may be considered from an economic point of view desirable for the renewal fees to be fixed at a height which with other Patent fees will be enough to pay for the upkeep of the Patent Office. It may well be contended by patentees that renewal fees need in any event not be raised beyond this point. It is natural

however for any Chancellor of the Exchequer or Finance Member to regard such renewal fees as a potential source of additional public revenue. It would seem that in England Patent fees not only pay all expenses of the Patent Office but do supply a considerable contribution to the public revenue.<sup>2</sup> In British India also fees collected in respect of Patents more than pay for the cost of upkeep of the Indian Patent Office; as may be seen from a perusal of the Annual Reports of the Patent Office for recent years. These figures are interesting as showing the following nett profit to Government by excess of income over expenditure in respect of the Indian Patent Office : *viz* :—

Income of Patent Office including fees & sales		Expenditure of Patent Office including salaries, printing etc.		Profit to Govt. from Patent Office.	
Rs.		Rs.		Rs.	
1929.	2,04,003- 6-0	82,919-	5- 4	1,21,084-	0- 8
1930.	2,05,363-13-0	1,02,662-	0- 1	1,02,701-	12-11
1931.	1,91,420- 3-0	93,500-	10- 1	97,919-	8-11
1932.	1,89,388-14-3	80,790-	5-11	1,08,598-	8- 4
1933.	1,93,142- 0-0	83,304-	12- 2	1,09,837-	3-10

From any point of view there must be a limit beyond which the imposition of higher fees must tend to lower the annual total of new Patents applied for as well as the number of Patents annually renewed. It may be a matter of great importance also during which period of the life of the Patent the heaviest fees are levied. It is believed that when in the United Kingdom by the Act of 1883 the initial fees payable on grant of Patent were reduced by more than five sixths, though the total fees were only reduced by about one eighth, the effect was that the number of applicants for Patents was immediately trebled.

It is no doubt fair that the higher fees should only be charged

<sup>2</sup> The corresponding figures for the English Patent Office were :—for 1933 :—total income £588,836-4-4 of which receipts for Patents fees alone were £503,846-18-6, total expenditure £415,076-3-7, profit £173,760-0-9 : and for 1934 :—total income £629,547-5-9 (an equivalent of about Rs. 81,84,111-0-0) of which receipts for Patents fees alone were £540,780-18-3, (an equivalent of about Rs. 76,30,153-0-0) total expenditure £416,835-13-3 (an equivalent of about Rs. 54,18,868-0-0), profit £212,711-12-6 (an equivalent of about Rs. 27,65,253-0-0).

after the Patent has had time to reach the stage of being a profit-making concern.

The method in force in the United Kingdom of halving the fees where the Patent is endorsed "Licenses of Right" also appears to be a fair scheme for reducing the amount of tax payable by the Patentee and might with advantage be adopted in India.

### **Consequences of non-payment.**

When renewal fees become payable, it is essential for the Patentee to pay these fees, if he desires the continuance of the Patent; and to pay them punctually within the time allowed him. Failure to pay causes automatic termination of the Patent under section 14(2) of the Indian Act by which it is provided as follows:—

"A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times :

"Provided that where the patentee, before, or within three months after, the expiration of the time for payment, applies to the Controller for an extension of time by any period not exceeding three months, the patent shall, on payment of such additional fee as may be prescribed, be continued or revived, as the case may be, during, but not beyond, the period of extension applied for".

There is no penalty for the non-payment of any renewal fee. Nor is it any sort of an offence. The Patentee can cease to pay the renewal fees at any time: with the consequence only, as stated above, that the Patent then automatically ceases.

### **Extension of time for payment.**

Extension of time may be obtained up to a limit of three months as is clear from section 14(2) above. Additional fees chargeable for such extension of time are :—

Rs. 10/- for one month.

Rs. 20/- for two months.

Rs. 30/- for three months.

The application for extension of time is to be made on a standard Form, being Form No. 4.\*

### **Method of payment of the renewal fees.**

Rule 5 of the Indian Patents and Designs Rules 1933 governs

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\* See *infra*.

the method of payment of these as of other fees. The second part of this rule reads as follows:—

“Fees may be paid in cash at the office, or may be sent by money order or postal order or cheque payable to the Controller at Calcutta. Cheques not carrying the correct addition for commission, and other cheques on which the full value cannot be collected in cash within the time allowed for payment of the fee, shall be accepted only at the discretion of the Controller. Stamps shall not be received in payment of fees”.

For further instructions Patentees will find the following directions given in the Patent Office Handbook (5th edition) at page 115 by the Controller of Patents for the assistance of persons paying fees:—

“Fees. The fees prescribed in the 1st Schedule to the Indian Patents and Designs Rules, 1933, should be paid in the manner prescribed in rule 5 of the said Rules. Where cheques are offered in payment of fees, it must be clearly understood that the Office cannot hold itself responsible for any delay that may occur in the collection of cash on the cheques; any cheque not payable in Calcutta is subject to commission for which due allowance should be made. In cases where it is not possible to have the fees handed in at the Patent Office, it is preferable to send them by money-order or postal order payable at Calcutta to the Controller of Patents and Designs, and to advise him that they have been so sent.

Stamps will not be received in payment of fees.

A proceeding in respect of which a fee is payable shall be of no effect unless the fee has been paid.

Fees prescribed in the Act and the Rules are paid in respect of admitting the applications or requests accompanying the fees and not in respect of the final orders granting such applications or requests. If the applications or requests are refused the fees in respect of the same will not be refunded”.

### **Qualifications of the Patentee.**

What personal and other qualifications are required in an applicant in British India for a Patent are considered in a subsequent chapter.



## CHAPTER IV.

### COMMERCIAL FACTORS ARISING WHEN DECIDING WHETHER TO APPLY FOR A PATENT—RISK OF RELYING ON MERE SECRECY OF THE IN- VENTION—VALUATION OF AN INVEN- TION—VALUATION OF A PATENT —ACTUAL VALUES OF PAT- ENTED INVENTIONS.

It may not be out of place now to consider certain matters relating to the grant of any Patent from a business rather than from a legal point of view. It may be that business factors even more than such matters as were mentioned in the last two chapters, will affect the mind of a person contemplating making application for a Patent ; and it may be only after the consideration of these matters that he will come to a decision whether or not he will take out a Patent for a particular invention. These considerations will also weigh with the Patentee when coming to any decision about the disposal of his Patent : as they will affect the decision also of any man of business who may be considering the acquisition of a Patent from the holder.

#### **Secrecy.**

The advantage to the inventor of his invention is in his being able by means of the invention to do something or make something, or do or make something better or more quickly or more cheaply than other people working without his invention. Therefore if no one else knows the secret of the invention, every one except the inventor is lacking this advantage. Therefore the inventor may think that the maximum possible advantage will accrue to him simply if he keeps his invention a secret. But this is to overlook the practical aspect of the matter. That view might be well enough if the inventor intended to do the whole manufacturing of the article, that is to say all over the world, himself, or if he were to be content to profit only from whatever he could himself manufacture. But a moment's reflection shows that it is very seldom that an inventor is

in the best position to be his own manufacturer. If he is not, then it becomes necessary for him to transfer his secret to a manufacturer. Without such transfer he can make nothing : neither the article which is to be the fruit of his invention nor any profit. To effect any such transfer he must first disclose his invention to the transferee at least. In practice he will be required to disclose his secret to other persons besides the transferee, and there will be inevitable discussions. The transferee will wish to discuss the matter with his technical advisers, or with his partners, or his legal advisers as the case may be. Any discussion will be futile without full knowledge of the invention itself. One of the greatest difficulties to be overcome by the inventor in real life is, after discovering the invention, to discover the manufacturer and the best man or men to market the manufactured article : the person who will become the transferee or licensee. In the natural course of events the person who will be in the best position to manufacture the invention will be found among persons who are already manufacturing on a large scale goods of a similar nature ; since it will be by improvement on such goods that the profit, if any, is to be made and since these will be the people who will be in closest commercial touch with the consuming market. It will only be by advertising the invention among these persons, or at least after several preliminary discussions with different individuals among them, that the best person may be found and the best terms may be made to enable that person to take up the invention. These are the very people who in the natural course of events will also be, if they do not take up the invention, the inventor's most keen rivals and most formidable competitors.

Thus it is inevitable, in cases where the inventor is not going to be his own manufacturer, that he will be required, in the course of negotiating the manufacture, to disclose his invention to those very persons who are most likely to be his competitors. There is no possibility then of his relying on keeping his invention secret in such cases.

Apart from this again, while he is the owner simply of an invention unprotected by the Patent Law, it is totally impossible for the inventor to have any effective commercial or legal dealings with his invention. Having for the reasons already mentioned, no legal rights in his invention other than what he may acquire under the Patent Law Statutes he clearly cannot effect any effective transfer or

assignment of these rights under English Law. He does not appear to be in any better position under Indian Law in this respect. It is true the Indian Act appears to contemplate the assignment of an unprotected invention.<sup>1</sup> But in any case the inventor who has purported to transfer his unprotected invention to one individual can have no remedy whatever against other persons to whom he has not transferred it, if they manufacture or imitate it. Clearly the individual transferee also can then have no remedies against such other persons. From a commercial standpoint then clearly no purported assignment at this stage by the inventor of his unprotected invention is of any business value, since the inventor cannot give the buyer any general rights worth buying.

In the same way the inventor, as long as he is in the position of having only the secret of an unprotected invention, is in no position to be able to arrange any commercially effective licenses or other terms.

It is obvious then, at least in cases where the inventor is not going to manufacture the article himself, that secrecy is in almost every instance for him neither possible nor desirable.

Even in cases where the inventor is his own manufacturer, it will be found in practice that secrecy for him is seldom if ever possible or desirable.

The very nature of the majority of articles which can be the result of an invention, it will be realised, is, in far the greater number of cases, such that the nature of the invention is at once apparent from an inspection of the manufactured article. In all such cases there is no possibility of the inventor keeping his invention secret.

In a very few instances, as where the invention consists of a method of manufacturing an emulsion or the emulsion itself or other special chemical methods of preparing some composition, it may be that not only will the invention not be obvious from a mere cursory view of the manufactured article, but even chemical analysis and microscopic examination will not reveal the secret of the invention. In such case the position will then be this. Let us suppose the inventor manufactures his product according to a process which he keeps secret. All the time he is doing this he is dependent on the integrity of his employees. If one of his employees shall disclose

<sup>1</sup> See Sec. 3 of the Act of 1911.

the secret to one of the inventor's competitors, the inventor will have no remedy against that competitor if that competitor manufactures the same product according to the precise process which has till then been the inventor's secret. Also there is nothing to prevent every competitor from carrying on his own research work and as soon as one or more such competitors discovers this same process, which in most instances will be merely a matter of time, there will be nothing to prevent any one or all of them from manufacturing under what has been hitherto the original inventor's secret process.

What is more, suppose the same state of things : the original inventor has been manufacturing some commodity under a secret process for say, 5 years : a competitor by dint of independent research discovers the same process. Now suppose this competitor makes an application for a Patent. What then ? It may be very doubtful in any particular case whether such previous 5 years manufacture in secret will be held to be any bar to the application for Patent by the new comer. Even if it be so, the original manufacturer will need to give full particulars of his secret in order to make any effective opposition to the grant. If the application for Patent is refused it can only be on the ground of prior user, or prior knowledge. This will mean that after the application has been made and refused, all the world, as well as both the first and second inventor, will be able to use the same process ; so all advantage to the original inventor will be gone. If on the other hand the application is granted and a Patent issued to the newcomer, the original inventor as long as the Patent remains in force will be completely ousted ; and neither he nor anyone else except his competitor will be able to continue manufacture.

Even in a case where the new application for Patent does not cover precisely the same ground as the hitherto secret invention, it may become necessary for the original inventor to disclose the whole of his secret process if he wishes to oppose the grant of that part of the new application which affects him.

It is practically impossible for him to make any effective opposition to the new application on the ground of prior user or prior knowledge without disclosing his secret. The alternative is that if he continues to keep his secret, he will be helpless to prevent the new Patent being granted to the new applicant and he will then be ousted from the fruits of his invention : he will be able to do

nothing but watch the new man enjoying and exploiting what might have been his own monopoly.

Thus even in cases where the inventor will be his own manufacturer it is seldom if ever that secrecy, even if attainable, is of any real or lasting protection to the inventor.

Other than secrecy the only means by which the inventor can obtain any protection at all for his invention is by obtaining Letters Patent. It is obvious therefore, though inventors in India do not appear as yet to have grasped the full importance of this, that where an Inventor has any new invention which has marketable value, the only way for him to obtain any protection for his invention is to take out Letters Patent.

The only question then is what is the value of the invention and whether it is worth the cost, often slight, of obtaining the requisite Patent. For this it is necessary to make some estimate of the probable or potential value of the invention as well as some estimate of the probable expenses of obtaining the Patent.

#### **Commercial value of the Invention and Patent.**

The commercial value of the invention together with the Patent is the crux of the matter to the inventor.

It will be as well for him at an early stage as soon as he has got his invention completed to collect as much material information as possible in regard to costs of working, sale price, output and profits on the one hand in respect of similar articles in use prior to his invention ; and on the other hand in respect of the new article which is proposed to be marketed after embodying his invention. In this way he may arrive at some definite figures, however approximate, of an estimated valuation of his invention.

#### **Difference between value of the invention and value of the Patent.**

Whatever approximate figure may have been arrived at as representing an estimate of the valuation of the Invention it must not by any means be concluded that this same figure represents the true commercial valuation of any specific Patent which may be obtained in respect of that invention.

The invention and the Patent though connected are two totally different things<sup>2</sup>. The invention is that which creates the possibility

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<sup>2</sup> An invention in Patent Law is a term ordinarily restricted to an invention as

of commercial profit if the inventor is allowed the security of a monopoly for making that profit from the invention. The Patent is that which gives him the security. The invention, however good in itself, without a Patent may be valueless : for if all the world can make the product arising out of the invention and compete with the inventor he may be able to do nothing but sell below his cost price and be driven out of business. The effect of a bad or ineffective Patent may be as disastrous as having no Patent at all ; if it fails to give any protection. In either case though the invention may have been rightly valued as very profitable at a large figure, the Patent in respect of that invention may be found to be of much less value or none at all. On the other hand, if the invention itself has no potential commercial value, no patent, however effective, which is obtained for it can increase its value : nor can the Patent in such case be of any value. Thus an effective Specification and Patent may be viewed commercially as an effective policy of insurance against loss of profits. It cannot create profits if none are inherent in the invention : but it can secure them if they are.

If an invention is valued and a figure of estimated profit calculated, though nothing can be added to this figure for a Patent which reaches perfection in its degree of effectiveness, nothing need be subtracted : the full valuation of the invention can be taken as the commercial valuation of the patented invention. For the same invention if a less effective Patent only is obtained, then to arrive at a valuation of the patented invention a subtraction will require to be made from the figure taken as the potential value of the invention. To reduce the matter to business terms an illustration may be given in rupees in this way. Take a small invention of such a nature that if you have the monopoly of it after it has become widely known in the market it will yield a profit of Rs. 6000/- per annum. Say it takes 2 years before any profit can be made and the expenses of putting it on the market can be cleared : and that in the next 4 years an average profit of Rs. 3000/- per annum may be made and after that for the next 10 years an average profit of Rs. 6000/- per annum. Over a period of 16 years those

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described and de-limited in a particular Patent specification. Here in this chapter however the term is used as referring broadly to the inventor's idea in the abstract for his invention prior to any specification being made or independently of any specification.

figures give a total potential profit of Rs. 72,000/-. That is an estimate only of potential profit. Unless the protection of an effective Patent can be obtained to give you your monopoly, there can be no security that even Re. 1 profit out of that estimated Rs. 72,000/- will in fact be made. If a Patent is obtained for that invention to give a watertight monopoly then the value of the patented invention may be taken at the full figure of Rs. 72,000/-. If the Patent which is obtained does not give a watertight monopoly, but, while restricting the sale by competitors of certain articles, leaves the door open for the sale by competitors of other products differing only slightly from the inventor's product ; and if half the persons who would buy the inventor's product, if it were alone in the market, buy the competing product instead, then the actual profit will be reduced by half; and the valuation of the patented invention will be not Rs. 72,000/- but Rs. 36,000/- at the most. Again if the loss of effectiveness of the Patent is considered to be greater and the risk of unchecked competition larger, the valuation of the patented invention may be more correctly stated at a much smaller figure, possibly Rs. 5,000/-, as a figure representing the profit to be made before sales become checked by competition from the sales of substitutes or in other ways.

#### **Estimated Valuation of the invention.**

The following are two alternative methods of valuation.

As stated by Haddan the estimated commercial value of the invention is "the value of the superior efficacy of the invention over the best of its competitors, in each instance of its employment, multiplied by the number of instances of its employment or likely employment, and the time during which it is likely to have preeminence".<sup>3</sup>

Or, in other cases, such as where the product is for domestic or personal use or use where from its nature buyers will pay a price for it which has no connection with the cost of its production or with the cost of competing articles, then its estimated selling value less the cost of its production and distribution, multiplied in the same way for output and period of demand.

#### **Risks of interference in the future by new substitutes.**

A prophetic estimate of the extent of future competition is

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\* See Haddan's Compendium of Patents and Designs (1931-edition) p. 37.

necessarily one of the most hazardous elements which go to make up a valuation of an invention. But an allowance for such competition must be considered : ever though it may turn out that the chief competition will come from substitutes which were not even in existence or thought of at the time when the valuation was made. The extent of this competition may greatly affect the "time during which the invention is likely to have preeminence" in the formula mentioned above. The true value of an invention for the windows of Hansom cabs might have been a large figure in the year 1883 but only a small figure in the year 1913 when hansom cabs were on the verge of being replaced by Taxis.

#### **Limits of "the invention" to be valued.**

When valuing the invention on the lines suggested above it is necessary that great caution be shown in one direction. Nothing must be included for valuation as part of the invention which is not novel ; since protection can only be obtained for such parts of the invention as are novel and can constitute the subject matter of a Patent. Considerations regarding what inventions can and cannot be patented are further discussed in a subsequent chapter.

#### **Valuation of a Patent.**

Enough has been said to show that it is extremely difficult to calculate any precise valuation for any patented invention ; or to foresee how much profit may accrue from it. A great deal depends on circumstances in the future, which it may be extremely difficult if not impossible to foresee. However, it may be of some assistance to note here certain features in which different Letters Patent may be efficient or inefficient in securing the desired monopoly for any invention. This has nothing to do with the value of the invention in itself.

#### **Exactitude in describing the nature of the invention.**

When a man has made an invention and subsequently obtains a Patent, nothing is protected by the Patent except the thing or things claimed by the Specification. The Patent Office has no knowledge of any invention that the inventor has actually made beyond what is described in the Specification. This is the first intimation received by the Patent Office and the only description with which it is concerned of the invention. To take an extreme case : if one machine is invented by an inventor and actually made as a model by



him in the course of perfecting his invention ; if another machine, though never made, is described in the Specification, it is the machine in the specification which is protected by a Patent if a patent is granted. It is natural and inevitable that this must be so : since neither the Crown granting the Patent, nor its agents in the Patent Office Department through whom the work in connection with the grant and registration of the Patent granted is done, nor the other subjects of the realm who are enjoined by the Patent to refrain from the use, manufacture and sale of a particular thing, have had any notice of any invention other than what is described within the limits of the Specification filed.

It may at first sight seem unlikely that a different invention should come to be described in the specification to that actually discovered by the inventor. But this is in fact by no means a rare occurrence. The necessity for careful, accurate and effective draftsmanship in the wording of the Specification at once becomes obvious. Since the Patent may be valueless if it does not describe the invention which the inventor wishes to be described, and may lose value in degrees proportional to its inexactitude, one feature which must be taken into account in the valuation of the Patent is the accuracy of the Specification in describing the invention required.

### **Exactitude in describing the limits of the monopoly.**

In addition to accuracy in describing the nature of the invention, it is also necessary that the Specification should be accurate in describing the limits of the monopoly claimed. The former is necessary so that the public may be enabled without doubt or inconvenience to make the invention after the period of monopoly has expired. The latter is necessary so that the public and in particular competitors of the Patentee may be informed without doubt what they may not make during the period that the monopoly is current. Inaccuracy of description in either respect may be equally fatal to the validity of the Patent and equally damaging to its value : since it may then be found invalid for insufficiency of description.

### **Freedom from other past patents.**

However competent and accurate the draftsman of the Specification may be, it is by no means always open to him to claim a Patent for the whole of what the inventor wishes to claim as his invention. The purported invention as described by the inventor must be

examined in the light of previous Patents to see how much of it, if any, is free from all previous Patents. Also how much of it, if any, is clear of all previous common or public knowledge. Similarly some inventions are of such subject matter as cannot in law be validly patented. Only that portion of the inventor's actual invention which is clear of these obstacles can be validly Patented. (For further consideration of these matters see Ch. VI). Normally where possible all such considerations will have been fully gone into by the draftsman of the Specification before the application for the Patent will have been filed ; and only a Patent of which the claims are not too wide will have been applied for and granted.

In this respect also the need for efficient work in drafting the Specification must be emphasized ; and the manner in which the degree of efficiency with which such work is done may affect the final commercial value of the Patent. It must be fully understood by every inventor and by every person who may be in any way financially interested in a Patent, that owing to the essential nature of any Patent system it is quite possible and indeed common for a Patent to be granted which after grant, in the event of certain steps being taken, may be found to be partially or even wholly invalid and ineffectual. The full appreciation of this is fundamentally essential for the understanding of anything to do with the practical working of any Patent as well as of the scheme of Patent Law as a whole.

### **Freedom from interference by future Patents.**

What has been discussed up to now is matter which relates to an investigation of the effectiveness of the Specification, and therefore of the Patent, in its purpose of creating a monopoly for the desired invention which will be watertight as the specification stands at the time of the application. The considerations for the commercial valuation of the Patent however do not end there ; and the future also be allowed for.

To take an illustration. Suppose a Patent has been valued on the basis that in the period of the Patent 10,000 patented articles will be sold at a clear profit of Rs. 5 each, making an estimated profit of Rs. 50,000. These calculations, let us suppose, are made on the footing that the Patent will create an absolute monopoly for the article in question and that there is no impinging on this Patent by any prior Patents or by any prior knowledge. Now suppose that is

so and there are in fact no attacks made on the validity of the Patent and that it in all respects gives a watertight monopoly for the article in question. For all that, the hoped for profits will never be made, if, after the patented article is well established in the market, some competitor brings out a Patent for something which may be sufficiently differently constructed to justify a separate Patent yet successfully replaces the patented article.

Of course if the new competing invention is totally different from the original one, then no amount of skill and ingenuity will avail to frustrate the grant of a Patent for the new competing invention. On the other hand if the Specification for the original Patent is drawn with foresight and real skill it may be found that by it a protection may be achieved not only for the precise invention as it stands at the time of application but for considerable modifications thereof which may not have been fully envisaged at the time of the application. In this way the new inventions of competitors at a later time may be found to be covered by the Specification as well as the particular article originally put on the market. In this way the field of new competing patents may be cut down.

Though it is difficult if not impossible to foretell the degree of danger likely to arise from substitutes, whether patented or unpatented, being put on the market, yet it is obvious that the degree of broadness or narrowness of a Patent in this respect is a matter to be taken into full consideration in arriving at any valuation of such Patent.

#### **Necessity for expenditure in connection with Key patents or other Patents relative to the manufacture in question.**

Another matter may here be mentioned. It not infrequently happens that a Patent may be taken out which is highly valuable but which cannot be worked except in conjunction with other Patents. In such case arrangements will have to be made either for the purchase of those other Patents or for obtaining licenses in connection with them. This will then be an item of expenditure for which allowance must be made on the debit side in arriving at any valuation of the original Patent.

#### **Allowance for the Contingent nature of the Grant of any Patent.**

The point cannot be over-emphasised that the Crown, when it grants a Patent, in no sense guarantees the validity of such Patent.

It will be seen hereafter that even after grant circumstances may arise enabling an opponent of the Patentee in certain contingencies to obtain the revocation of the Patent : either by instituting, on his own initiative, revocation proceedings, or by taking the plea that the Patent is in truth invalid by way of defence when the patentee brings an infringement suit against him. The contingencies in which a Patent may in this way be held to be invalid even after grant are considered in another chapter.

Until it is attacked the Patent will stand effective. If there is considered to be no prospect of any opponent attacking it in this way after grant the risk of the patent being upset after grant need not be taken into account in valuing the Patent.

In other cases the risk has to be taken into account before arriving at a valuation of a patent.

In most cases the risk is small. It may be treated as almost negligible where a very thorough search has been made for all possible anticipations and has resulted in a report that the field is clear of any possibility of the existence of any effective anticipations.

In other cases the risk may be very great : as where no thorough search has been made concerning the possible existence in India of previous specifications or of other matters which may afterwards be relied on by an opponent as having been anticipations existent at the time of grant and sufficient to invalidate the Patent in question.

The Patent Office itself makes certain searches prior to the Patent being granted. In the United Kingdom these searches are, as is required under the English practice, of a very thorough nature ; and may therefore be relied on to great extent as showing how far the field is clear of possible anticipations. In India in practice such thorough searches cannot at present be made at the Indian Patent Office ; and the mere fact that no anticipations have been cited as a result of the Patent Office search should not be relied on as conclusively establishing their non-existence.

For these reasons it is highly advisable, before any attempt is made to arrive at a practical commercial valuation of any Patent, that a thorough investigation should first have been made to ascertain to what extent the scope of the claims stated in the Patent may have been impinged upon by other prior patents or by other matters

of prior public or general knowledge and to ascertain in fact what possible matters of anticipation are in existence. From what has been said it is seen that if the Patent is otherwise valuable it will be advisable for such an investigation and report to be made by an expert Patent Agent.

After such investigation and report have been completed it will be necessary to estimate broadly what risk there is of the validity of the Patent for any reason being at any later date successfully attacked.

**Final commercial value of a patented invention as a whole.**

Though it may be impossible to fix any precisely exact figure, the different considerations discussed above will be required to be weighed up both for the value of the invention in itself and for a view of the effectiveness of the Patent on the basis of its Specification in giving the necessary protection ; and finally a rough estimate may be made of the commercial value of the patented invention as a whole.

**Cash values paid for patented inventions in certain recent instances.**

Since all transfers of Patents or grants of licenses in respect of Patents require to be entered in the Register of Patents and the amount of the consideration paid and received in any such transaction is also entered in that Register, ample examples may be found in the Register to show cases where considerable cash values have been put by the parties concerned on various Patents and high prices paid.

In many instances where an interest in a Patent is transferred, only a partial interest is transferred while the remaining part of the ownership or interest is kept by the holder. In many instances where Patents are commercially exploited with success the ownership of the Patent is retained by the holder while a license only is granted to some other manufacturer or merchant. In such cases the figure entered in the Register of Patents as the consideration for the transaction represents only a fraction of the amount at which the parties themselves must have valued the whole patented invention.

In other instances the consideration paid in cash is a merely nominal figure and can hardly be taken as any real indication of the true value of the patented invention. Such cases may natu-

rally arise where for reasons connected with Company Law or otherwise a legal transfer is necessitated, but where owing to the business relationship of the parties there is no need for any payment in cash of the full actual value of the invention. Nevertheless in certain instances a sum in cash representing a sum which may be taken to have been considered by the purchaser as the full value to him of the patented invention is not infrequently paid and consequently recorded in the register.

It may be of interest and not out of place here to cite the following instances of transfers of patents and of the amounts of the relative consideration in each instance from among certain cases mentioned in the Annual Reports of the Indian Patent Office.

Examples :—

In 1930 :—

- (1) A group of 5 patents relating to electric welding was assigned for a consideration of £ 2,500.
- (2) A patent relating to cop-winding frames was assigned for a consideration of £ 5,000.
- (3) A group of 3 patents relating to emulsions was assigned for a consideration of Rs. 40,000.
- (4) A patent relating to rail clip was assigned for a consideration of £ 1,000 plus an annual royalty.
- (5) A group of two patents relating to safes was assigned for a consideration of Rs. 10,000.

In 1931 :—

- (1) a patent relating to casting rice bowls, cooking pans, etc. was assigned for a consideration of Rs. 10,000.
- (2) a patent relating to liquid steam levellers, was assigned for a consideration of Rs. 3,000.
- (3) a group of four patents relating to scutching and spinning machines, was assigned for a consideration of Rs. 2,000 in respect of each patent.
- (4) a patent relating to bituminous concrete, was assigned for a consideration of £ 100.

In 1932 :—

- (1) a licence in respect of a group of four patents relating

to aircraft and aeroplanes was granted to the Secretary of State for a consideration £ 15,000 ;

- (2) a patent relating to telephone systems was assigned for a consideration of £ 500 ;
- (3) a patent relating to rotary looms for textiles was assigned for a consideration of £ 250 ;
- (4) a patent relating to cigarette making machines was assigned for a consideration of £ 225 ;
- (5) a group of six patents relating to means for securing rails to railway sleepers was assigned for a consideration of £ 1,250 ;
- (6) a patent relating to a process for preparing insecticides was assigned for a consideration of \$ 500 ;
- (7) a patent relating to upholstery pads was assigned for a consideration of Rs. 1,500 ;
- (8) a patent relating to a process of conveying pulverised materials, and another relating to hollow blocks for building construction were assigned for a consideration of £ 100 each ;
- (9) an exclusive license in respect of a patent relating to the production of glass filaments, was granted for a consideration of £ 100.

In 1933 :—

1. An exclusive license in respect of a patent relating to “apparatus for operating railway signals” was granted for a consideration of Rs. 2,000 in addition to royalties.

2. An exclusive license in respect of a patent relating to “clarification of water” was granted for a consideration of Rs. 1,000 in addition to royalties.

3. A patent relating to a “device for the prevention of back fires in gas apparatus” was assigned for a consideration of £ 100.

4. An exclusive license in respect of a group of 3 patents relating to “painting colours and processes” was granted for a consideration of Rs. 500 in addition to royalties.

[These few examples will be enough to show that patented inven-

tions in India can reach high valuation figures and can command substantial prices.]

Nevertheless the difference between the low values and small numbers of assignments recorded in India and the high values dealt in England is very marked. It must be expected that as industrial development in India increases and as the value of the protection afforded in India to manufacturers and merchants through the holding of letters patent becomes more widely recognised, the prices which good Patents will command on assignment will also greatly increase.

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## CHAPTER V.

### THE SYSTEM OF ADMINISTRATION OF THE PATENT LAW IN INDIA—THE PATENT OFFICE—THE FUNC- TIONS IN THE SYSTEM OF THE CONTROLLER— AND OF H. E. THE GOVERNOR GENERAL— AND OF THE COURTS—PATENT AGENTS— THE COST OF OBTAINING A PATENT.

It will be convenient in this chapter to take a view of the working of the Patent Office and of the system of administration of the Patent Law in British India. An appreciation of this institution and of the system is essential for the application in practice of any principles of Patent Law which are hereafter discussed. This will at the same time serve to show the extent of the service which is furnished to Patentees in particular and to the public in general by the State through its Patent Office Department ; if they care to avail themselves of it.

#### Creation of the Patent Office in British India.

Previous to the 1911 Act, that is to say under the system in force under the Act of 1888, the position was that there was no Patent Office proper in India, no Controller of Patents and no such thing as an Indian Patent properly so called. Protection of a sort was given under the Act of 1888 for what were termed "exclusive privileges" ; but both the method of their grant and of their operation, as well as the system of recording matters in connection with these exclusive privileges, were not altogether satisfactory either for the Inventor or for the public.

It was by the Indian Act of 1911<sup>1</sup>, which was modelled on the English Statute of 1907, that Indian Patents were created and given legal effect; and that an Indian Patent Office proper and a Controller of Patents in British India were appointed.

#### The Patent Office.

The Patent Office for the whole of British India is situated at

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<sup>1</sup> For the Objects and Reasons of the Act 1911 which have been given in full for ease of reference, see *infra*, App. No. 5.

1 Council House Street, Calcutta. There is a public room attached to the Patent Office where the Public may ask for and read such of the books and documents kept at the Patent Office as under the rules of the Patent Office are available to the Public. As stated in the current Patent Office Hand book the office hours during which the Patent office and its public room are open are from 11 A.M. to 4 P.M. on all days except Saturdays, Sundays and Government holidays ; and from 11 A.M. to 1 P.M. on Saturdays.

**Publications issued by and kept at the Patent Office.**

The following publications are issued by the Patent Office as stated in the Patent Office Handbook<sup>2</sup> :—

- (i) The Patent Office Handbook.
- (ii) Gazette of India, Weekly Notifications of the Patent Office.
- (iii) The Patent Office Journals.
- (iv) Inventions (Consolidated Subject-Matter index, Name index and Chronological lists)
- (v) Specifications of Inventions.
- (vi) Annual reports on the working of the Patent Office.

The Patent Office Handbook contains in Part I the full text of the current Acts and Rules affecting Patents, including the Indian Patents & Designs Act of 1911 as amended, the Indian Patents and Designs Rules 1933, the Indian Secret Patents Rules 1933 and the Special Patent Rules promulgated by the Government of India in 1912 for the Military and Marine Services : and in Part II various useful information for the guidance of inventors and others in regard to Patents in general and various matters connected with Applications and Specifications, the preparation of Drawings, Searches at the Patent Office and various other proceedings.

The publications in the Gazette of India published as the Weekly Notifications of the Patent Office are described as follows :—

“The Weekly Notifications contain lists of applications for Patents made and accepted weekly, giving the names of the applicants and titles of the inventions together with brief summaries indicating the nature of inventions in respect of the accepted applications. The Notifications also show whether patents are due for

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<sup>2</sup> Patent Office Handbook (5th Edn.) p. 147.

sealing or have been sealed or have been continued in force or have lapsed ; in addition they include notifications of other matters of current interests in respect of patents and designs. A name index of the applicants and provisional subject matter index of the inventions, so far as they can be ascertained from the titles given in the applications for patents, are included in the Notifications at the end of each quarter."

Of the Patent Office Journals it is said :—"The Patent Office Journals are published annually. The quarterly issues which were published for some time have been discontinued now. The essential part of the information given in the Weekly Notifications is condensed in the Annual Journals, which contain inter alia—

- (a) A Chronological list of applications for patents made during the previous two years :

The Chronological list contains, the serial number of the applications, the names of applicants the titles of the inventions, information regarding priority dates, the progress of the application, and a brief statement of the subject-matter of those inventions in respect of which the specifications are open to public inspection.

- (b) A list of applications which have become void, on account of the applications not being accepted within the prescribed time and of applications on which patents have not been sealed within the prescribed time ;
- (c) A list of special proceedings under the Indian Patents and Designs Act taken during the previous year ;
- (d) A list of patents in force on the 31st December of the previous year ;
- (e) A subject-matter index of the applications given in the chronological list.
- (f) A name index of the applicants for patents included in the chronological list."

"The annual Journals were printed in this form only from 1905 onwards. Before that year there were a number of printed indexes extending back to 1859, containing merely an alphabetical index of the applications and specifications filed during each year. Most of these indexes are out of print, but may be seen at the Patent Office.

For Patents from 1856 to 1888 recourse should be had to the Registers kept under the Acts then in force.”

The details of the different lists comprising the “Inventions Consolidated Subject-Matter Index, Name Index and Chronological Lists” which have been compiled are given thus :—

- “(a) Consolidated list of patents granted by the Government of India from 1859 to 1874 inclusive, arranged alphabetically according to the names of the inventors and the subject-matter of the inventions ;
- (b) Consolidated subject-matter index from 1900-1908.
- (c) Consolidated Name index from 1900-1911 and Chronological list from 1900-1904 ;
- (d) Consolidated subject-matter index from 1900-1911 and chronological lists from 1905-1911 ; and
- (e) Consolidated subject-matter and Name Indexes from 1912-1920 and Chronological list of application from 1912-1920.

These Consolidated Lists contain all the useful information contained in the Annual Journals for the period covered by them, and are more convenient than the Journals for purposes of search.”

Particulars of the Specifications of Inventions are stated as follows :—“Specifications which are open to public inspection under the Indian Patents and Designs Act, 1911 have been printed since the 1st January 1912. Specifications of inventions which have been notified in the Gazette of India, as filed under the provisions of the Inventions and Designs, Act (V of 1888), are not printed, but copies may be inspected on payment of a fee of one rupee in respect of each specification at the Patent Office, 1, Council House Street, Calcutta, the Record Office, Egmore, Madras, the Record Office, Bombay, the Office of the Chief Secretary, Home and Political Departments, Government of Burma, Rangoon, and the Office of the Director of Industries, United Provinces, Cawnpore.”

The Annual Reports of the working of the Patent Office contain usually the following information : details of the personnel and organisation of the staff of the Patent Office during the year : a summary of the numbers of Patent Applications made during the year with comparative comments and remarks as to the direction of the trend

of inventions during the year: a summary of other miscellaneous proceedings decided or effected by the Controller and the Patent Office in general: general remarks as to other matters which came up for consideration during the year: and figures giving the total income and total expenditure of the Patent Office during the year: also finally, in the Appendices, various interesting statistics showing an analysis of the origin of applications received giving the numbers from different countries and from different provinces and the numbers emanating from Indians, non-Indian residents in India and from persons outside India, also a table showing the total number of Patents applied for and sealed yearly, and the number kept in force in the year under review by payment of renewal fees and subsisting as effective; also details of Patents prolonged. The report also contains a very complete analysis of the Patent fees received which (together with Designs fees) amount to the figure representing the total income of the Patent Office.

#### Inspection of publications.

The above publications may be inspected free of charge at the Patent Office. They may also be inspected free of charge at the following places which are referred to in the Patent Office Handbook as "Inspection Centres": *viz* :—

Bangalore	...	...	Indian Institute of Science.
"	...	...	Industrial Museum in the Office of the Director of Industries and Commerce in Mysore.
Baroda	...	...	Department of Commerce and Industries.
Berlin	...	...	The Patent Office.
Bombay	...	...	Record Office.
"	...	...	Victoria Jubilee Technical Institute, Byculla.
Calcutta	...	...	Library attached to the Office of the Director of Industries, Bengal, 40/1A, Free School Street.
Cawnpore	...	...	Office of the Director of

			Industries, United Provinces.
Dacca	...	...	Sadar Registration Office.
Delhi	...	...	Office of the Industrial Surveyor.
Lahore	...	...	Punjab Public Library.
London	...	...	The Patent Office, 25 Southamptom Buildings, London, W. C.
Lucknow	...	...	Amiruddaula Public Library.
Madras	...	...	Record Office, Egmore.
"	...	...	College of Engineering.
Patna	...	...	Office of the Director of Industries, Bihar & Orissa.
Poona	...	...	Lord Reay Industrial Museum, Reay Market Tower, Shukrawarpeth.
Rangoon	...	...	Office of the Chief Secretary Home and Political Dept. Government of Burma.
Washington (U. S. A.)	...	...	The Patent Office.

Those of the above publications other than the printed specifications may also be inspected free of charges at the Imperial Library in Calcutta, or in London at the Office of the High Commissioner for India, India House, Aldwych, London, W. C. 2.

#### **Purchase of publications.**

The publications of the Patent Office, including printed specifications, may be purchased from the Central Book Depot of the Government of India, 8, Hastings Street, Calcutta ; or from the Manager of Publications, Old Press Buildings, Civil Lines, Delhi ; or (except as to printed specifications) from the office of the High Commissioner for India, India House, Aldwych, London, W. C. 2.

**Additional publications available at the Patent Office.**

The following publications in addition to those abovementioned are kept available for inspection on request by members of the public at the Patent Office Library in Calcutta.

- (i) Copies of all publications issued by the United Kingdom Patent Office. These include among other things, copies of full Specifications for Patents granted in the United Kingdom.
- (ii) Copies of the Journals issued by the Australian Patent Office.
- (iii) Copies of the Weekly Gazettes issued by the United States Patent Office (Abridgements.)

**Registration.**

One of the most important requisites of any Patent administration in any country is that there must be an effective central system of registration. The Patent Office (in Calcutta) is the registration centre for all India. Under Sections 20 & 33 of the Act of 1911 it is provided that a Register of Patents shall be kept at the Patent Office. In this register are to be entered in effect the following :—

- (i) Name and addresses of patentees.
- (ii) Particulars of assignments and transfers of patent.
- (iii) Particulars of licenses granted.
- (iv) Particulars of amendments, extensions and revocations.
- (v) Also particulars of mortgages if the mortgagees so desire  
(See Section 64.)
- (vi) Copies of any decrees and orders made by the Court under Section 29 or under Section 26, that is to say in suits for infringement or in suits for revocation.

Section 64 provides for entries being made in the register on the application of assignees, mortgagees or licensees or persons otherwise entitled to any interest in a patent.

It is also provided by Section 20 that the register of patents shall be prima facie evidence of any matters directed or authorised under the Act to be inserted in the register.

As an indication of the volume of work entailed by such registration it may be mentioned that according to the Annual Report of

the Patent Office in India for the year ending 31st December 1933 there were in that year 4,292 entries made in the Register of Patents.

### **Powers and duties of the Controller.**

For a view of the extent of the powers and duties of the Controller it is proposed to consider these first in connection with the grant of a Patent following the sequence of proceedings which may arise in respect of an application for a Patent chronologically, and then in connection with other matters *seriatim*.

### **Powers and duties of the Controller in connection with the grant of a Patent.**

The total number of Applications filed at the Indian Patent Office in the year 1934 was 1,006 inclusive of reciprocity applications and of applications for Patents of Addition. This figure is sufficient to show the weight and importance of the work which passes through the Indian Patent Office. At the same time for purposes of comparison it may be of interest to note that the total number of Applications for English Patents filed at the United Kingdom Patent Office in the year 1934 was 37,408.<sup>3</sup>

(i) *Application for grant* :—The Controller receives all applications<sup>2</sup> for the grant of a Patent. Where necessary he may call for further particulars, for identification or for proof that the applicant is such legal representative or assign as he may state himself to be, or for drawings or models or samples.

As to this see Sections 3 & 4 of the Act. Also Rule 3 : directing that the application may be sent by hand or by post addressed to the Controller.

(ii) *Examination of the application by the Controller* :—On receipt of an application the Controller is bound to make an examination thereof in terms of Section 5 of the Act. The topics to which he is required at this stage to direct his attention are in effect the following :—

- (a) The sufficiency of the title of the application. (Section 5 (1) (c).)

<sup>2</sup>See the fifty-second Report of the Comptroller-General of Patents, Designs, and Trade-Marks for the year 1934.

<sup>3</sup>As to the forms prescribed for applications see Forms Nos :—1, 1A, 1B, 1C, 1AC, 1BC, 1CC, 2, 2A, 2C & 2AC *infra*.



- (b) Proper compliance with the regulations for the preparation of the application, specification and drawings. (See sub-section (b))
- (c) Fair description of the invention (See sub-section (a)).
- (d) Sufficiency of the definition of the invention (See sub-section (d))
- (e) That the Specification only relates to one invention. (See sub-section (f).)
- (f) Novelty. (See see-section (e).)

If the application does not fulfil the requirements referred to in Section 5, the Controller may at this stage either refuse to accept the application or require amendments. The Controller has also a general power under Section 69 to refuse to grant a patent of which the use would, in his opinion, be contrary to law or morality.

(iii) *Notice of the decision of the Controller to accept any application ; or to refuse to accept it ; or to require its amendment :—*As already indicated the Controller's decision is required to be given on the application at this stage. The normal period ordinarily taken for the investigations required and for the design to be given may be reckoned in usual practice to be about three months reckoned from the time of submitting the application, when the decision is to accept the application. Notice of such acceptance is required to be given by the Controller to the applicant.

(iv) *Advertisement of acceptance of the application :—*Such acceptance is then required to be advertised : under Section 6 of the Act. (Section 6 provides that the application and specification with the drawings (if any) shall (after that) be open to public inspection. The practice is that the specification and drawings are printed and on sale at one rupee per copy about six weeks later.

*In the absence of opposition—then sealing and grant :—*If no notices of opposition are received within the period allowed, all further opposition at this stage is precluded. Then the Controller will proceed to seal and grant the Patent. (As to this see further remarks below.)

In the event on the other hand of opposition then the following steps become necessary.

(v) *Notices of opposition to the grant :—*The Controller receives

all notices of opposition to the grant of any Patent. After the date of the advertisement of the acceptance of an application, a period of four months is allowed during which anyone may on the grounds mentioned in Section 9 of the Act, but on no other ground, give notice that he wishes to oppose the grant of the proposed Patent. The nature of the grounds on which such opposition at this stage may be made and a comparison of the corresponding provisions of the English Acts of 1907—1932 is more fully discussed in another Chapter.

Where such notice of opposition is received at the Patent Office the Controller is required to give notice thereof to the applicant. (See Section 9(2) and Rule 20 and Form No. 6).

(vi) *Adjudication of the Controller on opposition to the Grant* :—On the expiration of the four months already mentioned in the event of any opposition to the grant the Controller is required to make a decision on the matter. For this purpose he will if so desired hear both the applicant and the opponent. Under Section 65 of the Act the Controller is given the powers of a Civil Court for the purpose of receiving evidence and administering oath and enforcing the attendance of witnesses and compelling the production of documents and awarding costs. It is therefore open to the Controller if the parties do not wish to be heard to decide the matter on the written documents. Or, if the parties wish to be heard, or if the Controller so desires, the matter will be decided before the Controller in all respects like a Civil Suit in a court of law. The procedure regarding his adjudication is that laid down under Rules 20, 21 and 22. If the Controller decides in favour of the opponent, he will then and there refuse the grant. No advertisement or further proceedings will then be required.

(vii) *Sealing of the Patent* :—If the Controller decides in favour of the applicant for grant, then the Controller proceeds in due course to cause the patent to be sealed (See section 10). Since it is provided under Section 10 of the Act that the patent shall be granted subject to such conditions (if any) as the Governor General in Council thinks expedient, it will be required of the Controller formally to submit the matter to the Governor General before the Patent is sealed.

**Patent of addition.**

The procedure in connection with an application for a patent of addition which is authorised to be granted in accordance with Section 15A of the Act of 1911, is in practice similar to the procedure in connection with any fresh Patent.

**Powers and duties of the Controller in connection with the restoration of Patents.**

It is provided by Section 16 of the Act that, where any patent has ceased owing to the failure of the Patentee to pay any prescribed fee within the prescribed time, the Patentee may apply to the Controller.....for an order for the restoration of the Patent.....

The Controller accordingly receives all such applications for restoration.

On receipt of such an application the Controller is required to examine it to ascertain that the omission to pay the fee was unintentional or unavoidable and that no undue delay has occurred in the making of the application. It would appear that the Controller is not given power under the Act to entertain or allow any such application when the omission to pay the fee was intentional and avoidable and where there has been undue delay. But this may be a matter for construction of the meaning of the section if the point should arise. The section makes no provision for such eventuality : but merely directs advertisement and the procedure in proper cases. The section does not expressly give the Controller power to reject an application without advertisement in cases where the omission to pay the fee is intentional and/or avoidable or where there has been undue delay, but it may be supposed that this is the effect of the section. In a proper case the Controller is then required to advertise the application in the Gazette of India (See section 16(3) and Rule 26.)

After the date of the advertisement a period of six weeks is allowed during which any person may give notice that he wishes to oppose the restoration of the lapsed Patent. (See Rule 27.) Where such notice of opposition is received, the Controller is required to make a decision on the matter. The procedure regarding his adjudication is governed ( in the same way as the procedure of opposi-

tion to a grant of a Patent ) by Section 65 and by Rules 20, 21 and 22.

The Controller will then make an order either dismissing the application made for restoration or restoring the Patent unconditionally or if he deems it advisable, restoring the Patent subject to conditions or restrictions. (See section 16.)

#### **Powers and duties of the Controller as to amendment of Patents.**

In any case, except in cases when any suit or proceeding for infringement or for revocation of the Patent is pending before a Court, it is always open for the applicant for or holder of a Patent to apply to the Controller for amendment of his application or specification as the case may be. Except where litigation is pending as mentioned, any application for such amendment is to be made to the Controller ; and no one else has power to order the amendment.

In cases where the application for amendment is made before the application for Patent has been accepted, no notice of the application for amendment is required to be given by the Controller to anyone : no formalities are necessary : the Controller simply decides *ex parte* on the application for amendment whether and subject to what conditions (if any) the amendment shall be allowed.

In other cases where the application for amendment is made at any time after the application for Patent has been accepted procedure with advertisement and notice, similar to that procedure already mentioned, is prescribed. On receipt of the application for amendment, the Controller is required to advertise by notifications the request and the nature of the proposed amendment in the Gazette of India. The Controller may also direct the applicant to advertise his application under rule 45 in which event the applicant must so advertise in not less than two newspapers published in British India. The Controller is also required (under Rule 20) to give notice of the application for amendment to all persons whose names are entered at the time of the request on the Register as claiming an interest in the Patent.

After the date of the advertisement three months are allowed in which any person may give notice that he wishes to oppose the amendment. The Controller receives any such notice of opposition. On receiving it the Controller is required to give notice of the opposition to the person applying for the amendment.

After the expiry of the three months mentioned the Controller is required to adjudicate on the matter. The procedure for this is regulated in the same way as for other proceedings before the Controller which have been previously referred to and is governed by Rules 20, 21 & 22. (See also Rule 23 and section 95) It is for the Controller to decide in all such cases whether the amendment requested is to be allowed or refused.

### **Hearing.**

It will be observed that in respect of all three of the above-mentioned instances, that is, in opposition proceedings under Section 9, in restoration proceedings under Section 16 and in amendment proceedings under Section 17 as is provided by rules 20, 27 and 31 respectively, the Controller will hear the case ; and the procedure of such hearing will be that regulated by Rules 20, 21 and 22.

### **Powers and duties of Adjudication and decision in other instances.**

In addition to the three instances above referred to the Controller has powers on certain other occasions to adjudicate and come to a decision on questions affecting the parties. Thus under Section 5(2) he has the power and duty to decide whether he will accept or refuse the applicant's application and specification at that stage ; under Section 10(1A) he has certain powers and duties to come to a decision on certain questions as to whether the grant shall be made jointly or not ; under Section 24 he has powers to allow the surrender of a patent ; and under Section 69(1) he has power to refuse to grant a patent of which the use would, in his opinion, be contrary to law or morality. It is to be noted that by Section 67 of the Act of 1911 it is provided as follows :—

“67. Where any discretionary power is by or under this Act given to the controller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of an application or of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.”

By Rule 64 it is also provided as follows :—

“64. The time within which a person entitled under Section 67 of the Act to an opportunity of being heard shall exercise his option of requiring to be heard shall be

one month from the date of a notice which the Controller shall give to such person or his agent before determining the matter with reference to which such person is entitled to be heard. If within that month such person or his agent requires to be heard, the Controller shall appoint a date for the hearing and shall give ten days' notice thereof.

Provided that if the giving of ten days' notice would cause an application for a patent or for the registration of a design to become void before the hearing the Controller may curtail the period of notice."

It would seem that this section read in conjunction with this Rule may be treated as applicable to cases where the Controller comes to a decision in the instances abovementioned. There is no precise procedure laid down under the Act or the Rules for the conduct of the hearing of the matter, if there is to be a hearing, in such cases. Rules 20, 21 & 22 are nowhere made applicable as regulating the procedure for a hearing in such cases. It would seem that there is nothing to prevent the Controller following a procedure as nearly similar as feasible in the circumstances to that provided by Rules 20, 21 & 22 in such cases if a hearing is necessitated. It would seem, equally, that there is nothing to prevent the Controller, provided he complies with Rule 64, in such cases from adopting a less lengthy and more summary procedure in arriving at his decision. In this respect the power given to the Controller under Rule 65 may be noted, by which he is enabled to call for a statement or explanations. Rule 65 reads as follows :—

"65. Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a time to be notified by the Controller, or to attend before him and make explanations with respect to such matters as the Controller may require."

#### **Powers and duties of the Controller on applications for surrender of Patents.**

Section 24 of the Act is as follows :—

"24. A patentee may at any time, by giving notice in the prescribed manner to the Controller, offer to surrender his patent, and the Controller may, if after giving notice of

the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent."

All offers to surrender a patent are to be made to the Controller. It is not precisely laid down what notice the Controller is to give, or to whom, but it may be supposed that in any case where there is any possibility of objection, the application will be advertised. He will then either dismiss the application or make an order for revocation of the Patent.

**Ministerial duties in connection with adjudication and decisions by the Court or by H. E. the Governor General in Council.**

In addition to the powers and duties already indicated the Controller has also certain duties which may be regarded rather as administrative and ministerial than judicial in connection with the procedure for securing a decision on certain other questions which, if they arise, are required under the Act to be decided by authorities other than the Controller himself. Thus in the case of an application for a compulsory license or revocation under Section 22 (on the ground that the demand for a patented article is not being properly met in British India) the decision is required to be given by H. E. the Governor General in Council ; similarly in the cases of an application for the extension of the term of a patent, the petition is under Section 15 of the Act to be made to H. E. the Governor General in Council himself or referred by him to a High Court for decision ; so also in the case of the disposal of appeals from decisions of the Controller where such right of appeal is granted under the Act, the decision is required to be given by H. E. the Governor General in Council (see Section 70) ; but in such cases in accordance with the provisions of the Act and the Rules various preliminary steps of procedure are carried out by or through the Controller.

**Miscellaneous other powers and duties of the Controller—**

The Controller also has various other powers and duties in addition to those already enumerated. These may here be briefly mentioned.

**Clerical errors.**

It is provided by section 62 of the Act that the Controller may, on request in writing, correct any clerical error in or in connection with an application for a Patent or any Specification.

**Rectification of the Register.**

On the application of any person aggrieved, the Controller may make orders for making, expunging or varying entries in the register and for its rectification. The powers he has in this respect he derives from section 64 of the Act. That section also gives the Controller power, in any proceeding under that section, to decide "any question that it may be necessary or expedient to decide in connection with the rectification of a register." He cannot however go beyond "correcting a mistake of fact which is apparent from a reference to the Patent itself or to some order of a competent authority" : as will be noted from sub-section 5.

**Certificate of entries and certified copies.**

The Controller may on request grant certificates of entries and events : under Section 71 and Rule 63. As provided by Section 71 such certificates are "prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or left undone." Requests for such certificates may be made under Form 29.

**Secret Patents.**

The Controller has also certain duties in regard to the sealing and keeping in his custody of closed packets in connection with secret inventions in accordance with the provisions of Section 21A of the Act of 1911.

**Nature of the powers and duties of the Controller.**

From what has already been stated, it becomes apparent that the Controller under the Act in certain respects exercises judicial powers of a wide character and in doing so adjudicates on matters of very considerable importance acting as a judicial tribunal, while in other respects he exercises executive or ministerial functions of an entirely non-judicial nature.

**Extent of judicial powers of the Controller.**

In connection with proceedings in which the decision of the Controller as a judicial tribunal is sought, questions may arise as to the precise extent of his judicial powers. In this respect it is to be noted that it is expressly provided by Section 65 of the Act of 1911 that in any proceedings before him the Controller shall have the



powers of a Civil Court. The precise wording of that Section is as follows :—

“65. Subject to any rules in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a Civil Court for the purpose of receiving evidence and administering oaths and enforcing the attendance of witnesses and compelling the production of documents and awarding costs.”

It has been the common practice for the Controller to issue subpoenas requiring the attendance of witnesses under the powers given him under the section. And in a recent case<sup>5</sup> it was decided by the Calcutta High Court on Appeal that “the Controller must issue subpoenas if asked for by either of the parties in order to enable them to enforce the attendance of any of the witnesses whose evidence they desire to place before the Controller. His position is the same as that of any Judge under the provisions of Order 16, r. 1 of the Code of Civil Procedure.” The Court held in effect that a party to opposition proceedings had a right to have such a subpoena issued on request.

It has been held in a certain case by the Controller that he had not power to issue a commission for the examination of witnesses abroad. The decision, which is not reported, was given in the course of the opposition proceedings to which reference is made in the last mentioned case, these being heard before the Controller by him in the year 1934; the applicant for patent was Dorman Long & Co. Ltd. and the opponent J. C. Mahindra. In the course of these proceedings the applicant having made an application for a commission to England for the examination of certain witnesses, the question was referred under the provisions of section 68 by the Controller to the Governor-General in Council and a ruling was obtained to the above effect.

There is no provision in India similar to Section 77 of the English Act of 1907-1932 providing for evidence before the Controller to be in the form of statutory declarations or affidavits. The Controller's practice in regard to the taking of evidence at a hearing of a matter (such as opposition proceedings) is to hear oral evidence of such witnesses as the parties may desire to call and to dispose of

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<sup>5</sup> See *Dorman Long & Co. v. Jagadish Chandra Mahindra* (1935) 39 C. W. N. 573 at p. 579.

the matter generally speaking on the lines of a suit in a civil court. It has been held in a recent case decided in the Calcutta High Court that while the Code of Civil Procedure is not applicable to proceedings before the Controller, the principles underlying the Code in so far as they are principles of natural justice must of course be observed by him, as they must be observed by all authorities exercising judicial or quasi-judicial functions.<sup>6</sup>

It has been further decided in effect in the other recent case (above mentioned) in the Calcutta High Court, on appeal, that the hearing referred to in Section 9 (that is the hearing in respect of opposition proceedings) means the hearing of the party and his witnesses and of the opponent and his witnesses. It was held by the Court in that case as follows :—"In my opinion the words "after hearing the applicant and the opponent" in Sec. 9 cannot be read as meaning that the Controller need only hear the applicant and the opponent, and can refuse to hear any evidence which either or both wish to adduce. "Hearing" means "the hearing of the party and his evidence." If it were to be held that Section 9 means that the Controller need hear only the applicant and his opponent there would be no obligation for him to hear evidence even by affidavit. It has not been suggested that the Controller's discretion is such that he may, if he chooses, refuse even to accept evidence upon affidavit. I can see, therefore, no reason for restricting his obligation to that of hearing the parties and of considering such affidavits as they may file. It must extend to the evidence of witnesses if the party chooses to call them."<sup>7</sup>

It is thus clear, it is submitted, that under the present Act & Rules in India it is obligatory for the Controller to decide such matters for which a hearing is necessitated on oral evidence if the parties so desire and to hear all such witnesses as each party may choose to call.

Under Section 74A the Controller is directly given power to require security for costs from opponents or appellants who neither reside in nor carry on business in British India.

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<sup>6</sup> See *In re National Carbon Co. Inc. Patent, and Bright Star Battery Co.* (1934) 38. C. W. N. 729 at p. 735.

<sup>7</sup> See *Dorman Long & Co. Ltd. v. J. C. Mahindra and another*, 1935 C.W.N. 573 at 578.

### Extent of the obligations in regard to the performance of his statutory duties.

Questions may also arise in regard to the executive side of the administration of the Patent Office in connection with the performance by the Controller of the Statutory duties of his office as to the extent of his obligations to perform such duties: that is to say how far the exercise of any given power is discretionary and how far obligatory.

It has been held in certain cases in regard to the construction of similar Statutes in general that where the language of the Act giving the power is merely permissive in form this is not necessarily conclusive; and that, for example, where the word "may" is used in the passage conferring the power, nevertheless the result on a proper construction of a particular Act may be in certain circumstances that the exercise of such power is obligatory and not discretionary. The question will be a matter of construction of the particular passage of the particular act in every case. In a leading English case (*Julius v. Lord Bishop of Oxford*)<sup>a</sup> the principle was stated as being that "the enabling words are construed as compulsory whenever the object of the power is to effectuate a legal right." In that case it was said by Earl Cairns L. C.—"The question has been argued and has been spoken of by some of the learned Judges in the Courts below as if the words "it shall be lawful" might have a different meaning, and might be differently interpreted in different statutes, or in different parts of the same statute. I cannot think that this is correct. The words "it shall be lawful" are not equivocal. They are plain and unambiguous. They are words merely making that legal and possible which there would otherwise be no right or authority to do. They confer a faculty or power, and they do not of themselves do more than confer a faculty or power. But there may be something in the nature of the thing empowered to be done, something in the object for which it is to be done, something in the conditions under which it is to be done, something in the title of the person or persons for whose benefit the power is to be exercised, which may couple the power with a duty, and make it the duty of the person in whom the power is reposed, to exercise that power when called upon to do so. Whether the power is one coupled with

<sup>a</sup> (1879) 4 Q. B. D. 245, and (1879) 4 Q. B. D. 525 (C. A.), and (1880) 5 A. C. 214 (H. L.).

a duty such as I have described is a question which, according to our system of law, speaking generally, falls to the Court of Queen's Bench to decide, on an application for a mandamus. And the words "it shall be lawful" being according to their natural meaning permissive or enabling words only, it lies upon those, as it seems to me, who contend that an obligation exists to exercise this power, to shew in the circumstances of the case something which, according to the principles I have mentioned, creates this obligation.

I think that if these principles are kept in mind it will be found that all the cases on this subject are easily understood and reconciled."<sup>9</sup> .....

Observations were made to the same effect by other members of the House of Lords in the same case; in particular by Lord Selborne as follows:—"My Lords, the use of inexact language in the statement of reasons for judicial decisions, (though nothing may turn upon it in particular cases determined upon sound principles) is sometimes liable to become a starting point in other cases towards erroneous conclusions. This appears to me to have happened in the Court of first instance in the present case. The language, (certainly found in authorities entitled to very high respect) which speaks of the words "it shall be lawful", and the like, when used in public statutes, as ambiguous, and susceptible (according to certain rules of construction) of a discretionary or an obligatory sense, is in my opinion inaccurate. I agree with my noble and learned friends who have preceded me, that the meaning of such words is the same, whether there is or is not a duty or obligation to use the power which they confer. They are potential, and never (in themselves) significant of any obligation. The question whether a Judge or a public officer, to whom a power is given by such words, is bound to use it upon any particular occasion, or in any particular manner must be solved aliunde, and in general, it is to be solved from the context, from the particular provisions, or from the general scope and objects of the enactment conferring the power."<sup>10</sup>

Also by Lord Blackburn<sup>11</sup>:—"I do not think the words "it shall be lawful" are in themselves ambiguous at all. They are apt

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<sup>9</sup> *Julius v. Lord Bishop of Oxford*.

<sup>10</sup> (1880) 5 A. C. 214 (H. of L.) at p. 222.

<sup>11</sup> *Ibid* at p. 235.

words to express that a power is given ; and as, *prima facie*, the donee of a power may either exercise it or leave it unused, it is not inaccurate to say that, *prima facie*, they are equivalent to saying that the donee may do it ; but if the object for which the power is conferred is for the purpose of enforcing a right, there may be a duty cast on the donee of the power, to exercise it for the benefit of those who have that right, when required on their behalf. Where there is such a duty, it is not inaccurate to say that the words conferring the power are equivalent to saying that the donee must exercise it." And again in another passage when commenting on a dictum in another case as follows :—"In *Reg. v. Tithe Commissioners*, Justice Coleridge, in delivering the considered judgement (14 Q. B. 474) of the Court says :—"The words undoubtedly are only empowering ; but it has been so often decided as to have become an axiom that in public statutes words only directory, permissive, or enabling, may have a compulsory force where the thing to be done is for the public benefit or in advancement of public Justice." The only part of this to which exception can be taken is the use of the word "public" ; if by that it is to be understood either that enabling words are always compulsory where the public are concerned, or are never compulsory except where the public are concerned, I do not think either was meant. The enabling words are construed, as compulsory whenever the object of the power is to effectuate a legal right."<sup>12</sup>

It is submitted therefore in regard to the exercise of such powers as are given to the Controller under the Indian Patents & Designs Act 1911 which are of a ministerial nature, on a correct construction of the Act there may be an obligation existing on the Controller to exercise such powers in a proper case, even where the wording conferring the power in question is grammatically on the face of it merely permissive in character. At the same time in regard to such matters in which questions of a judicial nature arise to be decided and the Controller is given a discretion it will always be open to him to decide the matter one way or the other in accordance with his discretion.

As to the proper remedies open, should the rare necessity arise, to a person desiring to enforce the performance of the proper statu-

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<sup>12</sup> *Julius v. Lord Bishop of Oxford* (supra) ; see also cases there cited : also *Maxwell's Interpretation of Statutes* (7th Edn.) p. 210 ; and *Hals. Vol. 27 Art. 327*.

tory duties imposed on the Controller by the Act of 1911, further reference is made to this matter in another chapter.

### **POWERS AND DUTIES OF H. E. THE GOVERNOR-GENERAL IN COUNCIL IN THE PATENT SYSTEM.**

In accordance with the general scheme of the Act of 1911 H. E. the Governor-General has very considerable powers in regard to the administration of the Patent system in British India. These powers though they may in a sense be regarded in the light of executive powers exercised by H. E. the Governor-General on behalf of the King Emperor, are for the greater part required to be exercised by him as powers of a judicial character ; entailing the giving of decisions such as are required to be given by a body functioning as a judicial tribunal.

#### **(i) As to Grant of Patent.**

The Governor-General in Council is invested with certain general powers in connection with the Grant of Patents in that he can under Section 10, impose such conditions on the Grant as the Governor-General in Council thinks expedient.

The Governor-General in Council has also certain special powers and duties in connection with the grant of Patents in connection with secret inventions and those of which the Patent has been assigned to the Secretary of State : under Sections 21 and 21A of the Act.

#### **(ii) As to the extension of the term of a Patent.**

H. E. the Governor-General in Council has powers under Section 15 of the Act 1911 to extend the term of a patent in a proper case. All petitions for any such extension are required to be made direct to H. E. the Governor-General in Council ; and are disposed of by him or referred by him to a High Court for decision. Certain preliminaries only in regard to the advertisement of such a Petition to enable persons interested to oppose the extension and in regard to the receipt and forwarding of notices of opposition by persons desirous of opposing the prayer for extension are effected by the Controller.<sup>13</sup>

#### **(iii) As to revocation under Sec. 25.**

The Governor General is invested with certain wide discre-

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<sup>13</sup> See Rule 25 : also Form No. 9 and Form No. 6.

tionary powers for revocation of Patents under Section 25 of the Act : if a Patent is held by him to be mischievous to the State or generally prejudicial to the public. In such a case if the Governor General in Council declares by notification in the Gazette of India, the Patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public, then the Patent is then and there deemed to be revoked.

**(iv) Revocation or Compulsory Licenses.**

Powers that are likely to be more frequently invoked are the Governor-General's power of revocation and of ordering the issue of compulsory licenses under Sections 22 and 23 of the Act on petitions made to him on the ground that the demand for a patented article in British India is not being met to an adequate extent and on reasonable terms : or on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside British India. It will be noted that the meaning of the former ground is defined in sub-section 5 of Section 22 which reads as follows :—

“For the purpose of this section the demand for a patented article shall be deemed to have been met to an adequate extent and on reasonable terms :—

- (a) If by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licenses on reasonable terms, any existing trade or industry or the establishment of any new trade or industry in British India is unfairly prejudiced . . . or,
- (b) If any trade or industry in British India is unfairly prejudiced by the conditions attached by the patentee .....to the purchase, hire or use of the patented article or to the using or working of the patented process.”

Any person interested is entitled to present a Petition on this ground under section 22, and any person without restriction under the wording of Sec. 23. The Petition is to be to H. E. the Governor General in Council under either section : being left at the Patent

Office. On receipt of such a Petition, H. E. the Governor General in Council will under the Act consider the Petition. When acting under Section 22 H.E. the Governor-General in Council may either dispose of the Petition himself or refer it to a High Court for decision. In cases where the matter is not referred to a High Court H.E. the Governor-General in Council may, if he decides in favour of the Petitioner, order the Patentee to grant compulsory licenses on such terms as H.E. the Governor General in Council may think just or, if of the opinion that the demand will not be adequately met by the grant of licenses, then the Governor-General in Council may order the revocation of the Patent. There is a proviso that an order of revocation shall not be made before the expiration of four years from the date of the Patent or if the Patentee gives satisfactory reasons for his default.

When acting under Sec. 23 as at present worded there appears to be no option for H. E. the Governor-General in Council to refer the matter to the High Court ; but he will in all cases dispose of the matter himself.

(v) **As to appeals.**

H. E. the Governor-General in Council is constituted by the Act of 1911 a tribunal of appeal in many instances in respect of decisions of the Controller. Such a right of appeal is created under the Act in the following instances :—

From an order by the Controller refusing under Section 5(1) to accept an application for a patent : under Section 5(2).

From a decision by the Controller under Section 9(2) in proceedings in opposition to the grant of a patent, whether such decision be to make the grant or to refuse it : under Section 9(3).

From a direction made by the Controller under Section 10(1A) : under the second proviso to Section 10 (1A).

From an order by the Controller under Section 16(5) on an application for the restoration of a lapsed patent, whether such order be to restore the patent or to dismiss the application : under Section 16(5).

From a decision by the Controller under Section 17(4) on an application for the amendment of an application or of a specification, whether such decision be to allow the amendment or to refuse it : under Section 17(6).



From an order by the Controller under Section 69(1) refusing to grant a patent on the ground that the use thereof would, in his opinion, be contrary to law or morality : under Section 69(2).

The procedure for the disposal of such appeals is regulated by Section 70 of the Act and by Rule 62 of the Indian Patents & Designs Rules, 1933.

Though no express provision is contained in the Act or the Rules giving H. E. the Governor-General in Council any express power to remand a case for rehearing or for the hearing of fresh evidence by the Controller, the Calcutta High Court (by a Court of Appeal) has held that such a power of remand is an inherent power possessed by an appellate tribunal and accordingly that H. E. the Governor General in Council has such a power in connection with the disposal by him of an appeal from a decision of the Controller refusing to grant a patent in opposition proceedings.<sup>14</sup>

**(vi) As to giving directions in case of doubt or difficulty.**

H. E. the Governor-General in Council may under Section 68 of the Act of 1911 give directions to the Controller in the event of an application being made to him by the Controller for such directions.

**(vii) Miscellaneous other powers and duties of H. E. the Governor General in Council.**

By the provisions of Section 77 of the Act H. E. the Governor General in Council is expressly authorised to make rules for the purposes therein mentioned.

By the provisions of Section 78A, H. E. the Governor General in Council is expressly empowered in certain circumstances to direct by notification in the Gazette of India that any other part of His Majesty's dominions or any Indian State shall enjoy the benefit of the reciprocal arrangements referred to in Section 78A.

**POWERS AND FUNCTIONS OF THE CIVIL COURTS IN CONNECTION WITH THE PATENT SYSTEM.**

It has been seen that in a large field of matters, all requisite acts and decisions such as are necessary in the working of the patent

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<sup>14</sup> See *Dorman Long & Co. Ltd. vs. J. C. Mahindra and another* (1935), 39 C. W. N. 572 at p. 577.

system are apportioned by the Act of 1911 to be made and performed either by the Controller of Patents or by H. E. the Governor General in Council. In certain few cases also, as seen, there is a power for a matter to be referred to a High Court. There are also certain other matters which are under the Act of 1911 expressly allotted to be decided by the Civil Courts (either a High Court or a District Court) and are allocated to the jurisdiction of such Court alone, without power of any adjudication either by the Controller or by the H. E. the Governor General in Council. The decision on these questions may be of the very greatest importance to the parties interested : for this reason litigation on these matters may be of a most serious tenacity. Questions connected with the conduct and progress of such suits and proceedings as may arise under the Act are hereafter dealt with separately more in detail. It is sufficient here to note the occasions when the decision of matters in dispute is under the Act called for by a Civil Court of law. These are :—

- (i) Suits for infringement of patent : (under Section 29).
- (ii) Suits for groundless threats of legal proceedings : (under Section 36).
- (iii) Petitions to a High Court (under Section 26) for the revocation of a patent.
- (iv) References by H. E. the Governor General to the High Court (under Section 22 (2)) as to an application for the grant of a compulsory license or for the revocation of a patent.
- (v) References to the High Court (under Section 21(4)) for the decision of disputes as to the making, use or exercise of an invention.
- (vi) References or appeals to the High Court (under Section 64(2)) regarding applications for rectification of the register of patents.
- (vii) Applications to the Court hearing an infringement suit during the pendency thereof for amendment of a Specification or Application for Patent : (under Section 18).
- (viii) Petitions to Court for the appointment of a person to act on behalf of a person subject to a disability : as for

the appointment of a guardian for an infant or of a committee or manager for a lunatic : (under Sec. 74.)

### PATENT AGENTS.

Since it cannot be an overstatement either in speaking of the United Kingdom or in speaking of British India to say that in modern times the work of the Patent Office could not be carried on and the modern system of Patent administration would become unworkable without the work and co-operation of Patent Agents, it will be convenient here to note something of the duties and functions of Patent Agents and their position in the working of the system of Patent administration in this country. In order fully to appreciate the position in British India it will become necessary also to consider and contrast the legal position of Patent Agents in the United Kingdom.

**Agency generally : provisions in the United Kingdom regulating what acts are required to be done personally.**

In the United Kingdom the degree to which patent transactions with the Patent Office may be effected by an agent instead of personally is regulated by the following Rule No. 8 of the (English) Patents Rules 1932 : *viz* :—

“8. With the exception of the signing of the following documents, namely, applications for patents, for a complete specification to be treated as a provisional specification, for postdating of applications, for the revocation of patents, for the grant of a licence under a patent for the indorsement of a patent “licences of right”, for the refusal of a request for the indorsement of a patent “licences of right,” for the cancellation of such indorsement, for the restoration of lapsed patents, requests for leave to amend applications or specifications, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all communications to the Comptroller under the Acts and these Rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom.

In any particular case, the Comptroller may, if he thinks require the personal signature or presence of an applicant, opponent, or other person”.

The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Acts from any person whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent, has been erased from the register of patent agents kept under the provisions of the Acts and not since restored, or (during the term of his suspension) any person who has been suspended from acting as a patent agent.”

#### **Agency generally : in British India.**

In British India the degree to which patent transactions with the Patent Office may be effected by an agent instead of personally is similarly regulated by somewhat corresponding provisions contained in Sections 75 & 76 of the Act of 1911 *viz* :—

“75. The following documents, namely,—

- (1) applications for a patent,
- (2) notices of opposition,
- (3) applications for extension of term of a patent,
- (4) applications for the restoration of lapsed patents,
- (5) applications for compulsory license or revocation, and
- (6) notices of surrenders of patent,

shall be signed and verified, in the manner prescribed, by the person making such applications or giving such notices :

Provided that, if such person is absent from British India, they may be signed and verified on his behalf by an agent resident in British India authorised by him in writing in that behalf.”

“76. (1) All other applications and communications to the Controller under this Act may be signed by, and all attendances upon the Controller may be made by or

through a legal practitioner or by or through an agent authorised to the satisfaction of the Controller.

(2) The Controller may, if he sees fit, require—

- (a) any such agent to be resident in British India,
- (b) any person not residing in British India to employ an agent residing in British India ;
- (c) the personal signature or presence of any applicant, opponent or other person.

And by Rule 9 of the Indian Patents & Designs Rules 1933 :  
*viz*—

“9. For all matters falling under the provisions of section 76 of the Act, any person may, unless otherwise directed by the Controller, authorise, under his personal signature any other person to act as his agent and to receive all notices, requisitions and communications. The authority may be given on Form 31.”<sup>15</sup>

Thus the position in this respect, as to the extent of the facilities for and restrictions on the effecting of patent transactions through agents instead of personally, is the same, broadly speaking, in India as in the United Kingdom.

**Advisability in practice of employing agents : the scope of Patent Agent's work.**

There are many reasons why a person who is contemplating taking out a Patent or a person who has obtained a Patent should entrust the work connected with such Patent to an Agent who specialises in Patent work rather than undertake the work himself. This would be so in the United Kingdom even if there were no Chartered Institute of Patent Agents and no regulations governing Registered Patent Agents as there are in that country. And it is so also in India though there is no Institute of Patent Agents and though there is no Registration of Patent Agents in India. There is nothing of course in law to prevent a prospective patentee from himself drafting the Specification and Claims to accompany his application for a Patent or from making all applications connected

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<sup>15</sup> (For Form No. 31 here mentioned reference may be made to App. No. 5 below).

therewith or with any Patent matter in which he may be interested or from doing everything himself. But in practice for him to do so will be highly inadvisable. A document such as the Specification and Claims in connection with an Application for a Patent, particularly if the invention be at all complicated or if the field for which a monopoly may be obtained is affected by other previous specifications, calls for considerable technical experience and skill both scientific and legal if it is to be drawn with accuracy and with the best results. It is not in drafting a Specification, as is sometimes apparently supposed, a question merely of describing a machine or a process from an engineering point of view so that someone else may understand it enough to manufacture it after the monopoly ends ; but there is the even more important work of properly delimiting how much or how little is claimed by the Applicant for Patent as a monopoly. An inventor's rights may be seriously prejudiced or even lost through ignorance of correct procedure and of Patent Law, both in the drafting of a Specification and Claims and in other Patent matters. This danger is recognised to such an extent in the United Kingdom and many other countries that the Patent Office recommend every prospective patentee to employ a Patent Agent and in some countries actually insist upon his doing so.

Apart from the work of drafting Specifications it will be found that in most other matters connected with a Patent the advice and assistance of a person who specialises in Patent Agency work will be useful ; and there is a large field of work outside the sphere of any transactions directly had with the Patent Office, in which Patent Agents are normally employed.

It will be advisable in many instances for commercial concerns to employ a Patent Agent in the normal course of business on standing instructions to keep them informed of all new developments in connection with Patents. In certain businesses more than others it is essential to be ahead of or at the very least fully abreast of all new ideas as they are evolved in connection with a particular trade or art. It may be that from the nature of the business it is highly dependent on a Patent or Patents of its own. In such a case it is vital for the owner to know of any new developments by others and to have information at once of any Applications for Patents touching on its own sphere of activities by others. Whether it may be desired to acquire such

Patents or co-operate with such Applicants, or whether it may be desired, for one reason or another, on one ground or another, to oppose the grant of a Patent to such applicants, it will be an equally vital necessity to have full particulars as early as possible of the new developments. Or it may be that a business, while possessing no Patents of its own, may yet be such that it stands to suffer considerable loss when new processes or articles are developed which will make its own processes or articles out of date. It more often than not is the case that an owner of a business which is working Patents of its own is more on the look-out for the development of Patents by competitors. Yet in truth it will often be the fact that a business which has no Patents of its own will be affected in precisely the same way by the development of Patents for inventions in the sphere of its own business : and will be or should be interested for the same reasons. It may be equally important in its case for it either to co-operate with or to oppose the newcomer who is applying for a particular Patent. Accordingly one important and valuable service commonly rendered by a Patent Agent is to keep his client fully informed of all new developments in the field of new Patents which may in any manner affect his client's business. In spite of the usual advertisements which are required of all new applications it will be seldom in practice possible for a business man to keep himself fully informed of all such new developments without the assistance of a Patent Agent whose work is to specialise in searches and such matters.

Even if the business man is in a position to rely on the organization of his own business to keep him informed of any new applications for Patents being made about which he is interested, when information is obtained of such new applications having been filed, it will no doubt be necessary or at least advisable for him to consult a Patent Agent, being a person whose daily work necessitates specializing in reading as well as drafting Specifications, to advise him on the construction of the new Specifications in order to enable him to envisage precisely the field and nature of the operations covered thereby and claimed by the new applicant ; and to advise him whether co-operation or opposition and to what extent and on what lines is practicable.

Patent Agents in addition to conducting their Client's business with the Patent Office or with Patent Agents abroad or with foreign

Patent Offices, may be expected to give advice and opinions on all Patent Matters. As a good Patent Agent is expected to be, apart from all other things, a first class and trustworthy Engineer or Chemist or both, a considerable part of a Patent Agent's work may also consist of advising in a capacity resembling that of a consulting engineer upon the engineering aspect or other scientific aspect of his client's invention.

Patent Agents are also expected to have an up to date knowledge of the Patent Laws & Regulations of Foreign Countries, so as to be in a position to advise their Clients in what foreign countries it may be advisable or profitable for them to take out Patents ; and so as to be able to put through from this country all necessary negotiations in the foreign countries chosen. In practice it commonly happens that Patent Agents in India specialise chiefly in the matter of taking out Patents in countries in the East : for the purpose of taking out Patents in such countries they may be consulted by Clients not only from India but from all parts of the United Kingdom, Europe or America. While if Patents are desired to be taken out in such territory as South American countries and other countries in the Western part of the world the matter will commonly be put through American Patent Agents, who will in their turn carry through the direct negotiations with the Patent Offices concerned.

Another sphere of the work with which Patent Agents are often entrusted is for them to act as Applicants for Patents on a communication from abroad in circumstances when for convenience or for expedition it is found desirable that a Patent should be applied for and granted in the name of the Patent Agent ; though he is to have no interest in the Patent and will be bound to assign the Patent as soon as granted to the Client. In regard to Patents which it is desired to take out in British India when the client who is the prospective owner of the Patent is abroad, it is commonly found convenient and useful by such a person for the Indian Patent to be taken out in the name of such person's Patent Agent in British India the Patent being after grant immediately assigned to the client. Such a procedure has been found particularly useful in cases where it has been necessary for the Application for Patent to be expedited and made before a particular date. Such a position, for example, may arise where the Client in the United Kingdom desires to obtain an Indian Patent for an invention which at a particular



date is novel in British India, but which after publication in British India of certain Scientific Journals or other documents which may be in the course of post, will become anticipated by prior knowledge : in certain of such cases it has been found even feasible to have a description of the invention cabled out to India and for the Patent Agent in British India to file the requisite application for the grant in his name to him on a communication from abroad of a Patent before the arrival in India of the critical documents. It may be noted in passing that while a Patent Agent who is a Fellow of the Chartered Institute of Patent Agents is debarred by the rules of the Institute from himself owning any Patent or from himself having any interest in a Patent, yet it has always been recognised that it is open even for a Fellow of the Chartered Institute of Patent Agents in the United Kingdom to apply in his own name for a Patent in such cases where the Patent is taken out on a communication from abroad.

Patent Agents' work also involves the making of novelty searches at the Patent Office ; the collecting of expert evidence, which process may entail the making of protracted researches and many and careful experiments for long periods in advance of the occasion for which the evidence is required ; the giving of evidence as expert witnesses in infringement suits ; and even the acting as arbitrators in Patent disputes. A further important and valuable service usually rendered by a Patent Agent is that of advising his client of taxes and renewal fees before they become due to keep his client's Patents in force and to prevent their unintentional lapse through non-observance of the requirements.

### **English regulations concerning the Registration of Patent Agents and prohibiting Patent Agency work to be done by any person other than Registered Patent Agents.**

In the United Kingdom all Patent Agency work can only be done by a duly qualified and Registered Patent Agent. Regulations to this effect have been in force in various forms in the United Kingdom since the year 1888.

### **Previous English Law as to Patent Agents.**

By Section 1 of the English Patents, Designs & Trade Marks Act 1888<sup>10</sup> it was enacted as follows :—

<sup>10</sup> 51 & 52 Vict c 50.

"1.—(1). After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonafide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom."

Prior to 1st July 1889 any person without restriction had been able to do the work of a Patent Agent. It is stated or implied by Edmunds that the provisions contained in this section were enacted as a consequence largely of the Parliamentary Reports of 1851 & 1865 to which he refers as containing "abundant evidence of the inconvenience and expense to which the absence of any provision (for means of excluding unqualified persons from acting as Patent Agents) might give rise." He also refers to the fact that "prior to the passing of the Patent Law Amendment Act of 1852 a patent agent's business was of a comparatively limited character, as at that time only about 550 patents were taken out annually in England: (and that) "under the Patent Law Amendment Act the number of patents annually obtained greatly increased.....". But it is to be noted that under that Act there was nothing to prevent an unregistered person from acting as Patent Agent, the prohibition being only against his describing himself as a Patent Agent.

In pursuance of the power and direction to make Rules granted under sub-section (2) of the above section, the Board of Trade in England on 11th June 1889 issued certain rules entitled the "Register of Patent Agents Rules." Under those Rules the control and care of the Register of Patent Agents in the United Kingdom and the control and management of qualifying examinations of candidates and of admission of applicants to the Register was entrusted to the Body then already in existence which was known as "the Institute of Patent Agents."<sup>17</sup>

The history up to that date of the Institute of Patent Agents is also noted by Edmunds as having been originally incorporated under the English Companies Acts 1862 to 1880 in the name of "the Institute of Patent Agents" as an association limited by guarantee on 12th August 1882, the use of the word "limited" having been dispensed with by license of the Board of Trade under Section 23 of the English Companies Act of 1867. It was further stated by Edmunds, writing as he was in the year 1890, that : "a royal charter of incorporation has recently been applied for, in which it is proposed that Fellows of the Institute should be entitled to describe themselves as "Chartered Patent Agents."

The Royal Charter referred to as in the future by Edmunds was in fact granted in the year 1891 and the Institute thereupon became an Incorporated Body by virtue of such Royal Charter and assumed its present title of the "Chartered Institute of Patent Agents."

Among the objects of that Institute as defined in the said Royal Charter were stated the following :—"To promote the education, status and training of Patent Agents and to maintain a high standard of rectitude and professional conduct and knowledge."

1907.

In the year 1907 a short-lived Act appears to have been passed entitled the Patents and Designs (Amendment) Act 1907<sup>18</sup> which contained certain provisions in its Sections 47 & 48 relating to Patent Agents ; these however do not call for more than passing mention since the whole of that Act was repealed by the Act which

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<sup>17</sup> Edmunds ( 1890 edn.) pp. 527 & 528.

<sup>18</sup> 7 Edw 7 C 28.

immediately follows it on the Statute Book being the well known Patents & Designs Act of 1907.<sup>10</sup>

The material provisions of that Act (the Patent & Designs Act of 1907. 7. Edw 7 C 29) regarding registered patent Agents were Sections 84 & 85 by which it was provided as follows :—

“84. (1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act,

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty fourth day of December, one thousand eight hundred and eighty-eight, he had been bonafide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section “patent agent” means exclusively an agent for obtaining patents in the United Kingdom.

“85.—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could

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<sup>10</sup> Edw 7 C 29.

refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man."

Even under that Act there was no direct prohibition preventing unregistered persons from acting as Patent Agents, but provisions were made to allow the Controller to refuse to recognise such persons as agents.

**1919.**

Then by the English Patents Act of 1919 (section 18) it was further enacted as follows :—

"18. For section eighty-four of the principal Act, which relates to the registration of patent agents, the following section shall be substituted :—

84.—(1) No person shall practise, describe himself, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—

- (a) in the case of an individual, he is registered as a patent agent in the register of patent agents ;
- (b) in the case of a firm, every partner of the firm is so registered ;
- (c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November nineteen hundred and seventeen, every director and the manager (if any) of the company is so registered .
- (d) in the case of a company which commenced to carry on business as a patent agent before that date a manager or a director of the company is so registered :

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) Every individual not registered as a patent agent before the fifteenth day of July nineteen hundred and nineteen who proves

to the satisfaction of the Board of Trade that prior to the first day of August nineteen hundred and seventeen he was bonafide practising as a patent agent, whether individually or as a member of a firm, or as a manager or director of an incorporated company, shall be entitled to be registered as a patent agent if he makes an application for the purpose within such time as may be fixed by the Board of Trade, unless after giving an applicant an opportunity of being heard the Board of Trade are satisfied that he has whilst so practising been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom.

(3) If any person contravenes the provisions of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds, and in the case of a company every director, manager, secretary, or other officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.

(4) For the purposes of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.

(5) Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.

(6) No person not registered before the fifteenth day of July nineteen hundred and nineteen shall be registered as a patent agent unless he be a British subject."

Section 85 remained as before.

**1932.**

Finally by the English Act of 1932 Section 84 of the principal Act was further amended so as to read in the form in which it now stands which is given below. While section 85 of the principal Act was also amended (by an amendment to give power to the Comptroller to refuse to recognise during the term of his suspension an agent who has been suspended but whose name has not actually been taken off the register) by the recent Act of 1932. The provisions of this section as they now stand are also given below.

**Previous Rules.**

Under Section 86(g) of the English Act of 1907 the Board of Trade were expressly given the power to make rules for regulating the keeping of the register of Patent Agents under that Act. This provision has been untouched by the 1919 amending Act and by the 1932 Act and continues in force at the present day.

Since the Rules which were made as already mentioned in 1889, various other Rules relating to the register of Patent Agents have been made. Reference may be made to the Register of Patent Agents Rules 1908 dated 17th December 1907 which were made by the Board of Trade under the English Patents & Designs Act 1907. The Rules in this regard now in force are referred to below.

**Present English Law as to Patent Agents.**

By Section 84 and 85 of the English Patents & Designs Act 1907-1932 as they stand today it is provided as follows :—

*"84. Registration of Patent Agents.*—(1) No person shall practise, describe himself, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—

- (a) in the case of an individual, he is registered as a patent agent in the register of patent agents ;
- (b) in the case of a firm, every partner of the firm is so registered ;
- (c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November, nineteen hundred and seventeen, every director and the manager (if any) of the company is so registered :
- (d) in the case of a company which commenced to carry on business as a patent agent before that date, a manager or a director of the company is so registered :

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) If any person contravenes the provisions of the section, he shall be liable on conviction under the Summary Jurisdiction Acts

to a fine not exceeding twenty pounds or in the case of a second or subsequent conviction to a fine not exceeding fifty pounds, and in the case of a company every director, manager, secretary, or other officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.

(3) Notwithstanding anything in any enactment prescribing the time within which proceedings may be brought before a Court of summary jurisdiction, proceedings for an offence under this section may be commenced at any time within twelve months from the date on which the alleged offence was committed.

(4) For the purpose of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.

(5) Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.

(6) No person not registered before the fifteenth day of July, nineteen hundred and nineteen, shall be registered as a patent agent unless he be a British subject."

"85. *Agents for Patents.*—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or (during the term of his suspension) any person who has been suspended from acting as a patent agent, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.



(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.”

There would appear to be no question that the provisions of the English Rule No. 8, previously referred to, directing which documents may be signed or which acts may be done through an agent and which must be signed or done personally, is subject to the provisions relating to the registration of Patent Agents which are contained in Section 84 & 85 above. It is clear therefore in the light of the various provisions already mentioned that in the United Kingdom no person who is not a duly qualified and registered Patent Agent may act as an Agent in any Patent matter which is ordinarily the work of a Patent Agent. And in regard to such matters as are mentioned in Rule No. 8 as being allowed to be transacted by an agent, since to effect such transactions must be to act as a Patent Agent, it follows that such matters, equally, if done through an agent and not personally must be done through a Patent Agent.

#### **Present Rules as to the Register of Patent Agents.**

The present rules now in force made by the Board of Trade by virtue of Section 86 (f) of the English Patents & Designs Acts 1907-1932 are known as the Register of Patent Agents Rules 1932.<sup>20</sup> For convenience of Reference these are set out in an Appendix.<sup>21</sup> The extent to which the Chartered Institute of Patent Agents in the United Kingdom working under and in collaboration with the Board of Trade, controls the Register of Patent Agents and Registered Patent Agents themselves sufficiently appears from a perusal of these Rules.

#### **The Chartered Institute of Patent Agents as it functions in the United Kingdom at the present day : qualifications required for Registered Patent Agents.**

By Rule 6 of the Register of Patent Agents Rules 1932 it is provided as follows :—

*“6. Final qualifying examination for registration.—No person shall be entitled to be registered as a patent agent unless he has*

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<sup>20</sup> Dated 4th October 1932 : S. R. & O 1932 No 820.

<sup>21</sup> Appendix No. 3.

passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as the Institute shall from time to time prescribe."

Rules 7, 8 & 9 also contain provisions regarding an intermediate examination and further regulations in regard to the management of both the intermediate examination and the final examination. These rules also contain regulations regarding the minimum qualifications necessary in candidates for such examinations. The management of the examinations is left almost entirely to the Chartered Institute of Patent Agents. The examination is designedly difficult to pass, in later years the percentage of successful candidates being only about 25 ; and the number and variety of the subjects in all of which the candidates must satisfy the examiners, ensures that a qualified Patent Agent is not only an expert in Patent Law and Procedure, but also has had a very extensive and thorough technical training, not only in engineering but in chemistry, physics and the other branches of science. The examination is controlled by the Chartered Institute of Patent Agents ; and successful candidates, who have their names entered upon the Register of Patent Agents as published under the provisions of the Register of Patent Agents Rules 1932, may seek election to fellowship of the Institute. Inventors in the United Kingdom may consult Chartered Patent Agents (*i.e.* Registered Patent Agents who have been elected to fellowship of the Chartered Institute of Patent Agents) on Patent matters in the certain knowledge that they will receive unbiassed opinions and technical and legal assistance of a very high order.

At the present time there are not more than 369 Registered Patent Agents in the United Kingdom of which some 275 only are Chartered Patent Agents, that is to say, Fellows of the Chartered Institute of Patent Agents.

#### **Indian Law as to Patent Agents.**

There is no Register of Patent Agents in British India.

There is no Institute or other body, whether company or corporation, of Patent Agents in British India : either privately established or created by any Act,

There are thus no Registered Patent Agents under the Indian Patents Act : nor are there any Chartered Patent Agents in British India—except in the sense that the term may be applied to persons

who have qualified in the United Kingdom as Registered Patent Agents under the English Acts, and have thereafter been elected to be Fellows of the Chartered Institute of Patent Agents of the United Kingdom, and have thereafter come to British India. As the work entailed in the making of applications for patents and in the drawing up of specifications, and indeed almost all work connected with patent transactions, is by its nature highly technical and specialised, it is natural that the work which is done in England and other countries by Chartered or Registered Patents Agents is done in fact in India by certain persons and firms specialising in such work who are known, commonly speaking, as Patent Agents or Patent Attorneys. But such term, except in so far as it relates to the English or foreign qualifications of particular persons, is in no sense more than a popular description indicative of the nature of the work done by such persons. There is no system by which any minimum standard of qualifications for persons doing the work of Patent Agents as to technical knowledge, character or conduct can be established or maintained ; and no Body of persons, however few its members, by which the rights and status of its members may be protected. Indeed it is a matter for comment that in a country where the patent system has been developed, to the extent to which it has been in British India, with the voluminous Act and Rules which have been put into operation here, there has been no further development towards the creation of any such Institute for the dual purpose of the control and the protection of patent agents ; and no provision for a Register of Patent Agents for the benefit and protection not only of the Patent Agents themselves but of the public.

There being in India no Chartered or Registered or Statutory Patent Agents, there are, naturally, no statutory restrictions prohibiting anyone from practising as a Patent Agent.

The non-existence of any statutory Patent Agents in India is indirectly referred to officially in the following short passage contained among the Instructions for the Guidance of Inventors and others at p. 115 of the Patent Office Handbook (5th Edn.) as follows :—

*'Patent Agents*—The Patent Office does not authorise persons to practise as Patent Agents ; nor does it undertake to keep a list of persons willing to act as Patent Agents. Any person duly

authorised by means of a power of attorney, or by means of authority given on Form No. 31, will be allowed to act as an Agent provided that he is resident in British India."

It may be noted that the Indian Act under Section 76 refers to "an agent authorised to the satisfaction of the controller." It has on occasion been suggested that that phrase means that only persons can practise as Patent Agents who obtain the consent or positive authorization of the Controller to practise regularly. But it is submitted that there is no foundation for such a view; and that the Controller has no power to refuse to recognise any agent except only in a case where the Controller is not satisfied that the agent is properly authorised by his principal. This view is in keeping with the view which is in practice taken by the Patent Office itself as stated in the Patent Office Handbook in the passage already referred to. It seems clear that the authorization or authority which is called for under Section 76 is not an authorization by the Controller but an authorization by the agent's principal. Thus it is clear under the Act and from Rule 46 and Form No. 31 that anyone, provided only he is duly authorised by his principal, may under the present provisions of the law act as a Patent Agent in British India.

### **Cost of obtaining a Patent.**

It is obviously not possible in the abstract to make any precise statement as to what it will cost to take out a Patent. This will naturally vary in different cases according to the charges of the Agent employed and according to the degree of complexity of the invention and according to the strength of the opposition, if any, and other such matters. But as the question is so often asked what it will cost and as so many people have no idea of any figure, it may be of some service to prospective applicants for Patents to state here that in an ordinary case in which the grant is not opposed, if Agents of the highest standing and skill are employed, for all steps up to and inclusive of obtaining the grant, that is to say inclusive of the drafting of the specifications, and the making of all necessary applications and the paying of all Patent Office fees and inclusive of all charges payable to the Agents for their work, the total amount payable should not exceed a sum in the neighbourhood of the comparatively small figure of

Rs. 200/-. It will often no doubt be advisable where possible for the prospective patentee to arrange for a consolidated sum to be paid by him to include all such matters, and thus save the annoyance of the mounting up of many small charges which may finally reach an unexpectedly high total.

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## CHAPTER VI

### WHAT THINGS MAY BE PATENTED—CERTAIN REQUISITES OF A VALID PATENT—ATTRIBUTES NECESSARY IN REGARD TO THE INVENTION—I. SUBJECT MATTER—THE TERMS “INVENTION” AND “MANNER OF MANUFACTURE”— II. NOVELTY—III. UTILITY.

#### PART I.

Since a Patent cannot be obtained for every kind of thing in the world it is important to discover for what things it can be obtained and for what it cannot. Again, since even after grant a Patent may in certain circumstances be declared invalid, it is important to discover what constitutes a good patent in the first place ; that is, a patent for which there is no risk, after grant, of its being upset or interfered with.

It will be seen that it may happen that a grant of a Patent is made without by any means a complete enquiry in all directions as to the complete validity of that patent : then, since every grant is made only conditionally, that is, on the terms that the grant will be void in the event of its being afterwards found for any reason that the Patent is invalid, from this two results follow. There is the advantage to an applicant that he may obtain a grant for a patent which would not be granted to him if there had been a complete investigation into its validity at first ; and as long as no one comes forward to upset that patent he will continue to enjoy, for a patent which in truth is defective, all those advantages which would have been afforded by a completely good patent. But there is also the disadvantage, in some cases great, that the patentee may be lulled into a false sense of security ; thinking he has a completely good patent while in truth it is defective. If he expends capital or lays down workshops or otherwise incurs liabilities over the patent, then, later, when it is found to be invalid, and when, on top of everything, he finds himself saddled with having to pay the expensive costs of the proceedings

brought by the person attacking the validity of the patent, the result may turn out for him to be worse than if he had never obtained any patent at all in the first place. For these reasons it will be convenient before going further, to investigate in this Chapter what are the attributes of a good Patent. It will be possible then to appreciate (in later chapters) the stages at which, and the grounds on which, a Patent which is defective may or may not be successfully attacked.

It is proposed in this chapter to discuss certain qualities known as "subject-matter", "utility" and "novelty" which are required to be possessed by a thing if it is to be patented.

These are qualities inherently necessary in the thing itself: otherwise it is not fit for any patent to be granted for it. In a subsequent chapter it is proposed to discuss other features of an invention, as described in a specification, which are essential for a good and valid Patent. It will be convenient to consider these essential matters as a whole, together, so as to appreciate fully what are the essentials of a valid patent; and it is considered that this course will be more useful than a mere running commentary on the Act. Such a commentary on the Act, section by section, would of necessity deal with various grounds of objection as they might occur, haphazard, in connection with the various sections of the Act: in that case the same ground would recur in the same or slightly different forms in connection with different sections relating to different proceedings. Such a treatment of the matter might develop into a wearisome repetition or be so disjointed as to be unintelligible. The course in this work proposed to be adopted is, rather, after a general survey of such requisities as are necessary in a valid patent as a whole has first been made, thereafter at later stages, as convenient, to note in relation to the Act how and when objections for the want of any one or more of these requisities can be effectively taken in the different proceedings which are open under the Act at various stages: by way of opposition to the grant or by way of revocation of the grant.

As an illustration it may be mentioned that objections on the ground of want of novelty may be taken either at the stage before acceptance of the application by the Controller, or at the stage of opposition to the grant by an opponent, or at the stage of revocation proceedings by an applicant for revocation or at the stage of an

infringement suit as a defence to such suit by the defendant; at each of these stages the objection for want of novelty can only be raised as to certain specific elements or grounds of want of novelty which are prescribed by the Act in the section relating to the particular proceeding; but the principles relating to want of novelty are the same throughout. For the Patent to be valid all through, so that the patentee may resist opposition at any of these stages, it is essential that it does not suffer from want of novelty in any one respect. It is for these reasons proposed first to take a general survey of the meaning of novelty such as is required in Patent Law as a whole in this chapter, so that, it is hoped, this may make more simple and intelligible a consideration of specific objections in specific proceedings in later chapters.

Of the three matters thus to be considered in this chapter it will be convenient to treat first of "subject-matter"; secondly of "novelty" and thirdly of "utility"; and this chapter being divided for convenience into parts, those heads are accordingly dealt with separately in Part II, Part III and Part IV respectively of this Chapter.

## PART II. SUBJECT-MATTER.

### Subject matter in the wide sense previously used.

In common parlance anyone speaking of the "subject matter" of a Patent might mean to refer to the whole subject matter of a Patent in all aspects and in relation to all its attributes. This would cover a consideration of its attributes of novelty and utility as well as all other topics which might concern its subject matter as a whole.

Formerly also, in Patent parlance, this was what was intended by a reference to the "subject matter" of a Patent. This may be seen from the arrangement of the work of Edmunds on Patents published in 1890, in which Chapter IV is devoted to "the subject matter of Letters Patent"; and deals with this topic under 4 sections: (1) in general, (2) as to "any manner of manufacture". (3) as to "novelty" and (4) as to "utility etc."



Recently however, it has become common, in patent legal phraseology to restrict the term "subject matter" to those topics which concern the inherent quality of the actual subject matter of a Patent : that is to say the actual "stuff" of which the invention is made, if it can be put in that colloquial way, exclusive of any consideration of any extraneous attributes relating to the stuff, such as the novelty or utility thereof. That is to say, in modern use the term "subject matter" is restricted to that part only of what Edmunds referred to as "subject matter", which does not relate to such topics as novelty and utility. The matter is a little difficult to be put into precise words, but the distinction is a clear one.

In this work, the term subject matter is used in the restricted, modern sense. When referring in this work to what Edmunds referred to as subject matter in the larger sense, this will be indicated by a reference to "the requisities of a patent" or "the attributes of a patent" or some such other phrase : as is done at the heading of this chapter.

#### **Subject matter in the sense now used.**

Several topics distinct but overlapping, fall to be considered with reference to the subject matter of an invention. One involves the qualities bound up in the expression "manner of manufacture" and the various different aspects of that expression, another the inventive qualities necessary to constitute a thing "an invention".

The actual wording of Section 6 of the Statute of Monopolies may be borne in mind : it was there provided :—

"that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures.".....

The "declaration before mentioned" refers of course to the declaration of the invalidity of monopolies as a whole : the patents here mentioned being by way of exception to that.

Since the Statute of Monopolies invalidates all Patents except those which are for "a manner of new manufacture", it becomes essential that a Patent, to be valid, must possess the qualities inferred by such term.

A consideration of the term reveals that it postulates two tests. Firstly whether the thing is a manner of manufacture: secondly whether the thing is new.

**"Manner of manufacture".**

Certainly in the earlier days of monopolies preceding 1623 and for the earlier period after the Statute of Monopolies it was common chiefly to grant monopolies or patents in respect of a whole single manufacturing trade: as for the manufacture and sale of gold thread (or, as it might have been in more modern times of footballs). It was no doubt with a mind to encourage within the realm new manufactures in that sense and in such manner that the Statute of Monopolies came to be worded as it was.

**Enlargement of the meaning of the term.**

Later, and especially in the great industrial revolution of the late eighteenth and early nineteenth centuries, the Courts came to extend the meaning of the word "manufacture" to include, besides whole manufacturing trades, lesser items of manufacture, and improvements of methods of processes of manufacture: with the result that there have been innumerable instances of patents for things small in themselves which have had far-reaching economic or humanitarian importance.<sup>1</sup>

At first the process of enlargement went so far as to include individual separate articles of manufacture but hesitated to include also processes.

The next step was for the Courts to decide to include such processes also, as it became realized that the process of manufacturing old articles by a cheaper, or more efficient means often constituted an invention of greater worth and importance than the manufacture merely of a new article. Among the earlier judgments giving rulings on these points, reference may be made to that in *Boulton and Watt v Bull*<sup>2</sup> in *R v Wheeler*<sup>3</sup> and in *Ralston v Smith*<sup>4</sup>. In *Boulton & Watt vs Bull*, in which case James Watt was one of the Plaintiffs suing for infringement of his patent relating to steam

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<sup>1</sup> See Terrell p. 48.

<sup>2</sup> (1795) 2 H. Bl. 463, or 126 E. R. 651.

<sup>3</sup> (1819) 2. B. & Ald 345, or 106 E. R. 392.

<sup>4</sup> (1865) 11 H. L. C. 224, or 11. E. R. 1318.

engines, it was observed (by Heath J. at page 482 referring to the Statute (21 Jac 1) as follows :—

“What, then, falls within the scope of the proviso ? Such manufactures as are reducible to two classes ; the first class includes machinery, the second substances ...formed by chemical or other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form.....I approve of the term “manufacture” in the Statute, because it precludes all nice refinements ; it gives us to understand the reason of the proviso, that it was introduced for the benefit of trade”.

Also in the same case (by Eyre C. J. at p. 492) as follows :—

“It was admitted in the argument at the bar that the word “manufacture” in the Statute was of extensive signification ; that it applied not only to things made, but to the practice of making ; to principles carried into practice in a new manner ; to new results of principles carried into practice”.

In *R. v Wheeler* it was observed (by Abbott C. J. at p. 349) as follows :—

“Now the word “manufacture” has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed, either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam-engine for raising water from mines. Or it may perhaps extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind”.

In *Ralston v Smith* it was observed (by Lord Westbury, L.C.) at p. 246 as follows :—

“Your Lordships are well aware that by the large interpretation given to the word “manufacture”, it not only comprehends productions, but it also comprehends the means of producing them. Therefore in addition to the thing produced, it will comprehend a new machine or a new combination of machinery ; it will comprehend a new process or an improvement of an old process”.

There is to-day not the slightest doubt on those points : patents are daily taken out for new improved methods of manufacture and for new processes as well as for new articles manufactured. There is still however even to-day a realm of invention relating to things which fall outside the meaning of the term "manner of manufacture" even as it has been enlarged by the Courts ; and for these things even to-day no valid Patent can be granted. Even in these days there frequently occur instances of inventions which are non-patentable and for which any patent if granted will be held on adjudication to be invalid for the reason that the subject matter to which it relates is not a "manner of manufacture".

### **Difficulty in formulating any criterion.**

When it is seen that a thing may itself be a manufactured thing (like a part of an aeroplane engine), that is to say in ordinary parlance the result, and not the manner, of a manufacture, and yet be held under Patent Law to be a "manner of manufacture"; and when it is seen also that a thing may be a manufactured thing (like a bicycle or a saucepan) and yet not be held under Patent Law to be a "manner of manufacture"—for want of subject matter ; it at once becomes clear that it is very difficult indeed to find any precise formula or definition in words to describe the meaning of the term. No doubt the term itself would have been altered or elucidated by qualifying or explanatory words by now, if it had not been that so many cases have been fought and so much time and money spent over the meaning of the term, that it has now, through the discussion and judgments in the reported cases, come to have a certain well known, though technical, meaning as a term of art in Patent Law. This being so it has no doubt been considered to be more to the public advantage to let the matter rest where it is, than by the enactment of a new definition to inaugurate an entirely new series of controversies as to the meaning of such new definition.

### **Manner of new manufacture.**

It has already been observed that the Statute of Monopolies refers to "a manner of manufacture". The definition of an invention in Sec. 2(8) of the Indian Act of 1911 (corresponding broadly to the similar definition in the English Act) also contains a reference to the same term<sup>5</sup>. An analysis of this expression at once reveals

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<sup>5</sup> See also the definition of "manufacture" in Sec. 2(10).)

a two-fold demand. The one being that the invention must be for a manner of manufacture, as mentioned, the other being that it must be for something new. This is obvious : what is rather less obvious, is the suggestion which has been made as a result of discussions in various cases, that the expression will be found on further analysis in truth to reveal a third requisite in addition to the two mentioned. It has been suggested that not only may a thing fail to be "a manner of new manufacture" in the patentable sense through not being new, and not only may a thing fail to be a "manner of new manufacture" in the patentable sense through not being a manner of manufacture, but that a thing, though both new and also a manner of manufacture, may yet in certain circumstances not be a "manner of new manufacture" in the patentable sense.

To elucidate this proposition it will be best, as an illustration, to take a quotation from one of the standard English works on Patents : from Fletcher Moulton at p. 15 : as follows :—

"From the earliest times the Courts have held that a manufacture of a thing new in itself does not necessarily constitute a new manufacture. It is in many, if not in all cases, the business of a manufacturer to constantly vary his products, and hence it follows that the novelty of the product cannot alone determine whether its production is a new manufacture. Probably the best criterion is whether that which is claimed as a new manufacture lies within the limits of development of some existing trade, in the sense that it is such a development as an ordinary person skilled in that trade could have naturally made, had he wished to. If so, then, even if the actual thing is new in fact and is a manufacture, it is not a new manufacture but simply a particular instance of an old one".

The learned author then proceeds to illustrate the proposition by reference to a new wall paper : pointing out that though the thing in such a case is new and a manufacture, it is not a "manner of new manufacture" in the accepted sense of the word ; since the manufacturer of wall papers is in the course of his business always producing new wall papers, he is expected to do so and there is no sufficient novelty in so doing to make the thing or the method a "manner of new manufacture." Reference is also made to a certain decided case where an application was made for a patent for casting tubular boilers (used for heating green-houses) in one piece—the practice up till then having been to cast in several parts. The

learned author suggests that, though this was an instance where the thing was new and a manufacture, it was not a "manner of new manufacture" within the accepted sense of the term. The third test which he suggests is this :—does the novelty appertain to the manufacture ?

### **Two tests as to the "manner of new manufacture."**

It is submitted that this refined analysis, though of interest in raising a discussion from which emerges a fuller understanding of the requisites of proper subject matter, is yet unnecessary. It is submitted that it is for practical purposes sufficient to consider the implications of the term "manner of new manufacture" merely under two and not three tests that is to say (1) is the thing a manner of manufacture in the accepted sense of Patent Law, (2) is the thing new in the accepted sense of Patent Law.

The question of novelty is treated hereafter as a separate question ; it may therefore for convenience be eliminated from the present consideration of subject matter proper.

### **Other elements of subject matter.**

It has long been recognised that certain other elements or tests of subject matter must also be considered. One such is the question of the existence of "the scintilla of invention" or of "an inventive step."

It is possible that the characteristic which the learned author had in mind in prescribing the tests "does the novelty appertain to the manufacture" had reference to or was connected with the same kind of characteristic as that now referred to under the head of "the scintilla of invention" or "the inventive step." Undoubtedly the question whether there has been an inventive step, is quite distinct from a question whether a thing is new. It is for present purposes an immaterial link between the two questions that it happens that an inventive step is a characteristic which can only occur (apart from exceptional cases) in relation to things which are new.

It will be noted that the definition of an invention given in sec 2(8) of the Indian Act of 1911 is as follows :—

"Invention means any manner of new manufacture and includes an improvement and an alleged invention" ; and the corresponding

English definition is in broadly similar terms. It may be that if it had been necessary to treat that definition as an exhaustive catalogue of all the elements of subject matter required to be found in a patentable invention, then, since an inventive step has long been considered to be a requisite, it would have been necessary to find words within such definition calling for an inventive step. In that event it would have been necessary for the existence of an inventive step to have been explained as being an element within the meaning of the term "manner of new manufacture". It may have been with this object that the learned author framed his test in that way—"does the novelty appertain to the manufacture"; that is to say with the object of embracing this requisite within the term "manner of new manufacture".

But it seems clearly unnecessary to treat the definition of "invention" in Sec. 2(8) as so exhaustive as to include all requisite elements of patentable subject matter. And indeed it has been held that it is not necessarily everything which falls within the definition of a "manner of new manufacture" that can be patented.

The point whether the term "manner of new manufacture" in itself embraces the existence of an inventive step appears in any event to be one of no more than academic interest. Since it has long been established that an inventive step is an essential part in the subject matter of an invention such as will support a valid patent, it makes no practical difference whether this element is to be considered as being within or without the term "manner of new manufacture".

For convenience of arrangement in this work the element of an inventive step is treated as an element of necessary subject matter outside the term "manner of new manufacture": and as a distinct element of subject matter which is inherently demanded in any invention which is to be the basis of a valid patent.

### **The scintilla of invention or inventive step.**

The thing patented must involve invention: or, as it has been put, it must involve "an addition to the stock of public knowledge". A very slight exercise of the inventive faculty is enough. If what has been termed the "scintilla" of invention or of the inventive faculty can be shown to have existed in the mind of the inventor, this will be enough. It is not necessary that there should have been

long search by the inventor or anything of that kind. It is however necessary that there should be an inventive step and an exercise of that invention which is necessary as the ground of a patent. It follows that amongst the tests required for subject matter, a further test must be fulfilled in regard to the existence of an inventive step *viz* :—

Is the thing such that its creation has called for the scintilla of invention in the accepted sense of Patent Law and has there been an inventive step comprised in the alleged invention ?

**Illegality : immorality.**

There is a further aspect of subject matter which should also here be considered. Since it is possible for a patent to be refused to be granted or for it to be revoked on grounds amounting to illegality and immorality, mention of these two qualities must not be omitted amongst the tests required for subject matter.

In view of the Statute of Monopolies, the whole scheme of which is to make an exception in favour of patents for inventions, in so far as they were for the public good but not otherwise, it is submitted that no alleged patent can be valid for an invention of which the purpose is illegal. It is submitted that the provisions in the Act of 1932 in England are merely declaratory and effected no alteration in the law in England.

For authority for this proposition reference may be made to Hindmarch at p. 142 where he states that in his view, even in his day, a patent for an illegal purpose would not be valid ; as for example a patent for an instrument only usable as a housebreaking implement. And it is submitted on this reasoning that it is one of the essential attributes of a good patent in India also that the invention to which it relates should not be for any illegal purpose.

To consider the matter from another angle, it has always been the law—quite apart from later legislation that a patent to be valid must be useful. From this point of view it may be surmised that useful means, not useful to the individual who may be a burglar or some other law-breaker or a crank or a lunatic, but useful to the public and to the state. If so, patents which are for an illegal purpose are ruled out also on the wider ground of non-utility.

As to patents for an immoral though not illegal purpose the



position is different. There is the difficulty : what standard is to be applied. The Courts are Courts of Law and not of morality. And there is no fixed standard of morals as there is of law by which any given case could be tested in the Courts. Certainly if the object of an invention could rightly be said to be immoral in such degree as to be not useful for the public good, there could be no valid patent therefor. Further than this it is submitted it is not safe to dogmatise.

### **Previous English Law.**

Before the amendments effected in England by the English Patents and Designs Act of 1932, there was no express provision making the illegality of the purpose of an invention a ground of invalidity available either as a defence in a suit for infringement or in support of an application for revocation. There was however even under the previous English Act of 1907 a provision under the old Section 75 somewhat similar in effect to the present Section 75, whereby the Comptroller of Patents was expressly empowered to refuse to grant a patent of which the use would in his opinion be contrary to law or morality.

### **Current English Law.**

There is now a direct provision under present English law by virtue of Section 25 (2) (m) which constitutes the illegality of the purpose of an invention to be a ground of invalidity, which may be raised as a defence in an action for infringement as well as in support of an application for revocation ; the precise wording being as follows :—

“that the primary or intended use or exercise of the invention is contrary to law”.

There is no provision in that section concerning inventions intended to be used for a purpose which may be adjudged to be immoral.

It is also provided by the current English Act by virtue of Section 75, that the Comptroller of Patents at the stage when the application for Patent is being entertained by him, may refuse to grant a patent, in effect, if the purpose of the Patent is either illegal or immoral : the wording used in that section being :—“of which the use would, in his opinion, be contrary to law or morality.”

**Indian Law.**

There is a provision under Section 25 of the Indian Act of 1911 whereby revocation of a patent can be effected if H. E. the Governor General in Council declares by notification in the Gazette of India that a "patent or the mode in which it is exercised" is "mischievous to the State or generally prejudicial to the public." There is also a provision by virtue of Section 69 of the Indian Act of 1911 whereby the Controller of Patents is given power to refuse to grant a patent "of which the use would, in his opinion, be contrary to law or morality".

There is no express provision under the Indian Act whereby either illegality or immorality are made any ground of invalidity either by way of defence to an action for infringement or by way of support to an application for revocation: it is possible that in such a case the point could be raised in support of a ground of lack of utility.

The position is the same as in England under the English Act of 1907 prior to its amendment in 1932.

**Unfitness to be the subject of the exercise of the Crown's prerogative.**

In addition to the aspects of subject matter already discussed there is one further aspect to be mentioned and one further test which must be fulfilled. In certain exceptional cases it is possible that a Patent will be unobtainable for want of subject matter even though the alleged invention may have complied with all the four tests already stated, that is to say, even though the thing sought to be patented is a manner of manufacture and comprises an inventive step and is not for an illegal use, or a use contrary to morality. For if it is for a class of article which is unfit to be the subject of the exercise of the Crown's prerogative, the grant of a Patent may be refused on this ground alone. It follows that among the tests required for subject matter a fifth test must be fulfilled in regard to fitness on general grounds for the exercise of the Crown's prerogative.

**Conclusion : Tests of subject matter.**

To summarise the foregoing discussion there are then, it is submitted, five principal tests as to subject matter : *viz* :—

- (i) Is the alleged invention a manner of manufacture in the accepted sense of Patent Law ?
- (ii) Is the alleged invention such that its creation has called for the scintilla of invention or has there been an inventive step in the accepted sense of Patent Law ?
- (iii) Is the alleged invention such that the primary or intended use of it is not contrary to law ?
- (iv) Is the alleged invention such that the primary or intended use of it is not contrary to morality ?
- (v) Is the alleged invention fit on general grounds to be the subject of the exercise of the Crown's prerogative ?

With these tests in mind it only remains to consider what class of cases have failed for want of subject matter and in what class of cases it has been held that no objection for want of subject matter could be taken. For illustrations of such cases reference may be made to the illustrative cases referred to below.

#### Cases.

An "Invention" is defined under Section 2 (8) of the Indian Act of 1911 as meaning "any manner of new manufacture" and as including "an improvement" and an "alleged invention". The definition of an "invention" under Section 93 of the English Act also defines it as meaning "any manner of new manufacture" the subject of letters patent and grant of privileges within Section 6 of the Statute of Monopolies and as including an "alleged invention". The cases in the United Kingdom relating to subject matter in regard to the question whether any particular invention is a "manner of new manufacture" commonly therefore make reference to the definition under Section 93 of the English Act. The principles on which these English cases have been decided will be none the less applicable in India in relation to the same question which arises here ; and in particular with reference to Section 2(8) of the Indian Act of 1911.

#### As to Manner of Manufacture :—

**A bare principle : or a mere plan : or scheme : or system : is not patentable :**

*In the Matter of an Application for a Patent by James Yate Johnson*<sup>6</sup>.

The application for Patent was for a process of colouring fertilizers and for the fertilizers so coloured. The Comptroller had refused the grant. It was argued in support of the Comptroller's decision that the colouring amounted to no more than the equivalent of colouring inks, tickets, stamps and the like for the purpose of distinguishing them one from the other. Held by the Solicitor-General (Sir James Melville) on appeal from the decision of the Comptroller :—

"After consideration of the arguments advanced before me and of the reported cases, I am satisfied beyond doubt that the decision of the Superintending Examiner is a right one and should be upheld. It is admitted that the addition of the colouring agent adds nothing to the efficiency of the fertilizer as a fertilizer. Its addition is merely for the purpose of avoiding confusion and enabling different fertilizers to be readily distinguished by those who use them, and especially by those who are not familiar with their composition. I do not consider that such a step adds such a characteristic to the vendible article as to constitute "a manner of new manufacture" within the meaning of Section 93 of the Acts, and I accordingly dismiss the appeal."

*In the Matter of an Application for a Patent by A. E. W.*<sup>7</sup>

In this case, on appeal from a refusal by the Comptroller to grant a patent for an application claiming "an odometer for motor vehicles and the like comprising one or more numeral wheels having signals associated with certain numerals to be displayed therewith upon completion, by the vehicle, of the mileage indicated by said numeral and thereby advise the operator of the vehicle of attention, such as the lubrication of certain parts, periodically required by the vehicle mechanism," it was held by the Solicitor General (Sir Henry Slessor) as follows :—

"In my view this case is really not distinguishable in principle from W's Application (1914) 31. R. P.C. 141. There it was sought, by means of coloured buoys, to say whether a buoy was outside a particular line of coast or not, that is, by painting a buoy red or

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<sup>6</sup> (1930) 47. R.P.C. 361.

<sup>7</sup> (1924) 41. R. P. C. 529.

painting it blue or placing some other appropriate signal upon the buoy. I do not think that the colouration of the odometer in this case, or the colouration of the buoys in W's case can properly be compared with some physical change such as shifting of a known mechanism to another angle or to the class of case where there really is a change in the mechanism as such. Here there is nothing more than colouration or some other similar device. I agree with the Assistant-Comptroller that what the Applicant seeks to protect is in substance a plan or scheme for reminding the driver that attention is required when certain distances have been run, and the method of colouring the odometer is merely one of the means of effecting that plan or scheme. There are a number of decisions which tend to the same conclusion. There is the case of W's Application which has been referred to, in which it was said that mere methods of arranging well known objects are not matters within Section 93, and there are also cases such as the musical notation case (M's Application, (1924) 41. H. P. C. 159) where it was held that the mere addition of printed or coloured matter by the side of a patented device such a pianola reel was not in itself a patentable invention. I think that a very clear distinction has been drawn between the present class of case, which is merely no more than a plan or an idea for bringing certain matter to the memory, and those cases in which there is really alteration of mechanism such as the alteration of the safety guard on motor omnibuses. For these reasons I hold that the Assistant Comptroller was right and that this appeal must be dismissed."

*See also W. R's Application*<sup>\*</sup> (An application for a patent for an alleged invention described as an educational appliance comprising illustrated charts for exercises and gramophone sound records.) Held there by the Solicitor-General (Sir Henry Slessor) :—

"I am of opinion that there is in fact no combination here at all, much less a patentable combination. There is at most a mere collection of two matters, the record and the chart, within the same room, and I think that it would be a misuse of words to describe the mere collection or simultaneous user of two instruments as a combination as that word is properly to be understood. That being so, I cannot see how the mere joint user at the same

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<sup>\*</sup> (1924) 41. R. P. C. 216

time of two instruments, neither of which is in itself a proper subject for a patent, can be brought within the principle governing the grant of patents for combinations. Here there is nothing more, as it seems to me, than a gramophone record on the one hand and a chart on the other hand which may be used together, or which possibly will be used together. For these reasons I am of opinion that the Assistant-Comptroller was right in refusing to accept the Application, and the appeal will be dismissed."

*See also P's Application*,<sup>9</sup> where the grant was similarly refused, the following observations being made by the Solicitor-General (Sir Henry Slesser):—

"In this case a claim is made for producing printed sheets to be used with a reflex copying apparatus, the essence of the claim being that the writing is printed backwards on a piece of paper, and, on being used in the apparatus, acts as a guidance to persons learning to write and draw. It is quite clear to my mind that the article here is printed matter, and that no particular article of manufacture is involved. I do not think it can be said that this printed matter is necessarily ancillary to the copying apparatus; it appears to me to be of a general character. What is sought to be patented here is no more than printed matter of a peculiar kind."

*Compare also M's Application*, a very similar case<sup>10</sup>, in which the following were among the observations made by the Solicitor-General (Sir Henry Slesser):—

"It was argued by Mr. Trevor Watson that this device constitutes an invention within the meaning of section 93 of the Patents and Designs Acts, 1907 and 1919, but in my opinion when the case is properly considered this device is no more than the printing of a part of a score on a perforated reel. It is quite clear that the printing of a score by itself cannot be construed to be an invention within the meaning of Section 93, and in my opinion the fact that the score or a part of the score, or a symbol showing what note is actually played, is printed upon or near the slot in the instrument which causes the sound to be played, does not take it out of the general principle that this is merely a method of printing musical notes. It is

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<sup>9</sup> (1924) 41. R.P.C. 201

<sup>10</sup> 1924 41. R. P. C. 159.

clear that the music produced on the pianola or musical instrument is in no way affected by the printing which it is proposed to put on the music reel, and therefore this alleged invention does in my opinion simply resolve itself into a new method of musical notation although that musical notation I agree is collocated to the sounding of a particular note."

*Compare R. B. C's Application*<sup>11</sup> where it was held that a certain scale or chart for map-reading was not in the circumstances of that case a manner of new manufacture. At the same time it was observed (at p. 157) that the mere fact that the invention was in the nature of a scale or chart was not conclusive against the applicant for patent; and on that point reference was made to C's application (1920) 37. R. P. C. 247 at 248.

*In R's Application*<sup>12</sup> the application for "improvements in and relating to indexes" was held not patentable. Certain extracts of the observations of the Solicitor-General (Sir Thomas Inskip) may be cited :—

"The question which I have to determine in this case is that which was stated by the Solicitor-General in Ward's Case (which is reported in 29 R. P. C. at page 79) whether what is sought to be patented by the Applicant can be regarded as an invention within the definition of Section 93 of the Patents and Designs Act 1907." ..... "All that I have to consider is whether that which is claimed by the Applicant is merely a scheme, an idea or a method; or whether it is a manufacture of which, applying the phrase which was used by Sir John Simon in Ward's case, the utility is purely mechanical."

"Mr. Bousfield contends that what is claimed to be an invention in this case is an idea of itself, and he says that if you look around and see the number of volumes in which the index which is the subject of this claim is contained, you will see at once that you have a very bulky subject matter, a physical object which is clearly a manufacture, and that this particular index is therefore a manner of manufacture within the meaning of Section 93. I have come to the conclusion that the decision of the Assistant-Comptroller is exactly the same as the decision at which I should have arrived if I had not

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<sup>11</sup> (1924) 41. R. P. C. 156).

<sup>12</sup> (1923) 40. R. P. C. 465.

been assisted by his view. I have to apply my mind to the facts of this case with the aid of the three judgments of the Law Officers to which Mr. Bousfield has referred. The fact that the idea embodied in this index enables one to obtain a mechanical result and to obtain something which is a manufacture like a volume or a series of volumes is not in my opinion sufficient. I have to ask myself the same question as Sir John Simon, when Solicitor-General, asked himself in Ward's case, the same question which Sir Edward Carson when Solicitor-General, had to ask himself in Johnson's case, and the same question as the Attorney-General, Sir Robert Finlay, had to ask himself in Cooper's case, namely: Is this a mere scheme or idea—it is true reduced to writing; or is it a mechanical manufacture which can properly be said to come within the definition to which I have referred? In Johnson's case it was pointed out that it was immaterial that a printed envelope was used, and in this case it seems to me to be immaterial that a sheet of paper is necessary to convey the idea which has come into existence in the mind of the Applicant to the mind of the person who has to apply the idea so as to produce a certain volume. The question which the Assistant-Comptroller appears to have asked himself, and which I ask myself is: Is this in itself a product of which the utility is mechanical? I do not want to use a new expression which may lead to greater difficulties than those which already exist in deciding this class of case. I do not for a moment say that this case is obvious apart from the guidance, to which I have referred, from the three reported cases. It is just the class of case which is likely to be the subject of appeal, as was Cooper's case, Ward's case, and Johnson's case, but with the guidance of the principles applied by the Law Officers in those cases I think that this is not an invention within the definition which I have to apply, and I therefore dismiss the appeal."

*Compare Ward's Application*<sup>13</sup> as to manner of manufacture under Sec. 93 of the English Act of 1907), where it was held by the Solicitor-General (Sir John Simon) that a certain system of indexing was not patentable.<sup>14</sup>

**A mode of carrying a principle into effect is patentable. A mecha-**

<sup>13</sup> (1911) 29 R. P. C. 79.)

<sup>14</sup> See also (1911) 43 R. P. C. 154 where it was held in effect that the fact that the method (or scheme) produced a vendible manufactured article was immaterial.



nical combination is patentable (none the less if it be for furthering a plan, scheme or system) :—

*In the Matter of an Application for a Patent by Companies Reunies des Glaces et Verres Speciaux du Nord de la France.*<sup>15</sup> The application for patent was for a combination of or method of mounting of known parts as an unbreakable windscreen. The Comptroller had refused the grant on the ground that there was no manner of new manufacture and no exercise of the inventive faculty. Held by the Solicitor-General (Sir Stafford Cripps), on appeal from the Comptroller's decision, that there was on the face of the specification a "manner of new manufacture" and that it could not be said that there was no "invention"; and the appeal was allowed.

With A. E. W's case abovementioned may be contrasted the case of *A. W. Loh's Application* reported in the same volume<sup>16</sup> where it was held that there was a novel combination, it being observed by the Solicitor-General (Sir Henry Slessor) as follows :—

"I think it is straining language to say that you have not in this case a combination. If that be so, it seems to me that the authorities are all in favour of the Appellant. This case seems to me clearly distinguishable from the case of *W's Application* (1914) 31. R. P. C. 141, the case of the buoys which was really a case of mere notative indications on the buoys. Here you have a specific invention depending upon the specific discovery of the form of the field of electric force finding expression in a specific complex of apparatus for the detection of that force. I agree entirely with what was said by the then Solicitor-General in that case, that mere systems of arranging well-known objects are not matters which come within Section 93, but what is suggested here is considerably more than a mere system of arranging well known objects, and at least one of the objects physically realised in this invention is based upon a novel discovery. In the present case, construing the claim reasonably, it is contemplated that these frames will either be permanently fixed or kept in defined positions by some contrivance. It is quite impossible that either the line of the axis of the crossed frames or the proper position of the side frames can possibly be accurately maintained on a moving body like a ship by merely

<sup>15</sup> (1931) 48. R. P. C. 185.

<sup>16</sup> (1924) 41R. P. C. 273.

laying the frames upon the deck, for it is vital in pilotage that the absolute accuracy of position of the frames should be preserved. The whole discovery, therefore, consists of one complex of apparatus for correct navigation, and in my opinion, the Assistant Comptroller was wrong in refusing to accept this application. I think it is properly a manner of new manufacture within Section 93, and I order that the Specification be accepted accordingly."

As another illustration of a case falling on this other side of the line, where the Patent asked for was granted, reference may be made to a well known case decided under the English Act of 1883 but on the same question of what constituted an invention in the sense of a manner of manufacture: *Cooper's Application*.<sup>17</sup> As is stated in the report of the case, it had been the practice of the Comptroller-General, after consultation with the Law Officers as to the meaning of the definition in Section 46 of the Act of 1883 to hold that although the last five words (*i.e.* the words "and includes an alleged invention") excluded all enquiry (at the particular stage) by him into the novelty of any alleged invention, they did not relieve him from the duty of satisfying himself that what was sought to be patented was an invention relating to some "manner of manufacture" within the Statute of Monopolies. In these circumstances the decision in the case of the Attorney General (Sir Robert Finlay), in common with the other decisions in the cases here collected, given at the stage of appeals from a refusal of the Comptroller to grant a patent, is of particular interest as being directly on the point as to what constitutes a manner of manufacture without any consideration of the question whether or not it is new. The alleged invention in that case consisted in leaving a space across the printed page of a newspaper to enable a person reading it to fold it along those spaces and thus avoid the trouble involved in reading over the folded part of the paper. The following extracts from the decision given by Sir Robert Finlay in the case will be of interest:

"A man could not ask for a Patent to be granted to him for a literary composition. That if anything would be the subject of copyright. In order to ask for a Patent a man must come forward saying that he has some invention with reference to a manufacture. You cannot have a patent for a mere scheme or plan—a plan for becoming rich; a plan for the better Government of a State: a plan for

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<sup>17</sup> (1901) 19. R. P. C. 53.

the efficient conduct of business. The subject with reference to which you must apply for a patent must be one which results in a material product of some substantial character. The Specification must show how some such material product is to be realised or effected by the alleged invention.... Now I take it that that points to a class of cases of which anyone who has followed the history of invention, in this country must have had experience where a man has attempted to take out a Patent for what is really a plan for the conduct of some branch of business, a plan for co-operative trading, a plan for securing the payment of discount in a particular way, and various other plans of that sort, which it is not the least necessary to refer to in detail. Now in furtherance of his application for a Patent for such plans he might propose that it should be carried out by virtue of a ticket containing printed matter arranged in a particular way so as to express what is to be done, or to enable the holder of that ticket, or coupon, or whatever it may be, to take his part properly in the development of the plan which the Applicant thinks he has invented and believes to be of public utility; and this direction I take to mean this: that the mere fact that one feature in the scheme was a printed sheet, or coupon, or ticket, or any equivalent, the invention being alleged to be an arrangement of words upon the sheet, would not form a subject in respect to which a Patent might properly be granted, because it would not be manufacture; in substance it would be a scheme, and the mere arrangement of printed matter in connection with such scheme would not prevent you from looking at the real object of the Applicant. To my mind the present application is of a different kind, and is not obnoxious to the direction on which so much comment has been bestowed. The present Applicant in no way proposes to arrange printed matter for its more convenient use from a literary point of view. What he proposes is a particular way of manufacturing a newspaper; and the alleged utility of his supposed invention is purely mechanical. It in no way is analogous to the arrangement of an index, or the arrangement of any other production of a literary kind, which may enable the reader more readily to appreciate the sense of the author. His proposal is not a proposal with reference to the arrangement of words upon the newspaper. His proposal is that a blank space should be left down the middle of the newspaper. The advantage of that is said to be the mechanical advantage that when you fold

your newspaper you will probably fold it down the middle either way, and then you will not interfere with any printed matter, and you will be able to read the newspaper more easily and more comfortably.....The question which I have to determine is for this purpose, I think solely whether this application relates to manufacture. I feel constrained to come to the conclusion that it does. There is no doubt that a newspaper is an article of manufacture. It is an artificial product. Mr. Cooper alleges that by following his directions, and leaving a blank space in the middle of the page each way, you will render it physically much more convenient for use than by printing it in the way hitherto accustomed. I do not see myself any difference, from the point of view from which I now am dealing with this matter, between such an application as this and an application relating to a proposal for so binding a book that it opens comfortably and conveniently for the reader, so that there should be no difficulty in unfolding it so completely that he would have the whole of each page lying flat before him, instead of being curved, and almost concealed, as it is in some old-fashioned methods of binding. There may be a vast difference in the utility of the two processes, but in point of principle it seems to me that the one must be regarded as a manufacture just as much as the other. Upon the whole, while I must repeat that I do not think that this case decided any question of principle, because the only point that has been argued is—whether the particular alleged invention satisfies the test to which the Comptroller referred to in his correspondence with Mr. Cooper, I must say that I have come to the conclusion that I think Mr. Cooper may have his Patent if he so desires”.

Regarding an application for a Patent in connection with counter and board games. The following official ruling was given by the Comptroller<sup>18</sup> :—

“The question having arisen upon an Examiner’s Report whether a patent for a game of the above character should be refused where the only novel feature (apart from the rules of the game) lies in the particular character of the marking upon the board, the following Ruling was given :—

“It may be stated generally, that where the claim made in

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<sup>18</sup> (1926) 42. R. P. C. Appendix A (p. i).

cases such as this is to apparatus for playing a game, comprising one or more playing pieces and a board marked in a particular manner substantially as shown in drawings accompanying the Specifications, the playing piece or pieces being moved in accordance with directions furnished in the Specification as to the manner in which the game is to be played, the requirements involved by the definition of an "invention" contained in Section 93 of the Acts will be held to be complied with, and the application will be subject only to such objection as may arise under Section 7 or otherwise in the normal procedure of examination."

**Manner of manufacture : Mere discovery is not patentable :—**

In *Hamilton Adams's Application*<sup>10</sup> the application for patent related to "improvements in and relating to agricultural processes" and was in connection with the rotation of crops. It was held that the matter was a discovery and not a patentable invention. The decision of the Solicitor-General (Sir Gordon Hewart) on appeal from the refusal of the Chief Examiner who had refused to grant a patent was to the following effect :—"If I thought that the difference between the Applicant and the Chief Examiner in this case was a mere question of words, I should have no difficulty in arriving at the conclusion that the Applicant desires. But I am satisfied that the difference is one of substance. The conclusion to which the Chief Examiner came was this, "that the alleged invention is in reality "a mere discovery, and a mere discovery is not in itself sufficient to justify the grant of a Patent"; and that "there is not in addition to the discovery any improvement in the method of carrying out any agricultural operations." My attention has been directed to two cases. The first was the case of *Lane-Fox v. Kensington and Knightsbridge Electric Lighting Company Ltd.*, in 9 R. P. C. 413. Lord Justice Lindley, in giving judgment (at page 416) said :—"An invention is not the same thing as a discovery. When Volta discovered the effect of an electric current from the battery on a frog's leg he made a great discovery, but no patentable invention. Again a man who discovers that a known machine can produce effects which no one knew could be produced by it before may make a great and useful discovery, but if he does no more—his discovery is not a patentable invention. He has added nothing but

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<sup>10</sup> (1918) 35. R. P. C. 90.

knowledge to what previously existed. A patentee must do something more : he must make some addition, not only to knowledge, but to previously known inventions, and must use his knowledge and ingenuity so as to produce either a new and useful thing or result. In the case of *Reynolds v. Herbert Smith & Co. Ltd.* reported in 20 R. P. C. 123, Mr. Justice Buckley, as he then was, in giving judgment said ( at page 126 ) :—"Of course the difference between discovery and invention is very familiar." No doubt it is very familiar, although it may not be very easy to define in precise terms. I am not satisfied, in spite—if I may say so—of the extremely interesting and learned argument which I have heard, that there is anything here which can properly be called an invention, and I think that the decision of the Chief Examiner must stand, for the reasons which he assigns in his decision. The result is that this Appeal is dismissed."

*In the Matter of an Application for a Patent by W. L.*<sup>20</sup>

The application was for an alleged invention for "Improvements in and connected with route-indicating phonic cables" ; which concerned a method by which the positions of ships at sea should be enabled to be ascertained. The Comptroller had allowed claims Nos. 3 & 4 of the Specification and granted a Patent in respect of those claims but had refused the grant in respect of claims Nos. 1 & 2.

On appeal to the Solicitor-General (Sir Henry Slessor) in respect of the decision as to claims Nos. 1 & 2, it was held that there was no novel combination, and there being nothing more than "the user of known instruments according to the dictates of common sense", there was no new manner of manufacture.

Similarly in another case *In the Matter of an Application for Patent by A. L.*<sup>21</sup> it was held as following :—

"What is claimed in this Claim appears to me not to be in the nature of an invention, but merely the discovery of a more expedient method of operating an old device, and is covered by the judgment of the Law Officer in the Application of the Deutsche Gasgluhlicht Aktiengesellschaft (26. R. P. C. page 101). There it was discovered that a direct current would produce a better result than an alter-

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<sup>20</sup> (1924) 41. R. P. C. 617.

<sup>21</sup> (1924) 41. R. P. C. 615.

nating current in connection with a filament. Sir William Robson, then Attorney-General, said that this was a discovery rather than an invention, and did not add anything to what was claimed by the Opponent. With regard to the second Claim which reads : "an embodiment of the improvement claimed in Claim 1, characterised by the feature that the constant direct current sent into the cable is produced simultaneously with high frequency electro-magnetic waves, emitted by a station of wireless telegraphy ; these electro-magnetic waves of high frequency producing in the receiving frames currents that act by induction upon a radiogoniometer frame in a known manner," I agree that this is merely a method for using known apparatus in a new manner, and indeed is at most a method of navigation rather than a manner of manufacture. For these reasons I think the Assistant Comptroller was right in refusing to accept the Application, and the appeal will therefore be dismissed."

*In the Matter of an Application by Louis Renault*<sup>22</sup> (regarding an application for a Patent in connection with a centrifugal oil purifying machine). The main question was whether the invention had been previously published or made available to the public. In considering that question a point arose as to whether there was a substantial part of the alleged invention applied for which was new. On this point the following observations having a bearing on the present point now under discussion as to what constitutes "invention", were made :—

"To say that, when the whole essence of the invention has already been discovered, the Applicant may succeed, because he has discovered certain additional advantages in what some former inventor has done, does not seem to me to be justified by the language of section 11 (1) (b). The whole of the invention sought to be patented has been published, none the less so because it contains certain advantages which are not disclosed in the prior publications."

**Manner of manufacture : Discovery of new purpose for old matter is not patentable :—**

*In the Matter of an Application for a patent by James Yate Johnson*<sup>23</sup> application for Patent was in regard to an alleged im-

<sup>22</sup> (1924) 41. R. P. C. 649.

<sup>23</sup> (1930) 47. R. P. C. 178.

provement in the manufacture of acetaldehyde. The Comptroller had refused the grant on the ground that the alleged invention was merely a non-patentable discovery. Held by the Solicitor-General (Sir James Melville), on appeal from the decision of the Comptroller, that the Comptroller was right ; and held that "the discovery that a known thing . . . . . can be used for a useful purpose for which it has never been used before is not alone a patentable invention."<sup>24</sup>

*In B. R's Application*<sup>25</sup> the application was for a process (or alternatively, on a suggested amendment, for an apparatus) for enriching with carbonic acid the atmosphere that envelops plants," the following observations were made by the Solicitor-General (Sir Thomas Inskip) :—

"Mr. Evans told me that the means, or what is called the mechanism in the Specification which are to be used for the purpose of gas purifying such as dust filters, oil separators washers, and the like are admittedly old methods or mechanisms. Therefore there is no new product, no new method of manufacture suggested, nor an old one improved, and under those circumstances the case appears to me to be very like the case of B.A's application (1915) 32. R. P. C. 345 in which Sir Stanley Buckmaster, the Solicitor-General, expressed an opinion with which I respectfully agree—and even if I did not agree with it I think it is an opinion which is now old enough at any rate to be followed—where he says, at page 349, line 38 : "It cannot be disguised that that is its purpose, and I still say that I regard it as one of the well established principles of Patent Law that when once a substance is known, its method of production ascertained, its characteristics and its constituents are well defined, you cannot patent the use of that for a purpose which is hitherto unknown."

"It is said that the combination of the purification, the means of conveyance and the green-house where the plants are to be treated constitutes a new invention, but, as I understand the law, the mere juxtaposition of a number of features is not such as to make a new invention ; you must have something more than juxtaposition ; you must have an organic combination which is to

<sup>24</sup> See also (1892) 9. R. P. C. 413 at page 416.

<sup>25</sup> (1923) 40. R. P. C. 469.



produce some result. In this case I have listened very carefully to the argument of Mr. Evans, but according to the view I have expressed there is no new product, no new method, no improvement on an old method, and no new combination of such a character as to make this Claim a good one, and I must therefore, dismiss the appeal"<sup>26</sup>.

*A. F's Application*<sup>27</sup> (as to manner of manufacture under Section 93.) The alleged invention for which a Patent was asked was for the use of a well known substance as an insecticide, such use being new. The observations of the Solicitor-General (Sir Stanley O. Buckmaster) have resulted in the case being treated as a leading case: he said :—

"The real question, therefore, is whether it is open to dispute that the description in Claims 1 and 2 of the Specification can cover what is known as an invention. In my opinion they cannot. It is an old and a well-established principle that the mere discovery of a new use of a particular known product is not what is meant by invention within the meaning of Patents Acts. It is outside the area which these Acts cover, and although in certain cases difficulties may arise when an old article or process is described for use in connection with a new manufacture, yet I can nowhere find any case that throws doubt on the proposition that where by the alleged invention no new product is obtained, no new method of manufacture suggested nor an old one improved, the discovery cannot be protected by a grant of Letters Patent. In the present case none of these merits are claimed; it is only suggested that the new use of a known product will thereby stimulate the old method of manufacture which is to be carried on in the old way". The appeal from the decision of the Chief Examiner acting for the Comptroller-General was dismissed and the Patent refused.

**Contrast :—new combination of application of known process and known product :—**

*In the Matter of an application for a Patent by I. G. Farbenindustrie Aktiengesellschaft*<sup>28</sup> The application for Patent was for im-

<sup>26</sup> Compare also (1923) 40. R. P. C. 467.

<sup>27</sup> (1913) 31. R. P. C. 58.

<sup>28</sup> (1929) 46. R. P. C. 271.

provements in the manufacture and production of rubber tyres. The Comptroller had refused the grant. The decision being important the following extract is of interest. Held by the Solicitor-General (Sir Boyd Merriman), on appeal from the decision of the Comptroller—"Put into non-technical language, the invention appears to consist in taking a known chemical substance and submitting it to a known process for producing what the Applicants claim to be a new result. ....As is so often the case in appeals under this Section, much of the argument was directed to the fact that in these proceedings I am not entitled to consider subject-matter, and, whilst broadly speaking this is true, I must of course consider subject-matter to the extent of determining whether an article for which protection is sought comes within the scope of what is known as "invention." It will not, I think, be disputed that both the Comptroller and the Law Officer have inherent powers to refuse the grant of a Patent, and these powers may properly be exercised in cases where upon the face of the Specification the alleged invention is one which, having regard to ordinary common knowledge, is neither new nor patentable. (See Comptroller-General's Ruling in *Wainwright's Case* (29. R. P. C., Appendix p.xi); *The King vs. Comptroller-General of Patents, ex parte Muntz*, 39 R. P. C. 335; and *D. A. & K's Application* (43 R. P. C. 154). I have read the reported cases to which my attention was called at the hearing, and indeed I have looked at most of the decisions given under Section 93. I observe from these that patents have been refused for the use of a known substance (a) as an insecticide (A. F's Application, 31. R. P. C. 58); (b) as a fertilizer (B. A's Application, 32. R. P. C. 348, and C. G. R's Application, 42. R. P. C. 320); (c) as fuel for internal combustion engines (D's Application, 38. R. P. C. 397). In all these cases the most the applicants had done was to discover a new use for an old substance. In my opinion, however, different considerations arise where the alleged invention consists not simply in applying a known product to a known use, but in subjecting a known product to a process which, as a process, is already known but the application of which to the product is alleged to be novel. In my opinion where this is the case it cannot truly be said that the resulting substance is the old substance, even though the article ultimately produced is a familiar article. In this case the Comptroller is saying in effect that butadiene is known as a chemical substitute for rubber; that the process of producing a

motor tyre by vulcanising rubber is known ; therefore to subject butadiene to the same process in order to produce a tyre is, at most, finding a new use for a known substance. The Applicants, on the other hand, say that the vulcanisation of butadiene in such a way as to produce the requisite elasticity is a new idea or a manner of new manufacture of motor tyres. They contend that the conversion of butadiene in a motor tyre by an appropriate process of vulcanisation is not the application of a known material either to a known or to a new use, but is rather the production of a new material in a form adaptable to a known use. I think that this contention is right. For the purposes of this decision, in the absence of any evidence to the contrary, I am bound to assume the novelty of this particular process of vulcanising butadiene. It seems to me to be quite irrelevant to say, as is no doubt the fact, that the application of the same process of vulcanisation to real rubber will produce a motor tyre, or that the application of another process of vulcanisation to butadiene will produce other articles, if it is assumed, as I do assume, that the vulcanising of butadiene into an article having the qualities of a motor tyre is novel.

Great reliance has been placed by the Comptroller on the passage in Sir Stanley Buckmaster's Judgment in *B. A's Application*, 32 R. P. C. 349, at line 37 : "In the present case there is nothing but a claim for a new use of an old substance. It cannot be disguised that that is its purpose, and I still say that I regard it as one of the well established principles of Patent Law that when once a substance is known, its methods of production ascertained, its characteristics and its constituents are well defined, you cannot patent the use of that for a purpose which was hitherto unknown." If I thought that this passage correctly described this claim I should unhesitatingly follow it. But I do not. On the contrary, I think that this case comes directly within the next succeeding passage (line 42). "You can, undoubtedly, associate it with any other material you like, and, by that means, obtain a new product for which you may claim protection, and if the applicant had sought to associate this urea nitrate with the certain well known forms of earth and had declared that by that means he got a certain manure, which could not be got if you associated it with different forms of earth, and that he was seeking to sell the earth so fertilised, that would be a totally different thing". I see no distinction in law, as a manner of new

invention, between associating the known substance, urea nitrate, with certain well known forms of earth and subjecting the known substance butadiene to a well known process of vulcanisation. If the one produces a patentable invention so, in my opinion, does the other."

### **Manner of Manufacture : Medicines.**

Ordinarily medicines and pharmaceutical compositions will be held not to constitute an "invention" or a "manner of new manufacture" within the meaning of Sec. 2(8) of the Indian Patents and Designs Act.<sup>28</sup>

Since there is no provision in the Indian Act corresponding to Sections 38 A of the English Patents and Designs Acts 1907-1932, the position under the Indian Act is not altogether clear and is somewhat unsatisfactory. It would appear that a mere mixture is patentable in British India, though such as could not be patented in the United Kingdom.

### **Manner of Manufacture : Manufacture to be in some way associated with commerce and trade :—**

A curious case which illustrates a somewhat different aspect of the connotation of the words "manner of manufacture" is the following :—*C & W's Application*<sup>29</sup>.

The application there was for a patent in respect of a process for extracting metals from living human bodies, and particularly for extracting lead from persons suffering from lead poisoning. On an appeal from the decision of the Supervising Examiner acting for the Comptroller-general who held that the alleged invention was not a manner of manufacture within Section 93, the Solicitor-General (Sir Stanley O. Buckmaster) in the course of his decision upholding the decision of the Examiner made the following observations :—

"I think it desirable that I should state a little in detail the reasons which have led me to this conclusion. By Section 93 of the Patents and Designs Act of 1907 an "invention" is stated to be "any manner of new manufacture the subject of Letters Patent and grant

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<sup>28</sup> See the Patent Office Handbook 5th edn. p. 118.

<sup>29</sup> 1914 31. R. P. C. 235.

of privilege within Section six of the Statute of Monopolies." Now the Statute of Monopolies declared and enacted that grants of monopolies should be void, and Section 6 of the Statute contained provisions excluding from this general declaration "any Letters Patent and grant of privilege, for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm." In point of fact that does not afford any satisfactory definition, because it simply repeats the phrase "new manufactures" but it repeats it in a new position, and it shows that what is meant by "new manufactures" is something associated with the manufacture or sale of commercial products as I think is made clear by the latter words of Section 6, which say, "so as also they be not contrary to the law nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient." I think therefore we must start with the assumption that an invention within the meaning of the Patents Act 1907, is an invention for a manner of new manufacture that is in some way associated with commerce and trade. It is quite plain that that does not merely mean that it must be a product. A manner of new manufacture may be a thing newly made, or a substance which, if made before, is improved in its manufacture, or, quite apart from that, it may be a machine or a process that can be used in making something that is, or may be, of commercial value. If I am right in that view, the question which I have to consider is whether the process described in the present Specification is something to be used in the making of an object that is or may be of commercial value or is a process adapted to that end. I find it difficult to see that it is. It is in fact a process by which certain well-known electrical apparatus is to be applied for the purpose of extracting lead from living objects. Further I think, on a true reading of the Specification, those living objects are meant to be human beings. So far as human beings are concerned, it cannot be suggested that the extraction of lead from their bodies is a process employed in any form of manufacture or of trade, though the human being may be a better working organism when the lead is extracted.

Then it is said it might be applied to other animals. That is so, but, in my view, that is not what the Specification contemplates; if it were an Application simply for the use of the process for the

purpose of removing lead from animals in order to make them better marketable products it might be that different considerations would apply. My judgment is not intended to exclude any such Application ; it is merely intended to cover this, that the application of a process for the removal of either lead or other noxious substance from the human body is not, by itself the subject matter of invention within the meaning of the Statute. I notice that the Patent Office have based their refusal upon the ground that the alleged invention relates simply to medical treatment, and I think that the foundation for that refusal is sound.

I have only to add this. It has been urged and I think quite rightly, that the question of humanity ought not to affect the decision in such a case as this. I agree. Of course, it is well known that the medical profession do all in their power to discourage members of their body from obtaining protection for any discovery that has for its object the alleviation of human suffering, and it is impossible to speak too highly of such conduct, but it cannot affect my judgment in arriving at a conclusion upon the terms of the Section of the Act of Parliament, and I have altogether excluded such considerations from my mind. For the reasons I have given I think that this appeal should fail. I repeat, if the Applicant desires to apply for something applicable to merchantable articles like sheep and cows, that may be the subject of different considerations.

**Manner of manufacture : patent for a bio-chemical process : plant patents.**

The first instance (and an interesting example) of a case relating to a Patent for a bio-chemical process founded on researches in bacteriological chemistry to come before the Courts in England was that of *Commercial Solvents Corporation v. Synthetic Products Co. Ltd.*<sup>30</sup> ; in which a patent for a process of fermentation by specially selected bacilli was upheld, the suit being a suit for infringement.

There appears to be no reported case in the United Kingdom of a patent having been granted for the production of a new species or type of an agricultural or horticultural plant. It is tentatively submitted that a case might arise, where a particular type of plant was the result of a particular scientific process of selective crossing,

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<sup>30</sup> (1926) 43 R. P. C. 185.

in which the invention might be held to be a manner of new manufacture and patentable. There would seem in theory to be little difference between such a biological process resulting in an agricultural product and a bacteriological process such as was patented in the case abovementioned.<sup>31</sup>

### **Alleged invention :—**

When deciding whether a thing is a manner of new manufacture within Section 93, as to the force to be given to the words which occur in that section "or an alleged invention"—the position taken up by the Comptroller in England and on appeals from his decisions by the requisite appeal tribunal has now become well established. It was well put in the case of *W's Application*<sup>32</sup>. The application was for a patent in respect of a certain manner of use of buoys for navigation purposes. The material observations of the Solicitor-General (Sir Stanley O. Buckmaster) were as follows :—"Again Mr. Justice (Counsel for Appellant) said, none the less it may be an alleged invention, that is to say, it may be an alleged new manufacture. It is necessary that I should explain what I understand those words in the section to mean. I understand them to mean something which is alleged as manner of new manufacture, even though, in fact, it may not be a new manufacture, though if you take the allegation as it stands it would appear to be a new manufacture. If, however, something is not, and, as alleged cannot be a manner of (new) manufacture, it cannot possibly entitle you to protect it under Section 93 merely because you have said that it is. You cannot make black white by calling it white ; it still remains black, and if you are once quite satisfied that what is referred to is not the subject of invention it cannot be turned into one by saying that it is. Therefore, I think the words "alleged invention" do no more than relieve one from the necessity of seeing whether it has been covered before by other Patents, whether it is a matter of common knowledge, or something

<sup>31</sup> Patents are available in the United States of America for the production, by scientific selection and crossing, of new species or types of agricultural or horticultural plants. It is understood however that this is not owing to any distinct interpretation in the U. S. A. of the term "manner of new manufacture," but by virtue of special legislation for the purpose.

<sup>32</sup> (1914) 31 R. P. C. 141.

of that kind. You cannot turn into an invention that which, from its nature and character, cannot be invention by alleging that it is one. I take the view that this case is within those which have decided that mere systems, more convenient methods of arranging well-known objects so that you may have them handy for reference, are not matters within Section 93. No one of the Claims in this Specification covers what is, in my opinion, meant by the word "invention" as used in the Statute, and, although no reason is given in the Chief Examiner's decision, I should imagine that that was what induced him to refuse this application and I must support his decision and dismiss the appeal."

It may be assumed that the Controller of Patents in India will adopt the same principles.<sup>33</sup>

It is possible that the words "alleged invention" were inserted in Section 2(8) with the object merely of assisting in giving effect to certain portions of the Act, as for example such passages of the Act as relate to the making of an Application for a Patent in Sec. 4, where the applicant is enjoined to describe the nature of the "invention" in the specification. For it is immaterial for the purpose of Sec. 4 whether what the Applicant thinks to be an invention is in Patent law in truth an invention or merely an alleged invention. Compare also the following case where the same matter was again discussed *viz.*, *S's Application*.<sup>34</sup> The alleged invention there consisted of having on one side of a gramophone disc a music record and on the other side a spoken record in explanation or description of the music. It was held that this was a mere system which was not a manner of new manufacture. The decision of the Solicitor-General (Sir Thomas Inskip) which states certain principles of interpretation of the term "manner of new manufacture" may be cited here in full :—

"In this case the Supervising Examiner has declined to accept the Application on the ground that the alleged invention is not a manner of new manufacture within Section 93 of the Patents and Designs Act, 1907. It is contended by Mr. Moritz on behalf of the Applicant that the refusal to accept the Application on the ground

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<sup>33</sup> See also (1922) 39 R. P. C. 335 at p. 339.

<sup>34</sup> (1929) 40 R. P. C. 461.



that the invention was not a manner of new manufacture proceeded upon the view that, inasmuch as doublesided discs had been well known before the Specification in question here, the Specification did not state a manner of new manufacture, the alleged invention being merely the substitution of spoken words on the reverse side of the disc explanatory of the music for what generally are musical records. It is contended that that conclusion has been arrived at by separating the word "new" from the word "manufacture" and considering first of all whether it is a manufacture and then secondly whether it was new, and that, it being admitted that it is a manufacture, it has been held that it is not new, and therefore it is not a manner of new manufacture. I am not clear that that is exactly the way by which the Supervising Examiner arrived at his decision, nor do I think that the proper interpretation of those words is to be arrived at by separating the words, and considering the word "new" as apart from the word "manufacture" and by saying that the only question the Comptroller has to consider is "manufacture" and that "new" is something that has to be postponed to a future date when the Comptroller has come to the conclusion that it is a manner of new manufacture within the meaning of Section 93 of the Patents Act. I think the words "manner of new manufacture" must be read as a whole, and if the subject matter of the invention is merely the re-arrangement or adoption of a plan or of a system which cannot, properly speaking be said to be a new manufacture, then it is not a manner of new manufacture within Section 93 of the Act."

**As to the scintilla of invention : inventive step.**

It is merely necessary to observe that the phrase often used in the cases "an inventive step" does not refer to any step by which the inventor achieved his invention but to the step of addition to previously known inventions comprised by the invention itself. In some cases by reason of the very nature of the thing sought to be patented it is possible to say that it is not an "invention" without considering at all the degree of public knowledge existing before the discovery of the thing sought to be patented. In many cases, probably the majority of cases, particularly those relating to improvements, it is necessary to consider the difference in public knowledge before and after the so-called invention and to consider how far this

difference constitutes an "inventive step." It will be noted that in exercising this mental process the question of novelty as such is excluded : for the step may well be new without being inventive in the sense used in patent law.

See *Tomlin v. Acme Engineering Co., Ltd.*<sup>35</sup> This was an action for infringement during which a defence of invalidity was raised, inter alia, on the ground of want of subject matter. The defence succeeded ; and the patent was held invalid for want of subject matter on the principle that there was no sufficient inventive step in the alleged invention. The alleged invention was in regard to "improvements in and relating to Fish Cookers" and related to a means of ventilation in the flue which was claimed to eliminate fumes and to have other advantages as in the prevention of the accumulation of fat, grease and soot. The point now under consideration is dealt with in the following passages in the judgement of Farwell J. (at p. 126) :—

"The first question that I have to consider is whether the Patent is valid. The real crux of the whole of this part of the case depends upon whether there is sufficient subject matter to support this Patent.

The invention or the alleged invention consists, as I understand it, of a cooker in which there is a single flue, in which flue there is a fan. As I have already said and as in fact is admitted in the Specification itself, a downward flue is nothing new. The insertion of a fan inside the flue is something new ; that is to say, so far as the evidence before me goes, that particular device had not been adopted before. It is said that the evidence establishes that there had been for long a great desire on behalf of persons interested in this trade to get a cooker which would get over the difficulties which I have pointed out ; that I must assume, because there is no direct evidence about it that many persons engaged in the art had all sought a solution of those difficulties, and that this invention or alleged invention solved the difficulties, because the result of cookers being made in the way described in the Specification has led to great success for that particular form of cooker.

That it was known that with the use of cookers with an

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<sup>35</sup> (1934) 51 R. P. C. 117.

upward flue there were the dangers or disabilities pointed out in the Specification is not in doubt.

It is said that there is evidence before me that persons interested in this matter were seeking a solution of those difficulties. The evidence is not every impressive. One gentleman did say that there were these difficulties, and that people were looking for a means of getting over them; but how far persons of engineering skill had really turned their minds to a problem which, after all, is a comparatively small one (by which I mean that the trade is a small trade, and the problem is not one which is likely to excite the interest of any very large number of skilled engineers), or how far there was any real attempt on the part of persons skilled in the art to solve this problem, if there was a problem, is not very clear, nor is the evidence on the part of the case at all satisfactory. I will assume that there was a problem to be solved, and I will assume that persons were seeking to solve it. But even assuming that, as only one cooker constructed in accordance with the Specification, that is to say, with this single flue, was ever made, and the whole of the evidence as to the success of the cookers is in regard to cookers which are not made in that way, that evidence appears to me to be quite useless for the purpose for which it is sought to be used. There is, in my judgment, no such body of evidence as ought to lead me to come to the conclusion that there was a serious problem to which persons' minds had been seriously devoted, that those persons had failed to solve the problem, and that ultimately this solution was found, which at once was such a commercial success as to illustrate the fact that there must have been sufficient subject-matter to support this Patent. I can well understand that, if a solution to a problem has long been sought, that many persons have tried in divers ways to solve that problem and have failed, and some one comes along and solves it by a means which, when the solution is presented to the world, would seem to be quite obvious, the mere fact of that long research and failure and the commercial success attending upon the invention would be so impressive as to make it impossible for the Court to say that what might otherwise have been thought to be an obvious step is in fact an obvious step so as to deprive the inventor of his protection. In my judgment, there is no such evidence in this case at all, and I cannot bring myself to think that merely putting a fan into a flue is such an inventive step as would

support a Patent. The dependent flue leading down into the fire or below the fire was perfectly well known at the date of the Patent. For years engineers knew that the use of a fan was an obvious method of operating on gases or fumes for the purpose of getting turbulence, and the mere combination of a flue of a particular shape which was well known and the fan does not seem to me to be such a step as can be said to be an inventive step or one which could support a Patent. In my judgment, this Patent is invalid for want of subject matter.

See also *Woodrow v. Long Humphreys & Co. Ltd.*<sup>30</sup> The alleged invention related to man-hole covers for streets. The following short extracts from the judgments by the Court of Appeal are of interest :—

Lord Russell of Killowen :—It being accordingly known that one triangle supported at each corner will cover a manhole without rocking, is there invention in discovering that two or more triangles each supported at each corner will also cover a manhole without rocking ? I think that the answer must be in the negative."

Romer L. J. :—But the defendants then say that this was an obvious thing to do. Now that the Plaintiff has done it, it does, I agree, look obvious. But in questions relating to patents it is more than usually necessary to beware of that wisdom that comes after the event. Mr. Sissons, one of the Plaintiff's witnesses and himself an engineer said in evidence that, when he first saw the Plaintiff's rectangular cover he wondered why somebody had not thought about it before. Mr. Parr, another engineer, said the same thing. And yet both these gentlemen had been making attempts, or at any rate had been interested in the attempts that had been made, and made unsuccessfully to design non-rocking covers. For myself I find it difficult to give a satisfactory answer to this question. If the thing was so obvious how comes it that it was not thought of before ? The difficulty in answering this question in similar circumstances has saved many a patent, and I should have hesitated before coming to the conclusion that the Patent in suit failed for want of subject-matter had the claim been limited to rectangular covers. But it is not so limited, and triangular covers are within it. So too are covers

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<sup>30</sup> (1934) 51 R. P. C. 25 (C. A.)

with five or more sides, though this cannot affect the validity of the Claim, if there would be subject matter in a claim limited to rectangular covers. If it required the exercise of the inventive faculty to apply the principle of three point suspension to rectangular covers it was equally required for the application of this principle to pentagonal and hexagonal covers and so on. Some point was endeavoured to be made by the Defendants out of the fact that covers in the shape of stars with four or five or more points are within the Claim. So they are, though no one can suppose that the Plaintiff had such covers in his mind. But this cannot affect the validity of the Patent. Such covers, it may be conceded, would have no commercial utility, but they would have patentable utility and that is material for the present purpose. Nor could a claim to such covers be devoid of subject-matter. If, as we are told, genius be akin to madness, then whatever else might be said about them they could never be said to be wanting in ingenuity; for only a lunatic could conceive the idea of plastering our streets with models of gigantic starfish. The inclusion within the Claim of triangular covers is, however, a very different matter. Such a claim by itself would in my opinion and for the reasons I have already given be a bad one.

But it is contended on behalf of the Plaintiff that, even if this be so, the Claim in the Patent in suit is nevertheless a good one. It is said that the Claim in its totality has subject-matter, and that this is sufficient. If the first part of this statement could be accepted I should agree with the second. But I cannot agree that a claim in its totality has subject-matter if it includes, as this one does, something that has none. If the Claim in its totality be good, the owner of a Seamac cover who for convenience of weight divided it in the manner to which I have referred earlier would be infringing the Plaintiff's Patent and could be restrained from using the divided cover. And yet between this divided cover and the Seamac there would be no patentable difference. Its owner would therefore be entitled to plead that the alleged infringement was not "new," to use the words of Lord Justice Moulton, and such defence would succeed. (See *Gillette Safety Razor Company v. Anglo-American Trading Company Limited* 36. R. P. C. p. 465 at p. 480) The Plaintiff would fail because his Claim included something that was bad. The legislature has recognised and provided for the possibility of one or more of the patentee's claims being held to be bad and the rest of them

good. But it would in my opinion be contrary both to principle and authority to treat a claim as having sufficient subject-matter purely because a large, and it may be the largest, part of it has subject-matter, if the rest has none. For these reasons I am of opinion that this appeal should be dismissed with costs."

(See also *British Celanese Ltd. v. Courtaulds Ltd.* (1933) 50 R. P. C. 63 and in the same volume, at p. 259 (on appeal).

See also *Ackroyd v. Strange*.<sup>31</sup> The alleged invention related to improved hair curlers. The following short extract of the judgment of Maugham J. (at p. 103) shows how evidence of a long felt want successfully overcome has a bearing on the question whether or not there has been a sufficient inventive step. In that case it was found there had been no longfelt want and there was also no inventive step. The passage in point is as follows :—

"I fully accept the doctrine to which I have already referred in other cases, that if there has been a long-felt want in any particular art or industry and many people have tried to supply the want the circumstance that then the inventor has provided a method of supplying the want, whereas a number of people have presumably not been able to do it, is cogent evidence that there was invention in the process or in the method which the inventor has adopted. In the present case I see no reason to think that Mr. Ackroyd, who is one of the inventors, wanted to have, as I have said, more durable curlers.....I cannot hold having regard to the curlers that were in use and well known at the time, that there was any inventive step in making this small improvement.

With regard to the facts, I will mention that the reason why I do not credit the story that Mr. Ackroyd ever thought of trying to make tubes stronger is to be found in pages 22 of the Shorthand Notes of the first day when he is giving evidence and is making statements that not only are, in my opinion, quite inaccurate and incredible, but are also opposed, in my view, to the evidence which Mr. Swailes, the manufacturer, gave when his evidence was interposed on the second day, for he stated at the beginning of his cross-examination that the question of the strength of the tubes had never been raised.

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<sup>31</sup> (1933) 50 R. P. C. 23.

On the whole, therefore, my opinion is that the Patent is invalid and that the action accordingly fails and must be dismissed."

See *Bonnard v. London General Omnibus Co. Ltd.*<sup>33</sup> That case was decided in the House of Lords against the Plaintiff (who was suing as Patentee for infringement) on the ground that the patent was invalid for want of subject matter in effect by reason of there being no inventive step. The following extract from the observations of Lord Shaw (at p. 14) is enough for the present purpose:—"The whole question is purely one of law, and is confined to the point whether this Patent contains patentable subject-matter. In considering that question—a question of law—it is legitimate, no doubt, to take into account the previous efforts to find a supply for a long-felt want. In the ordinary cases which arise in the Courts of law that process is given in evidence with some elaboration, namely, for example, long search, possibly attempts which fail, in many cases applications for Patents which are found to be unavailing, and a whole review of these things is exhibited in evidence, these experiments and searches sometimes extending to many periods of years. This case is as remote as could possibly be from the ordinary experience of the Court in this particular. But, while there is no such evidence of long search, no such evidence of serious and protracted and difficult attempts to find a remedy, yet even if there had been, the question of subject-matter would not thereby have been concluded. All that results from such a proof, be it elaborate or simple, is only the production before a Court of law of an element of assistance in the consideration of the problem whether subject-matter exists. Under those circumstances what was required was to make the slatted guard slanted instead of straight....." "There is no structural difficulty at all," says the witness; "the difficulty was in thinking of this method." And it now turns out that the so-called method was simply to take the slatted guard and put it on the slant to make it cover the advance of the wheel. The general public is concerned in these questions of patents with resultant monopoly rights for the most simple device, and the present device appears to me to be one which might well have occurred to an intelligent person, without any exercise of that invention which is necessary as the ground of a Patent."

**As to the inventive step requisite for a derivative patent : selective patents.**

If the invention comprising the applicant's patent is wholly anticipated by another Specification, then clearly the grant will be refused or the patent, should it be granted and later be objected to, will be held invalid. Where it is not wholly but only partially anticipated there will in many cases be a sufficient inventive step to give the applicant a right to the grant of a patent provided proper steps are taken to limit the invention patented to that field only in which it constitutes an inventive step in advance of the other Patent ; as may be done by the requisite disclaimer and or by a Reference by number to the other Specification if necessary. And this may be so even in cases where the inventive step is properly speaking within and not outside the realm of the other patent. For the mere fact that the basic principle on which the applicant's patent is based has been claimed in a previous Patent and, it may be, in a 'Master Patent, is not in all cases a bar to the grant of a new patent : it does not by any means in all cases mean that there is no room for a further inventive step even within the field of the basic principle of the previous patent which may form the subject matter of a fresh patent. This is well illustrated by the observations of the Comptroller General in *Hopkins Case*<sup>34</sup> in connection with the procedure for the insertion of Specific References in Specifications<sup>35</sup>.

"The question that arises is whether in any particular case what is alleged to be the invention in the narrower sphere is a sufficient inventive step when compared with the other invention in the wider sphere to constitute patentable subject matter."

The same question, that is, whether the applicant is entitled to a patent for an invention which falls properly speaking within the sphere of a previous wider invention, occurs commonly in connection with patents relating to the mode of manufacture of alloys.

The leading case in which the principle relating to selective patents was enunciated, which has since been cited consistently with approval was *Hills v. The London Gas Co.*<sup>36</sup> The effect of the decision

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<sup>34</sup> (1909) 27 R. P. C. 72.

<sup>35</sup> See also remarks inch below : re references.

<sup>36</sup> 1 Goodeve's Patent Cases (1884 edn.) p. 244.



in that case was summed up by the Comptroller-General, Sir Robert Finlay S. G. in a passage in his decision in the case of *Wylie & Morton's Application*<sup>87</sup> as follows :—"What that case decided was this—that if there were an earlier patent mentioning generally all oxides of iron, there might nevertheless be invention and discovery in finding out that one of the oxides of iron had particular advantages which were not shared by the other oxides of iron, and that if the jury found that the subsequent Patentee had exerted invention and had thereby picked out one of the class of oxides covered by the general terms of the earlier patent, the Court would not, merely on the ground of the fact that the earlier patent contained general terms which would include the particular article which the second Patentee proposed to use, hold that his patent was anticipated, and therefore bad. To that proposition of law I absolutely assent....."

In the case of *Wylie & Morton's Application* (already referred to) the application was for a Patent for the use of bisulphite of chromium and bisulphite of iron for dyeing purposes. The application was opposed on the ground that the alleged invention had been patented on an application of prior date (Patent No. 11456 of 1884) when a Patent had been granted to one Gatty which had been for a process of dyeing by using mixed solutions of any soluble salt of chromium and any soluble salt of iron and the claim had been "for dyeing certain fast colours on cotton yarns and fabrics by fixing upon the said yarns or fabrics a mixture of oxide of chromium and oxide of iron substantially in the manner described." At the hearing of the opposition proceedings it was not disputed that bisulphite of chromium is a soluble salt of chromium or that bisulphite of iron is a soluble salt of iron ; and therefore that the terms of Gatty's Patent of 1884 were wide enough to include the salts which the Applicants proposed to use. The question to be decided then was, as stated in the decision of the Law Officer : "Is it established that the Applicants have shown invention in picking out from the many soluble salts of chromium and of iron a particular salt, the bisulphite, which has advantages not shared by the other soluble salts to which Gatty's Patent of 1884 related ?"

The decision of the Law Officer, Sir Robert Finlay, (Solicitor General) (upsetting the decision of the Comptroller General who had decided that there was an inventive step and that a patent should

<sup>87</sup> (1896) 13 R. P. C. 97 at p. 98.

be granted to the Applications) was that on the facts as shown by the evidence produced in that case there were no special advantages in the selection and no sufficient inventive step; he refused the grant on that ground.

Another leading case relating to selective Patents, in which case the Patent was granted, is the case of *Nahnsen's Application*<sup>38</sup>. There the application was for a Patent for "Improvements in nitro-glycerin safety blasting explosives." The claim was for "the manufacture of a safety explosive from 30 parts nitro-glycerin and a powder admixture containing 38 parts cellulose and 32 parts chili saltpetre." The grant was opposed by Nobel's Explosive Company Ltd. (among other grounds) on the ground that the invention had been patented on an application of prior date (No. 442 of 1869) when a patent had been granted to one Newton for "Improvements in the manufacture of explosive compounds": in which the claim had been for "the use as explosive compounds of a combination of nitre, either nitrate of potash, soda, baryta or lead, with carbon, or substances containing carbon or hydro-carbon, such as coal, starch, rosin, sugar, or other analogous substance, and nitro-glycerine, the latter besides its own development of power, serving the purpose of greatly quickening the combustion of the other ingredients." On this point the following observations made by the Law Officer (Sir Richard Webster, Attorney General) on the hearing of the Appeal from the decision of the Comptroller General may be noted:—"I am of opinion that in this case the decision of the Chief Examiner was right, and must be affirmed. The responsibility of stopping a patent is a very serious one, and it is only in the clearest cases, that a patent can be stopped, and although I have never hesitated to exercise that jurisdiction when I am satisfied that there is identity, yet still I can only do so where I am clear that the merits both in form and substance rest with the Opponent." (He then considered the Specifications). "That brings me at once to the very difficult question, if a Specification of a Patent has described a combination which would in terms include every proportion, is that to be held to be the patenting of an invention on an application of prior date, so as to preclude persons from afterwards being entitled to have a Patent for a specific proportion. In my opinion no absolute general answer can be given to that question. Each case must be decided on its particular facts ;

<sup>38</sup> (1900) 17 R. P. C. 203.

but I should be disposed to lay down, for the purpose of this class, this rule for guidance, that you must be satisfied from the earlier Specification that the prior Patent deals with the difficulties and dangers which would be met, wholly or in part, by the adoption of any particular proportion; and that in claiming the whole range, the Specification indicated that the whole range was applicable to the particular dangers and difficulties that had to be met.".....

"I therefore come to the conclusion that it is not sufficient, in order to stop a subsequent Patent, that the range of proportions should be large enough, or the description of the claim wide enough to include proportions which are subsequently sought to be patented. It may very likely be that the merit of the invention does consist in taking out the particular proportions, and although I do not use it in any way against the Opponents, I think that the late Mr. Nobel would have been the first to have admitted that there might be almost as much invention in finding proportions, in view of the practical difficulties, as in generalising as to the possibility of the whole range of proportions being useful. I therefore come to the conclusion that upon the ground upon which this Patent is sought to be stopped, namely, the allegation that the invention has been patented under a Patent of prior date, I cannot stop the grant, and that the Patent must be sealed."<sup>39</sup>

**Manner of new manufacture : inventive step : foregoing principles acted on in India.**

The foregoing principles regarding what is a manner of new manufacture, what is an inventive step, have been adopted and acted on in India in a reported case decided by the Bombay High Court : see *Lallubhai Chakubhai Jarivala -vs- Shamaldas Sankalchand Shah*<sup>40</sup>. (On Appeal before Sir John Beaumont Kt. C. J. and Mr. Justice Rangnekar.) Two very lucid and comprehensive judgments were given on this point in this case. It is one of the few cases in India, officially reported, where questions of Patent Law in India were gone into in detail. The patent in question was for a process for treating almonds and dried fruits for whitening them without causing loss of flavour. As the material passages deal with both of the two closely related questions, what amounts to a manner of new

<sup>39</sup> See also 5 R. P. C. 345 ; 5 R. P. C. 347 ; 9 R. P. C. 487 ; & 26 R. P. C. 491.

<sup>40</sup> (1934) 36 Bom. L. R. 881.

manufacture and what constitutes an inventive step sufficient for a good Patent, the case may here be referred to as authority on both points. The case also contains lucid and useful observations in regard to a particular class of case where the inventions ought to be patented consists of a combination.

**As to inventive step and manner of new manufacture : in a combination.**

The following observations in that case were made by Beaumont, C. J. :

"The first issue raised before the learned Judge (in the Court of first instance) was, whether the process described in the specification in exhibit A the plaint, is an invention, and the learned Judge answered that in the negative. Now, the salient feature of the process is that bleaching powder is used on the almonds in conjunction with sulphur dioxide, and they are treated under a pressure of five lbs. per square inch in a closed chamber. I think the criticism which may be made upon the very careful judgment of the learned Judge on this issue is, that he is rather too analytical, and he considers the various component parts of the specification without considering the combination. It seems to me on the evidence to be clear that the particular combination which gave satisfactory commercial results for the first time was only arrived at by the plaintiff after a year of experiments, and that no one else had arrived at a similar process, and further, that there was a demand in the market for whitened almonds, though why there should be such a demand I do not know. But the evidence is that there was a demand for these whitened almonds, and the merchants thought they could get a better price for almonds in that state than for almonds in their natural state and, in my opinion, on the evidence the plaintiff has proved that he showed a sufficient amount of inventive genius in arriving at this method to justify the grant of letters patent in respect thereof. I think, therefore, the first issue should be answered in the affirmative."

Rangnekar J. arrived at the same conclusion, making the following observations :—

"The first question is, Is this process, for which a patent is granted to the Plaintiff, an invention within the meaning of the Indian Patent and Designs Act, 1911 ? Section 2 (8) defines invention as meaning "any manner of new manufacture, and includes an

improvement and an alleged invention." Section 2 (10) says that "Manufacture" includes any art, process or manner of producing, preparing or making an article, and also any article prepared or produced by "manufacture." Manufacture, therefore, comprehends not only productions but also the means or method of producing them, so that a new process or an improvement on an old process will be a manufacture within the meaning of the Act. Applying these definitions it is difficult to see why the plaintiff's process cannot be called an invention. The learned judge has considered the steps of which the process consists and examined each in the light of the evidence before him separately. His conclusion is as follows :—

"When we come to apply the established principles to the plaintiff's claim to have invented a new process we are at once met by the difficulty that so few of the details appear to form an essential part of it. The preliminary sulphuric acid washing is admittedly not necessary. Moreover any acid except sulphuric acid would do to get rid of the calcium deposit on the shells. It is not suggested that the use of an acid for this purpose needed invention and the evidence of the witnesses examined by the defendant goes to show that similar products can be turned out without the use of any acid at all. Again any form of sulphur oven will suffice and apparently no vital importance is to be attached to the pressure of five lbs. per square inch or to the hot air, which the defendant by the way does not use. So that it really seems to come to this that what the plaintiff claims to be new and essential about his process is that for the first time he combined the use of bleaching powder (not previously used for this purpose) with an up to date method of bleaching in sulphur dioxide (the ordinary process). Now it is true that there seems to be nothing in the books to which reference has been made about the use of bleaching powder and sulphur dioxide combined in the treatment of dried fruits. But, bleaching powder is commonly used for so many different things that the idea of trying it to bleach dried fruits might occur to almost any body, and if the bleaching powder alone was not satisfactory almost anybody might think of trying it in combination with the ordinary bleaching medium, sulphur dioxide."

With respect to the learned Judge, in my opinion, this is not the correct method of determining whether a process or a method claimed to be an invention is an invention or not. Undoubtedly, the process was in making use of the substances more or less

previously known, but the plaintiff's ingenuity and skill was in combining these substances in a particular manner and in a particular sequence so as to prepare and produce an article which admittedly was not produced before, and in overcoming the difficulties which existed even after a crude application of some of these substances previously. Then, there are at least some new features thought of by the Plaintiff which had not occurred to the persons in the trade or interested in the experiments for the purpose of whitening the almonds. The learned Judge has found, and, I think, correctly, that bleaching powder was not previously used or tried on dried fruits. Secondly, the effect of a pressure of five lbs. per square inch by means of sulphur dioxide forced into the bleaching chamber with hot air resulted in preserving the kernel and reducing the time of treatment by some hours. Originally the plaintiff applied the process with steam, but further experiments showed that hot air was far more efficacious for that purpose. This discovery required no less than fifty-eight experiments beginning from February 9, 1929. The fiftieth experiment was made on October 5, 1930, when steam was used. Some more experiments were made thereafter, and as the result of the sixty-fourth experiment made on November 5, 1930, the efficacy of hot air was discovered. Two further experiments were made, the last one being on November 13, 1930.

The law on the subject is stated in Halsbury Vol. XXII para 292 p. 138 as follows :—

"A new combination may be the subject matter of a patent although every part of the combination per se is old, for here the new art is not the parts themselves, but the assembling and working them together, which ex hypothesi is new. If the result produced by such a combination is either a new article, or a better article, or a cheaper article than before, such combination is an invention or a manufacture within the statute and may well be the subject matter of a patent".

I may also refer to a passage which the learned Judge himself has used from Fletcher Moulton on Patents (1913 Edn) p. 46, which is in these terms :—

"In some cases, and more particularly in the case of chemical patents, a variation of old methods has been held to form subject matter because it was not possible to predicate the new result from

the results of the old method with any certainty or without experiments and research."

The above passages, in my opinion, support the view which I am now taking.

A new manufacture does not mean only a new article of manufacture, but also means a new process or method of manufacturing something new. It does not mean a new principle of manufacture—a principle cannot be an invention—but it means a new application of the principles so as to produce a new method or a new manufacture. In *Househill Coal and Iron Company v. Neilson*<sup>41</sup> Lord Justice Clark Hope, in directing the jury, observed as follows (p. 685):—

"I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect: and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of the apparatus is essential in order to obtain benefit from the principle; then you may take out your patent for the mode of carrying it into effect and are not under the necessity of describing and confining yourself to one form of apparatus...You may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will more or less produce the benefit and you are not tied down to any form."

In *British Vacuum Cleaner Company Ltd. v. Suction Cleaners Ltd.*<sup>42</sup> the invention consisted in a new principle applied to the cleaning of carpets by vacuum. The inventor discovered that it was essential to success to so drive the pump and apply the pipes that a strong vacuum might be maintained at the carpet and at the filter. Other suction apparatus had been used before the date of the patent, but no one had appreciated the importance of maintaining a high vacuum. It was argued for the defendants that this was merely a patent on a question of degree of the vacuum. It was held by Farwell J (p. 312).—

"The whole point of it is, as is stated there, that it is

<sup>41</sup> (1843) 1 Web. P. C. 6735; Terrell (7th edn) p 50; 9 Cl. & F. 788.

<sup>42</sup> (1904) 21 R. P. C. 203.

essential to practical success to drive the pump by power and to maintain a vacuum of at least 5 lbs. per square inch at the filter. That appears to me to be a perfectly good process and well and sufficiently stated..."

Perhaps the best exposition of the law is that contained in *Cannington v. Nuttall*<sup>43</sup> where Lord Hatherly L. C. observed (p. 216):—

"It is quite apparent...that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every invention—the skill and ingenuity of the inventor are shewn in the application of the well-known principles. Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of the well known principles to the achievement of a practical result not yet achieved. And I take it that the test of novelty is this: Is the product, which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?"

The point of a combination patent is that the elements of which the combination consists is to produce one result. The merit depends upon the result produced. Frost in Vol. I of his *Patent Law and Practice*, 4th Edn., observes as follows (p. 74):—

"The merit of a new combination very much depends on the result produced. When a very slight alteration turns that which was practically useless into what is useful and important, the Courts consider that, though the invention was apparently small, yet the result being the difference between failure and success, it is fit subject matter. Thus, the mere placing of two flat wicks parallel to each other in an oil lamp, two concentric round wicks having been previously combined, and flat wicks being perfectly well known, has been held sufficient to merit a patent; ....."

The authority cited is *Hinks & Son v. Safety Lighting Co.*<sup>44</sup>

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<sup>43</sup> (1871) 5 H. L. 205.

<sup>44</sup> (1876) 4 Ch. D. 607.



In that case Jessel M. R. makes the following observation (p. 615):—

“Where a slight alteration in combination turns that which was practically useless before into that which is very useful and very important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and as far as a rough test goes, I know of no better”. In patent cases the Courts attach great importance to the fact that the alleged invention was only arrived at by a series of experiments. The learned Judge at p. 64 of the paper book has referred to this principle and has cited an authority in support of it. It is beyond dispute that the plaintiff carried on numerous experiments from 1924 to 1930.

The rule as to application of old contrivances to analogous purpose does not necessarily apply to cases of chemical invention (see *Badische Anilin und Soda Fabrik v. Levinstein*).<sup>45</sup> It is in evidence that when, previously, bleaching was done with sulphur fumes, the fruit was yellow and the flavour was wanting. Even when the plaintiff tried his first process in April 1930, and succeeded in obtaining white colour, the process was found to be a failure, and the almonds sold by Harakchand Shivji & Co. were returned by merchants to them after some months. That the attention of the dealers was directed to an improved method is undoubted. It was for that purpose that Jarivalla Shah and Co opened a laboratory and engaged Dr. Patel to experiment on it, and Girdharlal asked him to find out a process, among other things, relating to almonds of which there was a great demand. It is equally clear on the evidence that there was a demand for this kind of fruit at least since 1928, and as soon as whitened almonds appeared in the market they fetched a higher price and people began to deal in them. Then, although Dr. Patel decries plaintiff's invention, he had to admit that his experiments, which were no less than about twentysix, even on paper, did not produce satisfactory results, and his process was a failure. He had further to admit though at first he asserted that this particular method was in trade books, that as far as books went there was nothing in them about the combination of bleaching powder and SO<sub>2</sub> in the case of dried fruits. He

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<sup>45</sup> (1887) 12 A. C. 710 at p. 723.

admitted that the idea of using pressure had not occurred to him or to anybody else, nor did the application of sulphur dioxide. With these facts therefore before me I have no difficulty in holding that the two features which are necessary for the validity for the patent namely, novelty and utility, are there in the plaintiff's process and that it was a new invention unless the defects specified in s. 38 of the Indian Patents & Designs Act are present. I shall consider that question presently....."

**As to illegality :—**

See *Pessers and Moody vs. Haydon & Co.*<sup>46</sup> That case is clear and sufficient authority, if any authority were necessary, that a Patent will be held invalid if it is established that it is for an illegal purpose. But it is not enough to establish that the Patented invention *may* be used for an illegal purpose. The observations of Eve J. in that case of which the following is an extract are directly in point :—"This particular instrument could be made the means of gaming and possibly of unlawful gaming, having regard to the places where the gaming is carried on. But, human nature being such as it is, I think it would pass the wit of man to invent any game, either of skill or chance or a combination of skill and chance, which might not be made the means and method of illegal gaming. It does not follow from that, of course, that the game or the instrument is in its nature so illegal as to disentitle it to the protection to which the grant of the Patent would otherwise entitle it. In considering this case, I am bound to make this comment upon it : that the Defendants, as I understand, are now disposing of and selling these instruments in London and in England, and if it be, as Mr. Lunge has suggested, the duty of the Court to stop, at as early a stage as possible, the corruption of the youth of this country by letting them gamble in these instruments for pennies or sweets or bad cigars, it seems to me that that is an argument in favour of my granting the injunction rather than my allowing two sets of corruptors of youth to be placing upon the market these injurious instruments. But that is only an observation ; it does not really strengthen the Plaintiff's case. What I have to consider is, whether this game is so illegal in its nature as to constitute improper subject matter for a Patent. I can conceive persons, in fact I think I know

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<sup>46</sup> (1909) 26. R. P. C. 58.

persons, of that intellectual capacity who would thoroughly enjoy playing that game without any pennies or cigars or any other prizes being involved in it; they would appreciate the increased skill which they were obtaining as they practised it shot after shot, and I can quite see the time coming when this will be taken up with all the craze which the game called Ping-Pong was at one time taken up, and, indeed, by persons who certainly would not come under the category of small boys who frequent icecream shops. Under those circumstances I do not feel myself at liberty to say off-hand that this (is) an illegal subject-matter for a Patent”.

**As to immorality :—**

See *A and H's Application*.<sup>47</sup> The application which related to “an improved contraceptive device” had been refused acceptance by the Assistant-Comptroller, it seems on the grounds that the invention was “one of a class for which patents have not hitherto been granted in this country” (i.e. the United Kingdom) and on the ground that he refused it also under Sec. 75 of the Act (that is to say on the ground of immorality). The Applicants appealed. The Solicitor-General (Sir Thomas Inskip) upheld the decision of the Comptroller and dismissed the appeal. It will be observed that he did not come to a finding that the alleged invention was for an immoral purpose and did not dismiss the appeal on that ground. That portion of his judgment dealing with the second ground, the ground of immorality, was as follows :—“I express no opinion as to whether the use of these articles is consistent with morality, because I am not aware that the law has laid down what the exact standards of morality are. I am a Court of Law, and not a Court of Morality”.

**General discretionary ground for refusal to accept application or for refusal to grant patent : based on the nature of the prerogative of the Crown.**

As to the first ground given by the Assistant Comptroller in the case last mentioned for refusing to accept the application it is to be noticed that this was also dealt with in the judgment of the Solicitor-General. “The question arises—whether, quite apart from Sec. 75, the Crown in the exercise of its prerogative could possibly

<sup>47</sup> (1927). 44 R. P. C. 298.

be expected to exercise its discretion to grant a patent for an article designed as an apparatus for the prevention of conception...I decline to be any party to the grant of a patent for this class of article...Even if, as to which I express no opinion, its use as a contraceptive is consistent with morality, I am not prepared to exercise on behalf of the Crown the Crown's discretion in favour of the grant of a patent in respect of it. ...All I say is, I think these are not articles for which, whether the specification be amended or not, the Crown can be expected to exercise its discretion by way of granting a patent. I therefore dismiss the Appeal".

In argument, Sec. 97 of the English Act had been expressly relied on. And it had been contended that the Law Officer who represents the Crown and is charged with the exercise of the prerogative reserved by Sec. 97 had ample power to refuse the grant for articles which it would not be fitting to sell as being protected by Royal Letters Patent. And it was stated that for the last 44 years Patents for such articles had invariably been refused.

The decision may therefore, it is submitted, be treated as authority for the principle that the prerogative reserved by Sec. 79 of the Indian Act of 1911 (corresponding to Sec. 97 of the English Act) may in certain cases be relied on as an independent ground for the refusal by the Controller to accept an application or to grant a patent for the reason that a particular alleged invention is for a class of article unfit on general grounds to be the subject of the exercise of the Crown's prerogative.

**Each case must be considered upon its own merits<sup>44</sup> :—**

As was said in one case<sup>45</sup> it is easier to say what is insufficient to obtain a patent than to define what is sufficient.<sup>46</sup>

**At what stages objections for want of subject matter may be raised in British India : and in what form.**

The proceedings in which objections may be raised against the validity of a patent are discussed in later chapters. It may be

<sup>44</sup> See *In the Matter of an Application for a Patent by C.* (1920) 37 R. P. C. 247.

<sup>45</sup> *In the Matter of an Application for a Patent by D, A, and K.* (1926) 43 R. P. C. 154 at 158.

<sup>46</sup> Other references as to subject matter : see also 42 R. P. C. 320 : 39 R. P. C. 355 : 38 R. P. C. 397 : 27 R. P. C. 247, 112, 109 : 35 R. P. C. 90 : 32 R. P. C. 348, 345.

convenient however here to note briefly at what stages the various objections which have been discussed in this chapter under the head of "subject matter" may be respectively taken in the various proceedings available to a person attacking the patent.

(a) As to the objection that the alleged invention is not a manner of new manufacture :—

(i) Before acceptance of application :—

This objection may be raised by the Patent Office before acceptance of the application : by virtue of Section 5. The wording of the statutory ground under Section 5 (1)(e) is :—

"The invention as described and claimed is *prima facie* not a new manufacture or improvement".

(ii) In opposition proceedings before the Controller :—

The objection is not expressly mentioned among the grounds given in Section 9. Moreover by the words there used—"but on no other grounds"—the section expressly excludes objections on any other grounds being taken by the opponent. Nevertheless it has been held in England that the objection may be taken either by the opponent or by the Comptroller of his own initiative. It is submitted that the position is the same in India.

(iii) On a petition to Court for revocation :—

This objection may be raised by the petitioner on a petition for revocation, it is submitted, by virtue of Section 26(1)(b) read with Section 2(8). The wording there used is :—

"That any invention included in the Statement of Claim was not at the date of the application for a patent, a new invention within the meaning of this Act." And an invention is defined as follows :—

"Invention" means "any manner of new manufacture and includes an improvement and an alleged invention".

(iv) In an infringement suit as a defence :—

The objection may be raised : by virtue of Section 29(2).

(b) As to the objection that there was in the alleged invention no inventive step sufficient to support a patent :—

(i) Before acceptance of the application :—

It is submitted that this objection may be raised by the Controller at this stage : provided that a very strong *prima facie* case appears on the face of the Specification for the sustaining of the objection.

(ii) In opposition proceedings :—

It is submitted that this objection is open to an opponent in opposition proceedings, and that it is open also to the Controller to take it in opposition proceedings. It is submitted that the legal position is the same as in respect of the previous objection already discussed.

(iii) In a petition to Court for revocation :—

This objection is not expressly mentioned as a separate ground among the grounds stated in Section 26 of the Indian Act. It is however submitted that it may be read into that section as being implied or covered by Section 26(1)(b) or even possibly by Section 26(1)(d).

(iv) In an infringement suit as a defence :—

The position is the same as for a Petition for revocation : by virtue of Section 29(2).

(c) As to the objection that the use of the invention will be contrary to law :—

(i) Before acceptance of application :—

This objection is open to the Controller by virtue of Section 69. It must be assumed that as the section gives the Controller power to refuse the grant, he has also power in a proper case to refuse to accept an application. The wording of the section is :—

“The Controller may refuse to grant a patent for an invention.....of which the use would, in his opinion, be contrary to law or morality”.

(ii) In opposition proceedings :—

No mention of this objection occurs among the grounds open to an opponent under Section 9. In view of the words used in the section—“and on no other ground”—it is submitted that this objection is not open to be taken in opposition proceedings by an opponent. It is submitted that it is however open for the Controller to take it in opposition proceedings.

## (iii) On a petition to Court for revocation :—

This objection is not mentioned among the grounds stated in Section 26. It seems therefore that it is not open in revocation proceedings.

## (iv) In an infringement suit as a defence :—

The position is the same as above stated in regard to revocation proceedings : by virtue of Section 29(2).

(d) As to the objection that the use of the invention will be contrary to morality :—

## (i) Before acceptance of application :—

## (ii) In opposition proceedings :—

## (iii) On a petition to Court for revocation :—

## (iv) In an infringement suit as a defence :—

The position at each stage is similar to that regarding the objection for illegality. The objection is however one which will seldom be held to prevail.

(e) As to an objection that the alleged invention is unfit to be the subject of the exercise of the Crown's prerogative :—

## (i) Before acceptance.

There is clear authority in England for the view that it is open to the Controller to refuse to accept an application on this ground alone under the implied powers which he has by virtue of Section 97 of the English Act 1907-1932.

Since Section 79 of the Indian Act of 1911 is in precisely the same words, it is submitted that the Controller in India also must be taken to have the same right.

## (ii) In opposition proceedings :—

This objection is open to the Controller for the same reasons as previously stated.

The objection is not mentioned among the grounds available to an opponent under Section 9. It is submitted therefore that it is not open to an opponent in opposition proceedings.

## (iii) On a petition to Court for revocation :—

This objection is not available, it is submitted, as a ground for revocation. It is not expressly mentioned as a ground under Section 26. And it is submitted that it cannot be read into the

section as being implied or covered by any of the grounds there stated.

(iv) In an infringement suit as a defence :—

This objection is not available, it is submitted, to the Defendant in an infringement suit: since the grounds open to him in such suit are only those open to a Petitioner in revocation proceedings.

**How far the question of subject matter is one of law or one of fact.**

The question whether or not the thing is a manner of manufacture appears to be considered to be a question of law.<sup>51</sup>

The question whether the inventive faculty has in any given case in fact been called for may be in a sense a question of fact. Yet the real question whether there is subject matter to support a patent is formally a question of law.

**The connection between subject matter and novelty.**

From what has already been said it is seen that there is a very close connection between the requisites of an invention which in Patent Law are ordinarily referred to as "subject matter" and the requisites ordinarily referred to under the head of "novelty". And in practice any set of facts which raises questions regarding the one will ordinarily be found to raise questions regarding the other also. The connection between the two topics has been ably stated in *Fletcher Moulton* at p. 21 in the following passage :—

"Although it seems that the question of novelty and the question of invention are separate, they are usually very closely connected in every patent case, and, in fact, it will not be found that any consistent distinction in terminology has been observed by the Courts between novelty and subject matter in its restricted sense. It will readily be seen that the distinction is often one without any real difference. In nearly every case the exact thing patented has never been proposed before, and the dispute is usually as to the extent of the advance made on previous knowledge. In such case the question, is the alleged invention new, might be said

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<sup>51</sup> See *Fletcher Moulton* p. 15 citing *Walton v. Potter* (1841) W. O. P. 597; and *Cornish v. Keen* (1836) W. P. C. 501.) See also *Bonnard v. London General Omnibus Coy Ltd.* (1921) 38 R. P. C. 1 at p. 12.



to be solved by the Court determining what advance on previous knowledge would be necessary in that case to constitute an invention and then deciding if such advance had in fact been made, while the question of subject-matter would be decided by first determining what advance had been made and then considering whether such advance, were sufficient to constitute invention, and it is usually very doubtful which process has been adopted by the Court. Consequently in dealing with subject-matter many decisions which are in form decisions as to novelty will have to be considered".

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## PART III. NOVELTY : AND FREEDOM FROM ANY PRIOR GRANT.

### A. NOVELTY.

#### **Novelty Demanded by the Statute of Monopolies.**

It is clear from the passage already quoted from the Statute of Monopolies<sup>1</sup> that novelty is expressly made a *sine qua non* of a good invention if it is to form the material of a good patent.

#### **Demanded at Common Law.**

Even before the Statute of Monopolies it was decided in the Courts in several reported decisions that the grant of a privilege in a known art or trade was illegal.<sup>2</sup>

#### **Want of novelty considered as want of consideration for the grant in the bargain between the patentee and the public.**

Apart from other reasons Hindmarch put the necessity for novelty on this ground : he maintained that as the grant of a patent was in the nature of a bargain between the patentee and the public, and as the only consideration moving from the patentee was the fresh knowledge of his new invention which he gave to the public, then, if the alleged invention was not new, there was an entire absence of any consideration moving from the patentee ; and on that ground alone no patent could validly be granted or if granted it would be void. It may be of interest to quote the passage in his own words :

"The only thing which a patentee gives to to the public is a knowledge of his invention, and a patent is in effect a bargain between the patentee and the public, in which the public, in consideration of an inventor communicating to them a knowledge of his invention, so that they may afterwards be enabled to practise it,

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<sup>1</sup> See page 14.

<sup>2</sup> See Hasting's patent (1561) 1 Web. P. C. 6 ; Matthey's Patent Web P. C. 6 : Humphrey's Patent 1 Web P. C. 7 : Darcy v Allein (1602) 1 Web P. C. 6 : Clothworkers of Ipswich (1615) 1 Rol R 4 : and see Edmunds at p. 33. And see Terrell (8th edn) p. 83 : And see the account of the case of Monopolies in Monopolies by Patent by Gordon which is referred to in Terrell (ibid) p. 84.

grant to him the sole use of his invention for a limited time. But, if an invention is not new, the patentee does not communicate anything to the public which they did not know before, and therefore the patentee gives them nothing which can be considered as a consideration for the grant, and therefore the patent is wholly void.”<sup>3</sup>

There is another interesting passage to the same effect, which was subsequently approved by Lord Blackburn in *Patterson v Directors of the Gas Light & Coke Co*<sup>4</sup> as follows :—

“If the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted either to the true and first inventor himself or any other person. for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give.”<sup>5</sup>

It may be observed that the words “by any means whatever” which occur in the last quoted passage are not today accurate. Modern legislation has effected in favour of the inventor an immunity from the ordinary loss of rights which would occur from publication when such publication is at certain Exhibitions. Also by certain international conventions and reciprocal arrangements between different countries it is possible for an inventor to take out a patent in one country, and, even though that patent may be published in another country, still to be free to take out a second patent in that other country provided he does so within one year. But for all that, for general purposes the passage is as good law today as when it was written.

**Want of novelty in a material part of the invention may avoid the whole patent.**

It has long been held to be the law that any such want of novelty in a material part of the invention on a proper construction of the specification will have the effect of making the whole Patent void : even though the specification may relate to other parts of the invention which are new. The reason for this has been put on two

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<sup>3</sup> See Hindmarch (1846) p. 103 & 104.

<sup>4</sup> (1875) 3 A. C. 239 (H. L.) at 244).

<sup>5</sup> See Hindmarch (1846) p. 33.

different grounds. The one, on the line of reasoning already indicated, that as the consideration for a patent is entire, want of novelty in a material part of the invention constitutes a want of consideration moving from the patentee. The other, that such a want of novelty in a material part of the invention constitutes a false suggestion or misrepresentation having been made by the patentee and appearing on the face of the patent.<sup>6</sup>

This aspect of the matter is further considered below in the chapter on Amendment; since amendment may become of vital importance in order to save a Patent which may be found to be wanting in novelty only in part.

For present purposes there is now no need to consider further the juristic reasons on which came to be based the proposition of law that a valid Patent was required to be for an invention that was novel. Novelty is now, as of old, in law of the essence of a good Patent. About the general principle there can be no doubt: the difficulty arises in coming to a decision on a particular case. The question of novelty is thus in practice the most important and also the most disputed point when the validity of any patent is in question. Though tests of novelty are difficult to lay down, certain classified principles may be said to have been evolved by the Courts in their decisions of the reported cases. Even though the question of novelty is in the main one of fact, it may yet be of some use to examine the reported cases. Novelty may be found to be excluded in a variety of circumstances and in a variety of ways and on a variety grounds which can with advantage be analysed and classified in a manner which is of some assistance. It is only in this way that some degree of uniformity in the decisions can, as it has been, be achieved: or that inventors and patentees can be assured of any degree of security. The various grounds on which want of novelty may be found to arise have now also been expressly formulated in considerable detail in modern legislation both in India (under the Act of 1911) and in England: particularly under the English Act of

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<sup>6</sup> See Hindmarch (1846) p. 115: Edmunds p. 32: and the following cases cited by him:—*Hill v Thomson*, 8, Taunt 401. *Brunton v Tawker*, 1821, 4. B. & Ald, 541; *Lewis v Morling*, 1829, 10. B & C 27; *Kay v Marshall*, 1839, 5 Bing. N. C. 501; *Gibson v Brand*, 1842, 4 M & G 179; *Muntz v Foster*, 1844, 2 Web. P. C. 112; *Templeton v Macfarlane*, 1848, 1 H L. C. 595; *McCormick v Gray*, 1861, 7 H & N 25.

1932. Further consideration in some detail of the grounds on which such want of novelty may arise is to be found in later chapters concerned with the actual contesting of opposition proceedings and of infringement suits. For the present it may be of interest to make here certain observations in regard to want of novelty in a general aspect.

### **Various methods of anticipation which result in want of novelty.**

Want of novelty entails anticipation. For an invention to be other than a new invention in the accepted sense knowledge of it must have been made public previously. The necessary anticipation may be established by showing a state of prior public knowledge in one of two forms : by showing either prior common general knowledge or prior public knowledge simply ; which latter may be due to publication of the invention orally or in some prior document or by prior user.

### **Anticipation in British India.**

The expression "new invention" has always been taken to mean an invention new within the realm. When the novelty of an invention is under consideration therefore, the whole question is : is it new to British India ? For this reason any anticipation outside British India is totally immaterial.<sup>7</sup>

### **Anticipation by prior common knowledge.**

Want of novelty will be shown in the highest degree in the class of cases where anticipation is established by showing that the alleged invention formed a part of prior common knowledge in British India. The thing is obviously not new if the mass of those persons concerned in the art had knowledge of the thing before it is alleged to have been invented : for common general knowledge entails a wide degree of public knowledge.

### **Degree of publicity necessary to constitute common knowledge.**

To establish common knowledge it is necessary to show that the alleged invention formed a part of the state of general knowledge at the time in question. This may be done by proof of passages from standard authorities or reputable text books of the time. Or

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<sup>7</sup> Compare Haddan p. 96 ; citing *Edgeberry v Stevens* (1691) 1 Web. P. C. 35 ; also *Rolls v Isaacs* (1881) 19. Ch. D. 268.)

it may be done by the oral evidence of witnesses who are in a position to speak to what was the state of knowledge at the time. Or it may be done by proof of sufficiently widespread prior user.

Previous specifications may, it seems, also be relied on in some instances as some evidence of prior common knowledge; though how far such specifications should be held to be proper evidence of prior common knowledge is a matter of some doubt which has been commented upon in several cases.

It is not necessary to show that every unskilled workman concerned with the art had the knowledge, but it is sufficient to show that a fair number of ordinarily skilled persons, who would, having regard to the nature of their work, be interested, had the knowledge.

#### **Difference between common knowledge and public knowledge.**

If a thing is a part of common knowledge it must of necessity also be public knowledge. But a thing may have been published sufficiently to be considered public knowledge without being generally or commonly known, and without, therefore, forming any part of that stock of common public knowledge which is common knowledge.

In regard to common knowledge it is ordinarily impossible and unimportant to show by what means of publication of particular information the state of common general knowledge was achieved. All that can be done for practical purposes, is to establish proof of the existence of the state of common knowledge which may have resulted from any and various processes of publication. In regard to public knowledge on the other hand it will more often be possible to show the means of publication of particular information; and indeed it will commonly be only by showing the means of publication, that it will be at all possible to prove the existence of the public knowledge which results from the particular publication.

#### **Anticipation by prior public knowledge.**

Want of novelty will equally be shown where anticipation is established by showing that the alleged invention formed a part of prior public knowledge in British India.

**Various means of publication which may result in public knowledge.**

Just as the means of publication may have been any and various and yet, if the degree of publicity has been wide enough, there may be common general knowledge, so also the means of publication may be any and various which may result in public knowledge. And it is immaterial whether the means of publication be oral or in writing or by user and ocular demonstration ; whether in a book or in a pamphlet or in a newspaper or periodical or in other Patent Specifications, or in an official government report or in mere drawings ; or whether in English or a foreign language ; or in whatever other form ; provided of course there is sufficient publication.

**Degree of publicity necessary to constitute public knowledge.**

The broad test will be the same, it is submitted, whether the prior publication alleged is by prior user, or by prior documentary publication or by prior oral publication ; and the question will be whether there was or was not a sufficient publication to disclose the invention publicly so that others could reproduce it.

**Publication by user : prior user as negating novelty.**

There may be the most complete form of anticipation of an alleged invention by prior public user. If an alleged invention is actually used in public, no question of any other publication of mere knowledge of the invention short of the publication by user need arise. If the invention is in fact being publicly used this alone is a sufficient prior anticipation of it and publication of it, quite apart from any other means of publication of it ; and it follows there will be want of novelty.

Proof of prior public user will be therefore evidence of or one means of establishing want of novelty.

**Prior user : degree of publicity necessary : whether prior user is to be considered apart from negating novelty.**

A question may arise whether prior user, if it does not amount to want of novelty or independently of want of novelty, will be a bar to the grant of a patent or will invalidate a patent that has been granted.

Conflicting views appear to have been held on this point ; or

at least decisions have been arrived at which when examined appear to show that they have been founded on a holding of conflicting views on this point.

Edmunds after citing a passage from Hindmarch, simply says :—"The novelty of an invention is destroyed by prior public user of the same or a similar invention." He does not treat of prior user as deserving attention from any other aspect.<sup>8</sup>

The passage in question cited by Hindmarch is ;—"A public use of an invention is sufficient to avoid a subsequent patent for it for three reasons : firstly, because the public use of an invention is evidence of a public knowledge of it ; secondly, because the Statute Monopolies expressly requires that an invention granted by patent shall be such as others (than the inventor), at the time of making the patent or grant, do not use ; and thirdly, because every patent expressly requires that the invention comprised in it shall be new as to the public use of it."<sup>9</sup>

Edmunds goes on to say :—"Again the invention must have been used in public."<sup>10</sup> Beyond citing with approval the passage of Hindmarch above quoted, he does not make any suggestion that prior user which is not in public so as to amount to a publication negating novelty, will be any bar.

In Terrell on Patents also there does not appear to be any definite suggestion that prior user should be considered as a bar apart from its being a form of want of novelty : and the topic of prior user is treated merely as incidental to the larger topic of want of novelty.<sup>11</sup>

There is authority in numerous cases for the view taken in Edmunds and in Terrell.

The opposite view, which is possibly hinted at though not

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<sup>8</sup> Edmunds (1890) p. 39.

<sup>9</sup> *i.e.*, Hindmarch p. 108.

<sup>10</sup> Edmunds p. 40.

<sup>11</sup> See Terrell (8th edn.) p. 85 *et. seq.* The point would have arisen in regard to secret user : but this is now regulated in the United Kingdom by Sec. 25 (2) (0) and by Sec. 93 under the amendments effected by the 1932 English Act. As to the position in the U. K. prior to 1932 see Terrell 7th edn. p. 83-85 : also Mr. R. J. Tugwood's Paper printed in Vol. 42 of the Transactions of the Chartered Institute of Patent Agents at p. 172.



amplified in the passage on Hindmarch above quoted, was most positively stated, it seems for the first time in a judgment of Parker J. in *Robertson v Purdey*<sup>12</sup>: the reasoning being based on the wording of the Statute of Monopolies itself. An extract from the judgement in that case sufficient to show both the cogent reasoning on which the view was arrived at by Parker J. and at the same time the extent to which anyone holding this view is committed to go, is cited below. As Parker J. pointed out the strict wording of the Statute of Monopolies is as follows ;—

“Which others at the time of making such Letters Patent shall not use.”

He pointed out that the words if taken in their strict sense grammatically could only mean that a patent is only to be validly granted to an applicant if other persons at the time of the grant to be made to him are not in fact using his invention. That there is no qualification there about using the invention publicly or anything of that sort. Parker J. therefore in that case made certain express observations to the effect that he did not consider that a patent could be validly granted in any case when there was a prior user of the invention in question: even though such prior user were shown to be merely in private or in secret.

The material observations of Parker J. in that case are these<sup>13</sup>:—

“.....It is not suggested in this case that Nobbs' invention was, prior to the 26th November 1894, published otherwise than by user, and I do not think it was seriously suggested that it was used in such a way as to amount to publication. At any rate I hold on the evidence that there was no publication by user. It was, however, argued that, on the words of the 6th Section of the Statute of Monopolies, “which others at the time of making such Letters Patent shall not use”, there may be contemporaneous user not amounting to publication which will avoid Letters Patent. In my opinion this argument is well founded. Suppose A invents a process for the manufacture of dyes, keeps the process secret and continues to manufacture and publicly sells dyes, manufactured according to the process, the sale of the dyes which might be made by any process, may not amount to a publication, of the invention, but I think that

<sup>12</sup> (1907) 24 R.P.C. 273.

<sup>13</sup> i.e. (1907) 24. R.P.C. 273 at p. 290

A is using the invention in such a way as to preclude B, who subsequently makes the same invention from obtaining valid Letters Patent in respect thereof. This at any rate would appear to be the effect of the Judgements of Mr Justice Earle and Lord Justice Campbell in *Heath v. Unwin* (2 Webs, at pages 277, 278; 3 E & B at pages 272, 273); and *Tennant's case* (1 Webs. 125). The question however remains whether Nobb's invention was in fact being used within the meaning of the Statute of Monopolies when the Plaintiff filed his Provisional Specification. I cannot find that the single gun which was completed before this time was ever sold or used at all except by being tested at the Defendant's private range, it was when tested forwarded to the Patent Agents and remained with them until the 4th of October. It was then returned to the Defendant's firm, who fitted it with a new trigger plate, and after that there is no evidence what became of it. There was a second gun of the same type commenced, but not finished until after the Plaintiff's Provisional Specification was filed. The evidence of user therefore reduces itself to the work done on these two guns and possibly on the action "P. A. N. 3" prior to the 26th of November 1894, and I have come to the conclusion that this evidence is insufficient to justify me in holding the Plaintiff's Letters Patent to be invalid because of any user by Nobbs or the Defendant's firm of the invention....." (The learned Judge then proceeded to consider other objections which were raised against the validity of the patent on other grounds.)<sup>14</sup>

It is this aspect of the matter which is evidently also referred to in *Fletcher Moulton on Patents*<sup>15</sup> when he states that "prior user of the invention.....may also in certain cases defeat a patent quite apart from the question of publication". Except for a note in which reference is made to certain cases he does not however explain the matter further. Indeed the part of the work dealing with prior user forms a part of the chapter headed "Public Knowledge"; and in the main the question of prior user is treated merely as a matter relating to a medium of publication.

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<sup>14</sup> See also *Four Oxidising Co. v. Carr* (1903) 25. R. P. C. 428 at p. 457 (there public user was referred to); *Wright & Eagle Engine Ltd. v. General Gas Appliances Ltd.* (1908) 46 R. P. C. 169 C. A.

<sup>15</sup> 1913 edn. p. 67.

It is this aspect of the matter which must be intended to be referred to also in Hadden<sup>16</sup> when after treating of prior user considered as a publication, he goes on to say "prior user may also be considered from another point of view, as we shall refer to later". After proceeding to a consideration<sup>17</sup> of secret user, he then comes to a conclusion, after considerable doubt but relying in the main on *Robertson v. Purdey* (*supra*), that "on the whole it appears (from the cases considered) that where a definite prior use by others is provable it will invalidate the patent even though the use was secret".

Now it is well settled, it is submitted, as to novelty that in a case where A applies for a patent and it is shown that B had knowledge of that patent in secret and even went so far as to manufacture it in secret, these facts do not amount to a want of novelty in the meaning of Patent Law such as to create a bar to the grant of a Patent to A. Accordingly it follows that if a manufacture by B in secret (as suggested in the passages in the judgment of Parker J. and in Haddan abovementioned) is to be held to be a bar to the grant of the patent to A, then this bar must arise for some reason independent of any reason based on want of novelty. On such a view therefore the bar of prior user would require to be considered entirely independently from the bar which arises from want of novelty.

In the course of arriving at the conclusion mentioned Mr. Haddan observes "It may be considered questionable whether a secret use of an invention by others is sufficient to prevent a patent being afterwards legally held by a *bonafide* inventor. On the one side there is the Statute of Monopolies, which distinctly states that only such new inventions shall be patentable "which others at the time of making such Letters Patent shall not use." On the other side there is the fact that the inventor introduces to the general public what, to them at least, is new and otherwise undiscoverable without invention; so no failure of consideration can be urged against the grant."

It is thus seen that the whole foundation for this view is the wording of the Statute of Monopolies in the passage noted: viz:

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<sup>16</sup> Haddan p. 101.

<sup>17</sup> See Haddan p. 104 & 105.

"Provided also.....that any declaration before mentioned (that is the declaration that monopolies are illegal) shall not extend to any letters patent .....hereafter to be made, of the sole working or making of any manner of new manufacture within this realm ... ..which others at the time of making such grants shall not use.....".

Now just as the words in that section comprise the sole provision in the statute which can be said to make any reference to prior user as a bar to the grant of a patent, so also the words in that section are the only ones which refer to want of novelty as a bar. The truth is, it is submitted, that the legal principles now in force regarding novelty in general and prior user in particular have originated out of the Common Law equally as from this section : or at least have originated from the established interpretation which by the decision of decided cases has come to be put on the section.

There are various stages by which an invention can pass from being completely new to being widely known and widely practised. In the first place a man has an idea : the idea having got no further than a thought within his mind. He may even give his idea actual expression either on paper by describing it in words, concretely by manufacturing an article which embodies and demonstrates the idea. But if he does not show the expressed description or form to anyone, the idea is still as much private to him as when it was merely in his mind. Then he may desire to communicate his idea to someone else. To do this he must either describe his idea by words, which he may communicate to the other person either by sound in the air or on paper by writing, or he must embody his idea in a concrete form in a thing of three dimensions which he must show to the other person. Before the idea can become widely known either the oral or written expression of it must be widely circulated or the thing in three dimensions must be made in great quantities and must be shown and seen and used by many persons.

One prevailing principle underlying the Common Law and the Statute of Monopolies has always been that a monopoly will not be granted to a man except in return for his communicating to the state an idea which was not known but for his so communicating it.

Another prevailing principle underlying the Common Law and the Statute of Monopolies has always been that there cannot be a good monopoly preventing other people from manufacturing what they have been manufacturing hitherto.

The idea underlying the one principle seems to be that the man asking for a monopoly must earn it, and must give some consideration for the grant. This directly concerns the grantee.

The idea underlying the other principle seems to be that the rights of other persons apart from the man asking for the monopoly must not be injured ; and that even the Crown has no right to prevent its subjects from continuing to do that which they have hitherto been lawfully doing. This directly concerns persons other than the grantee.

Both principles may be expressed in terms of "novelty" and "prior" user by stating that the invention must be novel and that there must not have been any prior user of the invention.

(It would seem that the underlying notion of both principles is the same. For even where there has been no actual user if the public has the mere knowledge of an invention they must it is submitted have the right to put their knowledge into use. It might be that in a case where several persons had already by actual user of an invention engaged in a particular line of manufacture, their grievance would be the more emphasised if a monopoly were to be sought by someone which would stop them from manufacturing, than in a case where they had the knowledge of the invention but had not yet started upon using it or upon manufacture. But the difference it is submitted is one merely of degree and of emphasis only. Thus the real and only single principle underlying both the Statute of Monopolies and the Common Law in this respect is that a monopoly will not be legally granted for an invention which is not substantially new. And a case of prior user is merely a specific instance of a want of novelty.)

In regard to both matters a question arises as to what degree of publicity if any in either case is postulated : in the one instance for an invention to be held not novel and in the other instance for there to be held to have been prior user of the invention.

In the one respect if the degree of novelty demanded were

required to be a 100% novel, then in a case where A was the applicant for a patent for an alleged invention and B (one man only) had in fact had previous knowledge of the invention even if this knowledge had been confined to the inside of B's mind, yet strictly speaking the invention should not properly be held novel. The result would be the same whether in fact A had communicated the invention to B or whether B had arrived at the knowledge of the invention independently. There would be no 100% novelty even if B had not expressed or communicated his idea to any single other person.

In the other respect if the degree of absence of prior user demanded were required to be a complete and total absence of prior user, then if B (one man only) had embodied the knowledge of the invention into anything of three dimensions, and had thus "used" it, then strictly speaking there should properly be held to be prior user. There would be no 100% absence of prior user even if B had not shown the thing he had made to any other person.

It is submitted that neither "novelty" nor "prior user" in the meaning of Patent Law connote any such meanings.

It is to be observed that the word used in the Statute of Monopoly is not "another" but "others": denoting even grammatically at least more than one.

In any event it is submitted that for there to be a want of novelty, it is meant that the invention will have been at least widely enough known to be said to have been public knowledge. Also that for there to be a prior user, it is meant that the invention will have been at least widely enough used for it to be said that there has been public user. At the same time this does not of course mean knowledge or user by the whole public.

It will be seen, it is submitted, that there is ample authority in the decided cases for this view: both from the earliest times and in most recent cases. In fact this somewhat lengthy dissertation on this point at this stage might not have been called for at all had it not been for the very definite contrary view expressed by Parker J. in the case of *Robertson v. Purdey*<sup>18</sup> and for the tentative expression of a similar view by Mr. Haddan and the fact that the

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<sup>18</sup> (1907) 24 R.P.C. 273.

point is evidently one which requires elucidation and calls for an authoritative ruling one way or the other.

It is submitted then that the view which appears stated in the observations in the Case of *Robertson v. Purdey*<sup>19</sup> to the effect that a prior user even by one other person even in secret is a bar to the grant of a Patent is unsound. Though it does not appear that this ruling in *Robertson v. Purdey* has ever been expressly criticised or overruled, yet it is submitted that it could not be supported or followed logically without going against the decisions of innumerable cases in which it has been held in effect that want of novelty signifies knowledge to a wide extent by some portion of the public; and that prior user signifies user to a wide extent, also, in public.

The observations previously cited of Parker J moreover appear now to have become inapplicable even in the United Kingdom since the subsequent amendment of Section 25(2) of the English Act.

Furthermore in British India all doubt on the point would appear to be eliminated by the terms of Section 38(1) by which it is provided that :—

“An invention shall be deemed a new invention within the meaning of this Act.

- (a) if it has not, before the date of the application for a patent thereon, been publicly used in any part of British India, or been made publicly known in any part of British India,
- (b) if the inventor has not by secret or experimental user made direct or indirect profits from his invention in excess of such an amount as the Court of the Governor-General in Council, as the case may be, may, in consideration of all the circumstances of the case, deem reasonable.”

From the wording of that section it seems clearly to follow that in British India (with the sole exception of secret or experimental user with unreasonable profits by the inventor himself) the only

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<sup>19</sup> See above at p. 176

Cf. Terrell (8th Edn.) p. 90 & 91 : contrast Terrell (7th Edn.) p. 64.

user which will invalidate a Patent is "public user". This public user it is submitted, can only mean such user as is accompanied by such publicity as will have created public knowledge.

If this correct, then, whatever the origin of the principle by which prior user came to be a bar to the grant of a patent—even if this was for reasons connected with the protection of the rights of the public which differed in origin from reasons connected with the nature of the consideration moving from the grantee—it now becomes unnecessary in practice to treat of prior user except as an instance of want of novelty. For it will be found that a prior user, which is unaccompanied by a degree of publicity enough to establish want of novelty, will have no effect as a bar to the grant of a patent.

The matter is not one of merely academic interest relating to the merits in logic of two alternative methods of arrangement of this book. The matter goes deeper than that. For if the view is taken that prior user is a matter independent of novelty, then one degree of publicity may be demanded to create want of novelty which will be a bar to the grant of a patent, while a lesser degree of publicity, or no publicity at all, may be demanded to create a user which will also be a bar to the grant of a patent. On the other hand if prior user is only a form of want of novelty, the degree of publicity having been once established which is requisite for want of novelty in order to amount to a bar to a grant, the same degree of publicity will be requisite for prior user in order that that shall amount to a bar to a grant.

In these circumstances the topic of prior user in the present work is treated only (save for the possible exception only of user in private with unreasonable profit by the inventor himself) as a matter subsidiary to the topic of want of novelty.

### User in Public.

Prior user means then it is submitted, that there must have been a prior public user : accompanied, it is submitted with enough publicity to amount to publication of the invention. But it will be sufficient if the user is in public even though it be not by the public. The proposition was long ago established by the following passage in the judgment of Lord Abinger C.B. in *Carpenter v. Smith*



in these words<sup>20</sup> :—The “public use and exercise” of an invention means a use and exercise in public, not by the public”. The observations of Baron Alderson, were to the same effect :—“Public means a use in public, so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chambers.” As authority for the same proposition the case known as Dollond’s case is also commonly referred to. This was a case in which Dollond was the Plaintiff and patentee in a suit for the infringement of a Patent for a new method of making the glasses of refracting telescopes. At the hearing it was proved that one Dr. Hall (not connected with the Plaintiff) had made such glasses in 1720, but had not disclosed the secret and the public were not acquainted with it. The Patent was supported.<sup>21</sup>

The language of Baron Pollock in *Croysdale v. Fisher*.<sup>22</sup> as reported in Edmunds on Patents may with advantage also be cited here, the original report being not easily accessible. The material passage is as follows :—

“It is obvious that in almost all cases of user, it does not profess that there is a publication to the world, as there is in the case of a specification, or in the case of a book that is largely disseminated; because the more, perhaps, as different modes of refinement, variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is going on or what is being done by another portion. Certainly still more does the public not know with very great nicety, unless concerned either as manufactures or traders, what is going on in the different laboratories or manufactories attached to any particular trade. When it is said that a process has been disclosed, or an invention has been disclosed by means of user, it is necessary that such user should be a user by the public proper, provided only there is a user in public, that is to say, in such a way as contradistinguished from a mere experimental user with a view of patenting a thing which may or may not be existing.”

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<sup>20</sup> (1842) 9. M. & W. 300.

<sup>21</sup> See Edmunds p. 39 & 40; *Betts v. Menzies* (1857) 8 E. & B. 937. See also *Betts v. Neilson* (1868) 3 Ch. 431 per Lord Chelmsford L.C.

<sup>22</sup> (1884) 1. P.O.R., at 21 as cited in Edmunds at p. 40.

**Prior public user by sale.**

The novelty of an invention will be destroyed by the prior public sale in British India of the same or a similar invention whether manufactured in British India or abroad.<sup>23</sup>

There will be no anticipation where the invention itself has not become public knowledge ; as in cases which will occur where the article may be sold which is the result of the invention yet an inspection or an examination or even a chemical analysis of such article will not disclose the invention itself.

On the other hand in cases where the Patent related to alloys and where a sale of similar alloys was relied on as a prior user invalidating the Patent and where the nature of the alloys could be ascertained by chemical analysis but not otherwise, it was held that such prior user did amount to an anticipation. Lord Hanworth in *Boyce v. Morris Motors Ltd.*<sup>24</sup> speaking of one of those cases, that of the Stahlwerk-Becker Patent, said :—

“Then there was another case to which Mr. Trevor Watson referred, that of the Stahlwerk-Becker Patent, in which some steel had been sold of a particular chemical composition, and the Lord Chancellor, Lord Finlay, said that, inasmuch as it had been sold, there was a publication. He said : “I think it would be very dangerous to introduce the doctrine which your Lordships are now invited to introduce, either that it must be actually shown that the knowledge had been acquired by some individual, or that there is a high probability that it had, in fact, been acquired. The law as to prior user seems to be this, that if the article has been manufactured and sold, that gives the means of knowledge to the purchaser, and that is enough to establish prior user.” Of course one accepts that ; and indeed I do not know how information could be better conveyed than by the actual sale of a product for such are the researches and such the possibilities of analysis, that it was comparatively easy to discover what the composition of it was.”<sup>25</sup>

This same question, how far the sale of an article embodying

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<sup>23</sup> See Edmunds p. 43 citing *Lister v. Norton* (1886) 3. P.C.R. 208-210 and *Deutsche Nahmaschinen Fabrik etc. v. Pfaff* (1390) 7 P.O.R. 16.

<sup>24</sup> (1919) 36. R.P.C. 211.

<sup>25</sup> And see *Miller's Patent* (1898) 15. R. P. C. 205 at p. 211 ; also *Hills v. London Gas. Light Co.* 5. H & N 312.

the patented invention will be a public user so as to constitute anticipation came up for consideration by the court in India in the reported case of *Lallubhai etc. v. Shamaldas etc.*<sup>26</sup> to which reference has been made ante at page 154. In that case it was held that though almonds, which had been manufactured by the patented process, had been publicly sold, there had been no anticipation because it was not possible from an inspection (or it seems even a chemical analysis) to discover the nature of the invention. A decision in an earlier Calcutta case<sup>27</sup> appears to have been to some extent dissented from by both of the learned judges of the Bombay High Court. The following observations were made by Beaumont C. J. in the Bombay case<sup>28</sup> :—

“Now in considering how far the sale of an article manufactured under a secret process amounts to a public user of the process, we have to remember the terms of s. 38 of the Indian Patents and Designs Act of 1911. The section provides that an invention shall be deemed to be a new invention where two features are absent. The first feature is the public user of the invention in British India, and the second feature is secret or experimental user in which the Court considers that excessive profits have been made. So that you have two things, public user or private user for excessive profits,<sup>29</sup> which will prevent the invention being a new one, and these two matters seem to be based on two principles underlying the law relating to patents, the first being that there must be no disclosure to the public before the letters patent are applied for, since, if the public already knows the secret there is no consideration for the patent ; and the second being that even if there is no public disclosure, still if the patent has been used and considerable profits have been made, it is not reasonable to grant a further monopoly. Now, in this case, there is no allegation in the written statement of, and no issue is directed to, secret user, and therefore, we have not to consider the question whether the plaintiff made excessive profits from any such user. The only issue is, whether there was a public user. Mr. Khan referred us to many cases including *Wood v.*

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<sup>26</sup> (1934) 36. Bom. L.R. 881.

<sup>27</sup> (1896) 23. Cal. 702.

<sup>28</sup> (1934) 36. Bom. L.R. 881 at p. 887.

<sup>29</sup> It is to be noticed that the Act refers to private user by the inventor only.

*Zimmer*<sup>30</sup>, *Heath v. Smith*<sup>31</sup>, *Carpenter v. Smith*<sup>32</sup>, and *In the Matter of the Inventions and Designs Act*<sup>33</sup>, and he contended on the strength of those cases that if articles are manufactured under a secret process and then sold openly, that amounts to public user of the process. The principle enunciated in the Calcutta case as being that established by the English cases is that where profit is openly derived from the employment of a secret process, there is a public user of such secret process. Now, it is to be noticed that none of those cases were dealing with an Act in the terms of s. 33 of the Indian Patents and Designs Act of 1911, which distinguishes clearly between public user and private user. Whether a process has been publicly used or not is, as all the cases show, a question of fact. I have no doubt that in numerous cases the sale of an article manufactured under a secret process may amount to a public user of the process, because the article may be of such a character that anybody buying it and getting it examined by experts can ascertain the secret of its manufacture, and if the article is of that character, the sale of the article in public would, in my opinion, involve a disclosure of the secret of manufacture and thus amount to public user of the process. But in this case the article manufactured is an almond treated by a particular process which makes the shell whiter and smoother than the shell in its natural state, and I do not myself see how anybody purchasing an almond treated by this process could ascertain the method of treatment, and there is nothing in the evidence on record to lead me to think that this view is wrong. It seems to me that, at any rate in a case to which the Indian Patents and Designs Act applies, if you have an article manufactured under a secret process and that article is of such a character that nobody by examining it can find out the secret of that manufacture, then the sale of that article in public cannot amount to public user of the process. That is the case here and, therefore, in my judgment, the defendant has not succeeded in showing that the process of the plaintiff had been publicly used prior to the issue of the letters patent.'

The judgment of Rangnekar J. turned primarily on considera-

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<sup>30</sup> (1815) Holt 58.

<sup>31</sup> (1854) 3 EL & BL 256.

<sup>32</sup> (1842) 9. M. & W. 300.

<sup>33</sup> (1896) 23. Cal. 702.

tions of the degree of secret user allowed under the Act, reaching a similar conclusion on the main point that there had been no anticipation by prior user. It is to be noted that the Calcutta case mentioned<sup>34</sup> was decided when the act then in force in so far as it related to secret user differed from the present act. The decision in that respect is therefore no longer of interest. As to the point now under consideration it would seem doubtful whether there was any decision in the Calcutta case on this point. But if the judgment of Sale J. were to be understood as deciding that any public user of a resultant article made by the patented process is necessarily a public user of the invention and an anticipation thereof, then it is submitted that such a view is unsound.

#### **Prior public user by steps preliminary to sale.**

It has been held that there may be prior public user of an invention where the thing constituting the invention has been merely handed about the country for the purpose of attracting customers although no actual sale has taken place.<sup>35</sup> In *Oxley v. Holden* it was suggested, obiter, by Byles J. that the offering of even a sample for sale was a user: and a decision to this effect was given in the more recent case of *Hudson Scott & Sons Ltd. v. Baninger, Wallis & Manners Ltd.*<sup>36</sup>

#### **Prior user in private by persons other than the patentee.**

Considerable doubt has arisen as to cases where there has been in fact prior user by persons other than the patentee not in public, but in secret, or at least in private. This matter and the general principles affecting the question have already been discussed at page 177 et seq.

It is submitted, for the reasons already mentioned, that the better view is that such secret user will be no bar to the grant of a patent. It is submitted there is no sufficient publicity of knowledge of the invention shown in such a case as will create any ground for objection for want of novelty; and that there is no failure in the consideration supplied by the Patentee in making

<sup>34</sup> i.e. In the matter of the Inventions and Designs Act (1896) 23 Cal. 702.

<sup>35</sup> See Edmunds p. 43 citing *Hancock v. Somerrell* (1851) 39 New Lon. Jour. 158; also *Mullins v. Hart* (1852) 3 Car. & K. 297; *Oxley v. Holden* (1860) 8. C.B. N.S. 666; 30 L. J. C.P. 68 and other cases.

<sup>36</sup> (1906) 23. R.P.C. 79 at 87.

known the invention : and that, for the reasons already stated, there is no reason, based on the Statute of Monopolies or otherwise, why such prior use should in itself (apart from the question of novelty) be held to be a bar to the grant of a Patent.

Reference may be made to the terms of Section 38 of the Indian Act of 1911. It will be seen that this section refers to (i) public user (by anyone) and (ii) secret or experimental user by the inventor by which he has made more than reasonable profits. The question therefore is whether prior user in private by persons other than the patentee is to be considered to be within the meaning of the term "public user" as used in that section. For the reasons already explained it is submitted that even if the matter were free from authority, it is not. In India there is direct authority for this view in the case of *Lallubhai etc. v. Samaldas* (already fully referred to).

#### **Experimental user by person other than the patentee.**

This matter also is covered by the remarks already made. If the observations of Parker J. were to be taken to give a correct view of the law, then even experimental user by persons other than the inventor might be said to be a bar to a grant of a Patent. If the other view more commonly held which has been submitted as the better view is taken to be the law, then experimental user by others should be treated as having no greater effect than experimental user by the patentee; and should not be held to create any want of novelty or be any bar to a grant. There have been cases decided in which the latter view has been adopted. It would appear that where the experimental user has been by persons other than the patentee more strict limits have been put to what constitutes mere experiment.<sup>37</sup>

#### **Prior user by others which has been abandoned before grant.**

The question whether a user which has been abandoned before the date of the grant, invalidates such grant is one as to which there has been no clear decision. Probably the true test is : has the manufacture been so completely abandoned that but for the patentee's discovery it would in all probability never have been heard of again ?<sup>38</sup>

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<sup>37</sup> See *Westley v. Tolley* 11. R.P.C. 602, 607.

<sup>38</sup> See *Fletcher Moulton* p. 68 and cases there cited.

It has been held that user in public or in the presence of workmen without any special or implied injunction as to secrecy and for ordinary manufacturing or trading purposes is such a prior public user as to constitute want of novelty even if such use has been abandoned.<sup>39</sup>

Possibly if the user has been so long ago as to have been forgotten, such user will not be considered to create a want of novelty.

#### **Accidental or unconscious user by others.**

It is suggested in *Terrell on Patents*<sup>40</sup> that a mere accidental user is not of itself sufficient to invalidate a subsequent Patent. A passage in *Harwood v. Great Northern Railway*<sup>41</sup> is relied on for the view suggested. Against that view however it is to be submitted that, while the knowledge of the user himself is negatived in the circumstances of his accidental user and that therefore, if there is no question of knowledge of the invention having been communicated to others by his user, his user alone will not be an anticipation, yet apart from this the intention of the user is really immaterial : and that the true test will depend on whether the use in question, in fact, whether with or without the knowledge of the user himself, communicated knowledge of the invention to others so as to make the invention public knowledge.

In practice naturally this will be less likely to happen if the user himself does not appreciate the invention.

#### **Prior private user by the inventor himself.**

Even in the older cases a principle appears to have been enforced that an applicant for patent is not entitled to a valid

<sup>39</sup> See *Fletcher Moulton* p. 68 ; citing the following cases :—

*Humperston v. Syer* (1887) 4. R.P.C. 407 (C.A.) ; *Lafeboat Co. v. Chambers* (1891) 8. R.P.C. 418 : *Wesley Richards v. Perks* (1893) 10. R.P.C. 181 : *Haggenmackers v. Watson* (1897) 14. R.P.C. 631. (C.A.) *Haggenmacker's Patent* (1898) 15. R.P.C. 437 : *McLeay v. Lawes* (1905) 22. R.P.C. 199 : *Gramophone Co. Ltd. v. Ituhl* (1910) 27. R.C.P. 629 : *Househill Co. v. Neilson* (1843) 9. C. & F. 788, 781 : *Lewis v. Marting* (1829) W.P.C. 490. Compare also *Tangye v. Scott* 14 W.R. 386.

<sup>40</sup> 8th edn. page 87.

<sup>41</sup> 29. L.J. Q.B. 193 at p. 202 : reversed on another ground in the House of Lords see 35. L.J. Q.B. 27.

grant in a case where he has secretly manufactured the invention previously. This proposition cannot be based on the same reasoning as that which supports the principles already referred to relating to the prior user by others. For in a case of prior secret user by the inventor himself there can be no question of other persons being stopped from doing that which they have been doing or had the intention of doing hitherto, nor, it is submitted can there be any question of the invention, when he discloses it, being not novel, nor can any objection be taken for his not giving some consideration for the grant by disclosing his invention to the State. The bar to a grant of patent in such a case as this must be founded it seems entirely or chiefly on other considerations.

It may be that the objection to the grant is to be put upon the ground that as the inventor is expected to disclose his invention to the public within a reasonable time, his working of the invention in secret is to be regarded as something of a fraud upon the public; and that the grant is to be barred or invalidated on that ground. Or it may be that the objection is to be put upon the ground that by the period of such secret user the inventor-Patentee would undesirably prolong his monopoly.

It is difficult nevertheless to understand how it can be said with any real force in most of such cases that the monopoly is prolonged. The observations of Lord Campbell C. J. in *Betts v. Menzies*<sup>42</sup> are of interest. He said :—

“Upon the first point, my opinion is clearly in favour of the Plaintiff. The question arises upon the evidence. Upon the trial it appeared that the plaintiff, who really was the inventor, though the invention may be so imperfect as to deprive him of all benefit to be derived from it, gave directions that the patent should be applied for as soon as he had made the discovery; it was applied for *quam primum*, but from some unforeseen delays in the office, it was not granted within the usual time. In the meantime the plaintiff manufactured capsules according to the new process, but only under the cognizance of his partners, and of his own men, and with the express injunction that none should

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<sup>42</sup> 28 L.J. N.S. (Q.B.) 361 at p. 365.



be sold, and none were sold until the patent had been granted. Under these circumstances, I am of opinion that the manufacturing of the capsules according to the new invention would not invalidate the patent. I quite agree that if you look at the section of the Statute of Monopolies which has been referred to it abolishes monopolies altogether, and that there was no power in the Crown, after that statute passed, to grant monopolies, except with the conditions that are imposed by the reservation, but the reservation which must be relied upon here is this, "which others at the time shall not use." Now, others had not used this before the patent was granted. It was used only by the inventor, the patentee himself, and the use of it by the servants and mechanics whom he employed must be considered to have been his use, and therefore it was not used by others. But, still, if it could be shewn that the effect was really to extend the time of the monopoly, that would be fatal. But the defendant has entirely failed in shewing that, because any person might have used this manufacture lawfully, until the patent was sealed and the fourteen years had begun to run, there was a period of more than fourteen years during which the monopoly existed. That period was not in the slightest degree exceeded, and no inconvenience or grievance is caused to any one individual nor to the country, by saying that this manufacture of the capsules according to the new process before the patent was sealed, shall not invalidate the patent."<sup>43</sup>

At the present day in India the degree of prior user in private permitted to the inventor himself is regulated by Section 38(1) of the Act of 1911.

The effects of this section in this regard were referred to, obiter, in the case of *Lallubhai etc. v. Shamaldas* already mentioned<sup>44</sup> but as there was no direct issue arising on the point in that case

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<sup>43</sup> See Fletcher Moulton p. 67 note (f) and Terrell p. 83 where the point is discussed and certain cases cited.

<sup>44</sup> (1934) 36 Bom. L.R. 881.

there was no direct decision of any point which materially adds to the wording of the Section as it stands. The following extract of one passage among the careful observations of Rangnekar J. may however be of interest as an indication showing how the point should be pleaded in a case in which an issue was to be raised on Section 38(1). The learned Judge in dealing with a certain aspect of the facts in that case observed :—"In my opinion this would be a secret user of the process by the Plaintiff, and if I am right in this, then Section 38(1)(b) would at once come in, and it would raise the question whether the profit made by the plaintiff was unreasonable. There was no pleading to this effect, no issue and no evidence and, I think this is one of the complications introduced in the case by reason of the amendment of the issue, which the plaintiff had never any opportunity to meet. If the defendant had said that the plaintiff used this process for profit or commercially, the latter could have pleaded that it was not a public user but a secret user. I think he might also have contended that it was an experimental user for profit, which under Section 38 is allowed and does not vitiate the invention."

**Mere experimental user by Patentee creates no want of novelty.**

It has long been decided that mere experiment by the person who subsequently becomes the patentee creates no want of novelty and does not invalidate or avoid the grant of patent to him.

As was said in one case, "a man is entitled to make experiments in fact, he is bound to do so. No man can draw up a Specification, which will have the slightest chance of holding water, without testing the results which he is going to state in that Specification, and he is entitled to make experiments; and so far as Mr. Thompson's experiments are concerned I see no reason for doubting that secrecy was observed, and that he and his employes kept the results of those experiments—that is to say, the particular plates which they printed—to themselves. So far there was no publication. A man is entitled to do that; he is entitled to do more than that; he is entitled to ask his friends confidentially to advise him, taking care that they are not so many that they may be regarded as a portion of the public. He is entitled to have the assistance of experts to tell him what things can be done and what things cannot be done."<sup>45</sup>

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<sup>45</sup> By Kekewich J. in *Hudson, Scott & Sons Ltd. v. Baring, Wallis & Manners Ltd.* (1906) 23 R. P. C. 79 at p. 87. See also *Osrarn Lamp Works Ltd. v. "Z" Electric Lamp Manufacturing Coy. Ltd.* (1912) 29 R. P. C. 401 at p. 429.

But, as already indicated it is incumbent on the inventor not to delay unduly before making his application.

This experimental user is to be distinguished from a case where the future patentee manufactures the invention commercially, while keeping the secret of the invention to himself.

Provided the user has not been more than what was generally necessary for the inventor to satisfy himself as to the practicability of the invention, or as to the best form of the invention, it is classed as experimental: it is otherwise if it has exceeded these limits and has been carried on for profit or for the ordinary use of the invention.<sup>46</sup>

It is proposed next to turn from anticipation by prior user to the consideration of documentary anticipation.

#### **Anticipation by documentary publication.**

The form of document through which the anticipation may have been effected is immaterial<sup>47</sup> as is illustrated by the following cases.

*A book or treatise*:—Clearly if it can be shown that before the date of application for a Patent, particulars of the same invention were contained in a widely circulated book published previously in British India, there will be no question but that the invention applied for has been anticipated and is not new. It is another matter however where all that can be shown is that the particulars were contained in a book, which, say, was printed abroad and sent into this country unopened; of which nothing more than the binding can be shown to have been actually seen by anyone in the country. It may become a highly doubtful question in certain particular cases whether there has been sufficient prior publication to show the existence of public knowledge such as to create want of novelty. It is submitted that the statement of the law given in Terrell is not correct<sup>48</sup> to the effect that "mere exhibition in a book-seller's window for sale or sending it to a book-seller in this country to be published, is a sufficient publication." This point is further considered below.

<sup>46</sup> See Fletcher Moulton p. 71 note (f) and the illustrative cases there cited. (Regarding fortuitous user by others see also *John Wright and Eagle Range Ltd. v. General Gas Appliances Ltd.* (1929) 46. R.P.C. 169. (C. A.) at p. 175.)

<sup>47</sup> See page (7) ante.

<sup>48</sup> 8th edn. at p. 93

For illustrative cases reference may be made to *Plimpton v. Malcolmson*<sup>49</sup>, *Plimpton v. Spiller*, *Lang v. Gisborne* (criticised in *Plimpton v. Malcolmson* above), *Otto v. Steel* (below).

*A scientific work in a museum or public library :—*

See eg : *Otto v. Steel*.<sup>50</sup>

*A previous Indian specification :*

This is one of the commonest forms of alleged documentary anticipations.

*A previous foreign specification deposited in the library of the Patent Office :—*

See eg : *Harris v. Rothwell*.<sup>51</sup>

*An abridged foreign specification deposited in the library of the Patent Office.—*

See eg : *Plimpton v. Malcolmson* (above) where one of the documentary anticipations relied on was an American Abridgement in the Report of the Commissioners of Patents of the United States of America for the year 1863.

*An Official Board of Trade Report :—*

See eg : *Paterson v. Gas Light & Coke Co.*<sup>52</sup>

*Drawings or illustrations :—*

There may be a sufficient publication and anticipation through mere drawings. See eg : *The Underfeed Stoker Co. Ltd ; G. & J. Weir's application ; Mooney's Application*.<sup>53</sup>

*A document in a foreign language :—*

The fact that the document relied on as an alleged anticipation is in a foreign language will ordinarily be immaterial. As was remarked by *Chitty J. in Harris v. Rothwell* (supra), "German cannot be

<sup>49</sup> (1876) 3 Ch. D. 558 at p. 562 ; (1876) 6. Ch. D. 412 ; (1862) 31. L. J. Ch. 770.

<sup>50</sup> (1885) 31. Ch. D. 241.

<sup>51</sup> (1887) 35. Ch. D. 416 (No. 1) 3. R. P. C. 243, and (No. 2) 3. R. P. C. 383, and 4 R. P. C. 225 (C. A.)

<sup>52</sup> (1876) 3. A. C. 239.

<sup>53</sup> (1924) 41. R. P. C. 622 ; (1925) 43. R. P. C. 39 ; and (1927) 44. R. P. C. 294 respectively. See also *Plimpton v. Spiller* (1877) 6. Ch. D. 194. C. A. at p. 198 ; *Electric Construction Co. Ltd. v. Imperial Tramways Co. Ltd.* (1900) 17. R. P. C. 537 at p. 550 ; Cf. *Haddan* at p. 199 ; *Terrell* p. 100.

treated in this country as an unintelligible language" German Specifications at the English patent office were held to be a prior publication in that case. In *Otto v. Steel* (supra) a book in French at the British Museum was relied on as a prior publication. Though it was held by the Court, for other reasons, that there had not been a sufficient publication, this decision was not affected by the fact that the book was not in English.<sup>54</sup>

**Importance of the question what degree of publication or publicity in publication will amount to want of novelty.**

The question whether in a particular case there has been sufficient publication frequently at the present day arises in regard to opposition proceedings.

The present material provisions of the English Act of 1907-1932 contained in Section 11 (1) (b) relate to objections on certain grounds worded as follows :—

"That the invention has prior to the date which the patent applied for would bear if granted been *published* in any complete specification, or in any provisional specification followed by a complete specification, deposited, pursuant to any application made in the United Kingdom and dated within fifty years next before such date, or has been *made available to the public by publication* in any document (here follow certain exceptions) *published* in the United Kingdom before such date."

The question, what is sufficient publication, thus directly arises in connection with the actual present wording of that section.

The provisions in force in India corresponding to those cited and denoting the grounds on which opposition may be made for want of novelty in respect of documentary anticipation are contained in Section 9 of the Indian Act of 1911; worded barely and without detail as follows :—

<sup>54</sup> See also *Lang v. Gisborne* 31. L. J. Ch. 769 which though since dissented from on another point, stands good law on this point. And see eg: *Harris v. Rothwell* (1887) 4. R. P. C. (C. A.) (particularly) at p. 231; *Rucher v. London Electric Supply Corporation Ltd.* (1900) 17. R. P. C. 279 at p. 295. See Fletcher Moulton p. 65.

“that the invention.....has been *made publicly known* in any part of British India.”

The words “made publicly known” also refer to publication and publicity. The same question therefore arises in regard to this Indian Section. It is true that the wording of the English section given above differs from the manner in which it was worded in England prior to the year 1919. Previously to 1919 it would appear that there was no express provision in the earlier section 11 relating to an objection in opposition proceedings for want of novelty on the ground of documentary anticipation except for cases “where the invention had been claimed in any complete specification which was or would be of prior date” to the Patent opposed. And the statutory words now in Section 11(1)(b) “made available to the public” have only therefore come before the English Courts for construction since 1919. But as it was always open to an applicant in England to obtain revocation of a Patent for want of novelty based on documentary anticipation, and as it was also always open to a Defendant in an infringement suit to take the defence that the Patent was invalid on the same ground, this same question, relating to the degree of publicity necessary to make a sufficient publication to create want of novelty by reason of a documentary anticipation, has for long been an important question of English Patent Law also in proceedings other than opposition proceedings.

In respect of the degree of publicity fundamentally required to amount to a sufficient publication to create a want of novelty so as to invalidate a patent, it is submitted that there has been no change in English Law either before the Act of 1919 or since : and that the application of the present English Section 11(1)(b) has at the most made an alteration of procedure only, whereby it has been made possible to an opponent in opposition proceedings to take a certain objection (viz. that of want of novelty for documentary anticipation) which was only a ground of invalidity open previously to 1919 at other stages of objection to a Patent after grant.

Apart from this the question of publication may be involved indirectly or directly under Section 5(1)(e) of the Indian Act in regard to the enquiry made by the Controller as to novelty, under Section 26(1)(b) in regard to revocation based on a ground of want of novelty : and under Section 29(2) in regard to a defence on

similar grounds in a suit for infringement. Wherever there is alleged to be a want of novelty on a ground of alleged documentary anticipation the element of the question of the sufficiency of publication or publicity is involved : even though the word "publication" is not used in a particular part of the statute under reference.

Clearly unless sufficient publication (in some sense) is shown to have taken place of the document comprising the alleged anticipation, there will be no previous public knowledge and consequently no want of novelty. It becomes essential to consider what degree of publicity in such publication is required to support an objection for want of novelty.

### **"Publication".**

It is submitted there are two distinct questions: (i) what nature and degree of publication is required in Patent Law to amount to anticipation so as to create want of novelty and (ii) what evidence will satisfy the Court that such publication has in fact existed or has in fact not existed. It would appear that in some of the reported cases the two questions have been confused. It is proposed here briefly to treat of them separately.

### **As to the nature and degree of publication required in Patent Law to create want of novelty.**

In Patent Law is the publication of a document, such as must be established in order to create want of novelty in a subsequent patent, required to be the same in nature and degree as the publication of a document which is required to be established, for example, to support a claim for libel : or does it differ and if so to what extent?

It will be found that there have been decisions of cases in England which show conflicting tendencies on this point.

(It is submitted that in English Patent Law both past and present the better view is that what is meant by "publication" in Patent Law is very different from what is meant by "publication", for example in connection with the law of libel.)

In the first place, it is submitted, it will be found on an examination of the English cases that under English Patent Law something more than a mere publication in the technical sense in

which that word is used in what may for convenience be spoken of as the libel sense, is required ; and a certain substantial degree of publicity is required.

There will be found in the cases dicta which may be taken to favour a contrary view ; and to favour the view that any actual publication to a single person, provided the communication is not made on a condition that it is confidential, will be enough publication in patent law to amount to anticipation. Principal examples of such dicta may be noted in the cases of *Lang v. Gisborne* (in 1862) (by Lord Romilly M. R.) and the *Underfeed Stoker Company's Application* (in 1923) (by Sir Henry Slessor, S. G.)<sup>55</sup> But the first case was criticised or dissented from by Jessel M. R. in *Plimpton v. Malcolmson* and the second case was criticised or dissented from by Sir Thomas Inskip, Solicitor-General in *G. & J. Weir Ltd.'s Application*.<sup>56</sup> Moreover Brett L. J. in *Plimpton v. Spiller*<sup>57</sup> made the following observations directly dealing with this point in which he clearly indicated that mere publication in the narrower sense was not the test :—".....Another mode of proving the fundamental proposition is to show that a description of the invention has been published. But, then, to shew that, it is not sufficient merely to show that it has been published in one sheet or book. As Baron Parke himself says "published means offered or dedicated to the public". He then goes on to say that the question with regard to that, is :—Was the invention published or offered to the public to such an extent as that it was generally known among engineers or persons interested in the matter ? The mere fact of its being dedicated, the mere fact of its being published, is not sufficient it must be so far published as that you may fairly say it is known to a sufficient number of the public." It is submitted in regard to what is publication in Patent Law, a correct statement of the law which is equally applicable to-day as it was prior to the year 1919 is to be found in the decisions of Sir Thomas Inskip in *G. & J. Weir Ltd.'s Application* and in *Mooney's Appli-*

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<sup>55</sup> 31. Beav. 133 and (1924). 41. R. P. C. 622 respectively. See also the Judgment of Fry L. J. in *Humpherson v. Syer* (1887) 4. R.P.C. 407 relying on a passage in *Harris v. Rothwell* and taking the same view.

<sup>56</sup> (1876) 3. Ch. D. 531 at p. 561 and (1925) 43. R. P. C. 39 at p. 44.

<sup>57</sup> (1877) 6. Ch. D. 412 at p. 435.



cation<sup>58</sup> where it was laid down in effect, that, for there to be anticipation in patent law by a prior documentary publication there must be for the purposes of patent law something more than mere publication (that is to say in the libel sense) even if the communication relied on for publication is unaccompanied by any bond of secrecy.

What that something more will be than mere publication—that is to say what precise degree of publicity is required—depends on the circumstances of each individual case.

To what numbers and portion of the public the publication is required to be in order to amount to anticipation is another matter : once the principle is fixed that there must be publication of such a sort that it may be said to result in a dedication to the public, it is a question of fact in each case whether the requisite degree of publication has been effected. The question is whether the document in question has in fact been sufficiently published to come within the definition of being made known within the realm. Or, as it was put by Brett L. J. in *Malcolmson v. Spiller*, the question is “whether the invention was.....known to the public, not known to all the public, but known to a sufficient number, so that you may properly say it was known in England”. The following observations bearing on this point were made by Jessel M. R. in *Plimpton v. Malcolmson*. “When you say a thing is known to the public and part of common knowledge, of course you do not mean that every individual member of the public knows it. That would be absurd. What is meant is that if it is a manufacture connected with a particular trade, the people in the trade shall know something about it ; if it is a thing connected with a chemical invention, people conversant with chemistry shall know something about it. And it need not go as far as that. You need not shew that the bulk, or even a large number, of those people know it.”<sup>59</sup> As was said by Sir Thomas Inskip in *Mooney's Application*<sup>60</sup> “obviously the expression “the public” does not require the inclusion of the whole world”. And as was said also by Sir Thomas Inskip in *G. & J. Weir Ltd.'s Application* :—<sup>61</sup>

<sup>58</sup> (1925) 43. R.P.C. 39. and (1927) 44. R.P.C. 294 at p. 297 respectively.

<sup>59</sup> (1876) 3. Ch. D. 531 at p. 555.

<sup>60</sup> (1927) 44. R.P.C. 294 at p. 297.

<sup>61</sup> (1925) 43. R.P.C. 39 at p. 45.

"Publication may take place in circumstances of infinite variety, and the circumstances have to be considered in each case. The publicity attending the occasion of a particular publication may satisfy the words of the statute in one case ; in another case it may be the accessibility to students of the place of deposit of the documents, or the multiplication of copies of the documents, or the position of the person or persons to whom the documents were published."

It is thus clear, it is submitted, that a certain degree of publicity is postulated ; in a greater degree than would be requisite to establish mere actual publication for example in a libel action.

In the second place in considering the nature and degree of publication required in Patent Law to create want of novelty, and in considering for purposes of comparison the possible differences between such publication and the nature and degree of the publication necessary in matters of libel, a second point of interest arises, on which also divergent views appear to have been taken in the English decisions. Does the publication required in Patent Law postulate or necessarily entail or depend upon any actual publication in the libel sense at all ? Or can there be a dedication to the public so as to amount to an anticipation before there is, or without there being, any actual publication in the libel sense at all ?

To take a specific illustration : it is generally assumed in the Courts in England that if it is shown that a volume (it may be printed abroad and therefore not previously published in England to anyone) containing a description of a particular invention has been placed in the public room of the British Patent Office, this will amount to enough publication to be anticipation.

But does this view depend on the reasoning that the mere fact of so placing a volume in the Patent Office Library is a dedication to the public : a "publication" in itself in the Patent sense ? Or does it depend on the reasoning that when a volume is so placed in the public room of the Patent Office there arises at once a strong presumption (as a rule of evidence or inference of fact merely) that people will have read it and that accordingly there must be presumed to have been actual publication ?

It will be seen that on the former line of reasoning it will be immaterial if a party proves that in fact no one has read the volume

in question : there will be public knowledge and anticipation for all that. On the latter line of reasoning the presumption may be displaced by positive proof of non-publication : as would be the case if it were shown that all the pages were uncut or in cases where a list of persons taking out books was kept, if it were positively shown that no one had taken out the books.

For an instance, where the former line of reasoning was enunciated by one of the learned Judges of the Appeal Court, see the judgment of Lopes L. J. in *Harris v. Rothwell*<sup>62</sup> in which the learned Judge expressly observed as follows :—"In my opinion the depositing the specifications in the library of the Patent Office in the way described was itself a publication of the invention contained in them, and I think that the invention was then dedicated to and became the property of the public."

As an instance where the other view was forcibly expressed, the observations of Jessel M. R. in the case of *Plimpton v. Malcolmson*<sup>63</sup> may be cited, which were as follows :—

"Now, there is no law on the subject except this, that the Judge, on the facts proved, has to come to a certain conclusion. If it were necessary to express an opinion upon that, I should say it must depend on circumstances. It by no means follows, because the book has been printed and published, and sent to a bookseller for sale, that it is part of the public knowledge. Suppose it were proved that the bookseller never did sell any, or attempted to sell any. He says "exposed for sale". Suppose the bookseller had put one volume in his shop-window as exposed for sale for one day, and the next day, by direction of the author, destroyed all the volumes, that would not do, and I do not think that Lord Romilly intended that it would. These are general observations, not to be read in that strict literal sense, but in this sense ; that, if a man publishes a book, that is a large number of copies, and sends them to booksellers for sale, and they are, for a reasonable time, exposed in the window, so that you may infer the people have known and seen them, and may reasonably so infer, though you did not prove one has been sold—if the other side cannot prove that one has not been sold, you may reasonably infer that some of those books have been sold. If he means anything more than that, I humbly dissent from

(1886) 35. Ch. D. 416 at p. 433.

1876 3. Ch. D. 531 at p. 562.

it ; and I say that my decision is supported by the previous decisions to which I have referred, because I am clear that, if it were shewn that no copy had ever got into the hand of the public, and the public knew no more about it than seeing the back of the book in the bookseller's window, and every copy could be accounted for, and that none had been sold though exposed for sale, that would not be a sufficient publication to avoid a subsequent patent."

Observations such as those of Lopes L. J. in *Harris v. Rothwell* (above) would seem to suggest that the previous Specification has become "public knowledge" as soon as it was deposited in the Patent Office Library : by being dedicated to the public and by affording the public a ready means of acquiring the requisite knowledge at their desire. In that view what happened to the Specification after its deposit would be immaterial. Actual publication in the libel sense would be immaterial. Equally actual non-publication in the libel sense would be immaterial.

Observations on the other hand such as those of Jessel M. R. would clearly suggest that actual publication in the same sense as in libel must be established. It is submitted that the better view is that enunciated by Jessel M. R. In this view actual publication is postulated ; though it may be presumed to exist in circumstances in which for example publication in a libel action might not be held to have been established.

**As to the proof of "publication" : evidence.**

The other question, whether in any given case the Court will be satisfied that publication so as to create public knowledge has in fact existed or has not existed, may involve then and depend upon a rule of evidence.

Take again the illustration of the case where there has been a deposit of a Specification at the Patent Office and nothing more.

On the view of Lopes L. J. that deposit without more would amount to a dedication to the public of the invention described in the Specification : proof of non-publication in the libel sense would not affect the position : to show that it in fact had not been read by any person would be immaterial. There having been final proof of public knowledge, no question of any presumption either rebuttable or irrebuttable arises.

On the view, on the other hand, of Jessel M. R. the fact of the deposit at the Patent Office would raise a presumption (but no more) of publication, in circumstances in which if the presumption were not rebutted it should be held that there was public knowledge and all the consequences of want of novelty following from it. But this finding would be due to a rule of evidence only. On this view the presumption arising would be a rebuttable presumption. And if it could be shown that in spite of the deposit, no one in fact had read the Specification in question, then there would be held to be no publication, no public knowledge of the document relied on as being the anticipation, and consequently no want of novelty in regard to the latter Patent.

The doubt raised in the English cases would be dissolved by a direct decision of the previous question : whether actual publication of the document relied on as an anticipation is postulated.

It is submitted, though the matter is not free from doubt, that actual public knowledge is required to exist in order that there may be said to be any want of novelty : that for the public to have had available to it the means of public knowledge is not enough to create want of novelty : that therefore some actual publication (whether shown positively or presumed) is a necessary ingredient in public knowledge : and that therefore if it is shown in any particular case that there has been no publication (in India) to a single person then there is no documentary anticipation, no public knowledge, and no consequential want of novelty. It is submitted accordingly that the presumption of publication in such a case as that mentioned (whether of fact or law) is rebuttable.

### **Anticipation by oral publication.**

The principles of reasoning concerning the degree of publicity postulated in the publication of any oral communication which is relied upon as an anticipation, are the same, it is submitted, *mutatis mutandis*, as those discussed above in regard to documentary anticipation.

The broad test, it is submitted, will be : was a description of the alleged invention published orally in such circumstances and with such a degree of publicity as to make it public knowledge ?

**Confidential communications.**

If it is shown that the communication alleged to have been published was made (whether in writing or orally) in confidence and under a condition of its being kept secret by the person to whom it was communicated, there will ordinarily be held to be no publication and no public knowledge ; and consequently a subsequent application for a Patent will not be affected by any want of novelty. It will be often a question of fact, about which there may be some doubt, whether a given communication was in fact made confidentially. It would seem that even where the communication was not expressly made on a condition of confidence, the relation of confidence may in certain circumstances be inferred from the position of the persons making and receiving the communication<sup>64</sup>.

**Anticipations actually resulting in India through being made available to the public at the Indian Patent Office.**

It is to be noted that the Indian Patent Office receives regularly the following documents and periodicals from the Patent Offices of the following countries :—

*N.B. What is spoken of throughout this work as the Indian Patent Office is the Patent Office for British India situated at No. 1 Council House Street in Calcutta.<sup>65</sup> The term "Indian Patent Office" is strictly speaking a misnomer as it has no concern with the independent Indian States, some of which have Patent systems of their own. It will however be continued to be used throughout this work for brevity : and because it is the name now in ordinary use.*

**(a) From the United Kingdom :—**

- (i) All the publications of the United Kingdom Patent Office : including all printed Specifications in full.

**(b) From other British Dominions and Colonies :—**

- (i) From Australia ; the Journals issued by the Australian Patent Office. These only contain numerical references by a name index and by a subject matter index

<sup>64</sup> See Fletcher Moulton p. 66 citing *Humpherson v. Syer* (1887) 4. R.P.C. 407 at p. 414 (C.A.) ; *Pilkington v. Yeakley Vacuum Hammer Co.* (1901) 18. R.P.C. 459 ; and *Patterson v. Gas Light & Coke Co.* (1878) 3 A.C. 239. See also *G. and J. Weir Ltd's Application* (1926) 43. R. P. C. 39.

<sup>65</sup> See page 64 *ante*.

to Australian Patents ; they do not contain any full Australian Specifications or any Abridgements of Specifications.

(ii) From Ceylon : The Annual Reports of the Patent Office of Ceylon. These similarly do not contain any full Ceylonese Specifications or even any Abridgements.

(iii) From New Zealand : from time to time but not regularly : The Annual Reports of the New Zealand Patent Office. These similarly do not contain any full New Zealand Specifications or even any Abridgements.

(iv) From other British Dominions or Colonies :—Nil.

(c) From Indian States :—Nil.

*N.B. There are issued in certain of the Indian States at various times certain publications : e.g. Gwalior ; Hyderabad Deccan ; Indore ; Kashmir ; Marwar ; Mysore ; and Travancore. Such publications do not contain more than the date, name, title or number of any applications for Patents made in the respective Indian State. They do not contain any full Specifications or even any Abridgements. Such publications are not received by, and are not available at, the Indian Patent Office.*

(d) From the United States of America :—

The Indian Patent Office receives regularly the Weekly Gazettes issued by the U. S. Patent Office. Such Weekly Gazettes, while they do not contain any full American Specifications, contain Abridgements of Specifications relative to all Patents granted by the American Patent Office.

*N. B. Such an American Abridgement is precisely similar to the document of that description referred to in Plimpton v. Malcolmson.<sup>66</sup> It consists of a sample drawing and a copy of the first claim (which is usually the broadest claim), of the relative American Specification. Just as it was held in Plimpton v. Malcolmson that the American Abridgement in that case did not amount to an anticipation for the reason that sufficient details were not given in it to enable a person seeing it to make the invention in question ; so in*

<sup>66</sup> (1876) 3 Ch. D. 531.

*many; probably most cases, it will probably happen that a holder of an Indian Patent may not be affected by an American Abridgement, even in a case where if the full American Specification had been filed and made available to the public at the Indian Patent Office this would have amounted to an anticipation. The reason for his not being affected will be in such a case merely the incompleteness of the abridgement. In other cases where a sufficiently clear description of the invention is to be gathered from the Abridgement alone, as particularly in the more simple inventions, such an Abridgement will stand on the same footing for being a potential anticipation as the full Specification itself.*

As it may be a matter of considerable importance, in coming to a conclusion whether any particular document is an anticipation or not in any particular case, to know how it has been dealt with in order to ascertain whether it has been published or given any publicity so as to have become public knowledge in India—it becomes of interest to note how certain of the documents mentioned above are in practice dealt with after their deposit in the Indian Patent Office.

It is not necessary to refer further to the documents or periodicals received from countries other than the United Kingdom and the United States of America, since their very nature precludes them in any case from amounting to any documentary anticipation of any subsequent Indian Patent or Application for Patent. It remains to consider what happens to documents and periodicals received in the Indian Patent Office from the United Kingdom and the United States of America.

Under the present practice adopted at the Indian Patent Office one copy only is kept at the Indian Patent Office of every British Specification issued by the Patent Office of the United Kingdom. The files of these British Specifications from the time of their receipt are kept in an inner room at the Indian Patent Office, not the public reading room: and any particular British Specification is only available to a member of the public if requisitioned for by such person by its number. There are no copies of any British Specifications (apart from certain old Abridgements to which reference is made hereafter) kept in the Public Reading Room of the Indian Patent Office. It is true that the member of the



public requiring to see one or more British Specifications may make a search either in a Subject-Matter-Index or in a Name-Index (both of which indexes refer only to the number of any British Specification) and thus find out the numbers of certain British Specifications related to some particular subject-matter or to some particular inventor's name, but except for this he has nothing to guide him in fixing on any particular number. Possibly by requisitioning for all the numbers between two figures separated by an interval of, say, one hundred numbers, he might succeed in obtaining inspection of the last hundred British Specifications issued. To do this, even, he must find the number of the most recent British Specification as a guide. And when it is recollected that over 37,000 applications for Patents are received by the British Patent Office in a year (37,409 being the figure for 1934) and that over 16,000 new Patents, each with its Specification, are sealed by the British Patent Office in a year (16,890 being the figure for 1934)<sup>67</sup> and that many more Specifications are issued than the bare numbers of Patents that come to be granted, it is seen that the task of inspecting these by requisitioning them by number is by no means a simple matter. In these circumstances the question arises whether the filing of British Specifications in this manner at the Indian Patent Office in truth amounts to making such British Specifications public knowledge in India or not.

The position in regard to the American Abridgements which appear in the U. S. Weekly Gazette is the same as for the British Specifications already described ; except that the current copy out of the American Abridgements is placed in the public room after receipt for the space of one week or slightly more.

*N. B. There are certain old issues of British Abridgements (i.e. for years prior to the year 1929 or thereabouts) which are stored in unlocked book-cases in the Public Reading Room. These are apparently available for the perusal of any member of the public without formality and without being requisitioned by number. It would appear that these certainly would (in the absence of positive proof of non-publication in any particular instance) be held to have been made available to the public so as to be public knowledge in*

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<sup>67</sup> See the 52nd Report of the Comptroller General of Patents, Designs and Trade Marks for 1934.

*British India : though in view of the antiquity of these Abridgements the question of an anticipation of a current Indian Patent by one of these British Abridgements may be expected but seldom to arise.*

Indian Specifications, that is to say Specifications relating to Indian Letters Patent which have been granted in British India, are stored and issued differently to the British Specifications and American Abridgements to which reference has been made above. In the case of Indian Specifications printed copies of these are placed in open shelves in the Public Reading Room of the Indian Patent Office as soon as they are printed. The printed copies are bound up into volumes which are also stored in the same way in the Public Reading Room. These bound volumes as well as the loose printed copies of the current unbound volumes are available for inspection and perusal by any member of the public at his pleasure without any formality.<sup>68</sup>

It takes ordinarily about five weeks for Indian Specifications to be printed after the date of the acceptance of a particular application for Patent. Typed copies of such unprinted Specifications are kept with the Superintendent though not placed in the Public Reading Room. Such typed copies may be obtained on requisition (by number) to the Superintendent.

It is of interest to note that in England all printed Specifications in the Patent Office, whether of the United Kingdom or of other countries, are stored on open shelves in the public Patent Office Library ; and may be inspected and perused by any member of the public at his pleasure without any formality.

In the circumstances noted, it is clear, it is submitted, that just as in England a previous British Specification is held to be an anticipation (by reason of its having become public knowledge), so a previous Indian Specification will be an anticipation in British India by reason of its having become public knowledge. This is obviously right and proper from every point of view.

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<sup>68</sup> A further factor which may have a bearing, perhaps slight, but perhaps cumulative on the question of publicity is the difference in the hours at which documents are available. In the U. K. Patent Office between 9-30 a.m. and 9-30 p.m. : in India between 11 a. m. and 4 p. m. which means that perusal of documents becomes more difficult for those persons whose time in office hours is not their own.

As to whether or not in India under the system above noted a British Specification or an American Abridgement stored at the Indian Patent Office should or should not be held to have been sufficiently published by reason of such storage so as to have become public knowledge in British India, sufficiently to amount to an anticipation of a later Indian Patent or Application for Patent is, it is submitted, a different matter. On the whole, it is submitted, the true legal position would seem to be that in reality and in law there is no sufficient publication by storage in the Indian Patent Office, in the conditions noted, such as to constitute any public knowledge in India of the contents of these British Specifications or American Abridgements. The backward state of industrial development at large in British India in comparison with England in regard to Patents may also be taken into account as supporting this conclusion. No doubt in England all foreign specifications are avidly read by persons interested in a particular sphere of industrial activity in which inventions are important and no doubt the knowledge contained in the foreign specifications filed at the British Patent Office is in fact as well as on paper "public knowledge" in the United Kingdom in a very short space of time after the specifications are filed at the British Patent Office. In India, as is well known, the position is very different and in the ordinary way no one will read the patent specifications which are received (in their thousands) by the Patent Office from abroad. Apart from this there is the most important difference due to the different methods of storage and treatment between the Patent Offices of India and the United Kingdom which has been already explained, which, it is submitted, results in a very material difference in the degree in which the specifications from abroad are in each respective country available to the public.

It may well be having regard to these circumstances, that when the question comes to be directly decided, a Court in India may hold that the mere existence of a British Specification in the Patent Office in Calcutta and nothing more does not amount in India to a publication (so as to constitute public knowledge in India) at all. It is submitted that such a decision would in law be correct in British India under present conditions; just as it was decided in England in the case of *Otto v. Steel*,<sup>69</sup> in effect, that the mere exis-

tence of a book in the British Museum did not constitute public knowledge in England.

In an unreported case in the Calcutta High Court,<sup>70</sup> *National Carbon Co. Inc. v. Brough & Co. Ltd. and Anr*, Buckland J. expressly held that American Abridgements were not public knowledge and were no anticipation. The material passage of the Judgment is as follows :—"The only other point with which I need deal is as to the alleged prior publication by a Specification known as Briggs, of which a copy of an abridgement appearing in the Official Gazette of the United States Patent Office was received at the Patent Office in Calcutta in January 1928. I should have been disposed to hold that had this been published to the world it anticipated the plaintiff Company's invention, but in my opinion there was no publication upon which the defendant Company can rely. The Official Gazette of the United States Patent Office is not open to the public in that any one can pick it up and consult it as in the case of other publications. It is kept in a separate room known as the Record room, though any one can see it on requisition. This might suffice if the public knew the publication was available but a person would only ask for it if he knew such a publication existed and might be seen in the Patent Office. It was only quite recently that attention was drawn to the fact that this publication may be consulted by a paragraph in the Patent Office hand-book. Had that paragraph appeared in earlier editions of the hand-book it might be said that the attention of a careful searcher was drawn to this publication, but as it is I do not think it can properly be said that the abridgement of Briggs' specification was available to the public at any time prior to the issue of Letters Patent to the plaintiff Company."

It is to be noted that according to the practice then subsisting, there was no reference in the Patent Office Hand-book to the existence at the Indian Patent Office of those American Abridgements. Buckland J. appears to rely among other facts partially on that fact. It is open to doubt what his decision would have been concerning more recent times since when the existence of the Abridgements has been mentioned in the Patent Office Hand-book.

In regard to British Specifications the fact that these were treated so as to receive only the same or less publicity than American

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<sup>70</sup> Suit No. 2882 of 1931.

Abridgements, apart from the question of a mention in the Patent Office Hand-book, does not appear to have been appreciated by the Court. To arrive at his Judgment on the main issue in the case (that the plaintiff Coy.'s Patent had been anticipated by the publication of a British Specification at the Indian Patent Office) is necessarily to assume that such a British Specification was public knowledge in India. But in that case Buckland J. did not expressly deal with the position as to British Specifications and made no direct observations as to them. <sup>71</sup>

Until the point is decided definitely one way or the other in an Indian Court it will remain a question of considerable doubt what is the true position in law in India.

Whatever may eventually be held to be the correct view in law, the current daily practice of the Patent Office in India in the meantime is based on an adoption of the view (contrary to that advocated above) that the position in India is the same as in England. On an analogy with the current practice of the English Patent Office, the Indian Patent Office in the conduct of its examinations before acceptance, in all opposition proceedings before the Controller, in fact in all its transactions, always acts on the view that any sufficient prior disclosure of an alleged invention in any prior British Specification is an anticipation : and for this purpose acts on the assumption that such prior British Specification has in every case become public knowledge in British India through its storage at the Indian Patent Office.

It is difficult to reconcile the view at present adopted by the Indian Patent Office (in their treatment of British Specifications as public knowledge and anticipations) with the full force of the observations of the Calcutta High Court (Buckland J.), having

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<sup>71</sup> The unreported case cited was a suit for infringement of a Patent. In the Court of first instance the Judgment of Buckland J. was in favour of the Defendants: the suit being dismissed with costs. The Plaintiff Company appealed. During the hearing of the Appeal and before the conclusion of argument one of the learned Judges of the Appeal Court fell ill. Thereafter the Appeal was settled: the terms of settlement (put into Court) being on the basis inter alia that the Judgment of Buckland J. was set aside. It remains a matter of conjecture what the decision of the Appeal Court would have been on the particular point now under discussion.

regard to the conditions actually existing as to the treatment of British Specifications after their receipt at the Patent Office.

It is submitted in view of the foregoing considerations therefore that these British Specifications thus stored at the Indian Patent Office do not in truth amount in Patent Law even to paper anticipations : and do not in truth create any want of novelty. Even if it were to be considered that they did amount to anticipations, it certainly cannot be suggested that they amount to any public knowledge in a real sense or to anything more than paper anticipations of the flimsiest and most technical character. It is difficult to see what manner of advantage or benefit is gained by the continuance of the present system for enforcing such mere paper anticipations as might be thus supposed to be comprised in British Specifications, as an effective bar to subsequent genuine Indian Patents.

Should it be desired to make certain that inventors and prospective patentees in India should be unhampered by the dead mass of the contents of non-Indian specifications buried only at the Indian Patent Office, the desired result could very easily be achieved : either by the issue of executive directions only or by legislation or both.<sup>72</sup>

#### **Degree of similarity :**

In all the cases contemplated, where there has been a communication which is alleged to amount to a previous disclosure of the alleged invention so as to constitute want of novelty, no matter whether such communication has been documentary or oral or through user, the question will arise whether the thing disclosed was so similar to (or identical with) the alleged invention as to amount to an anticipation of it. If there is not identity, or at least a great enough degree of similarity, obviously there can be no anticipation in any circumstances.

A comparison between the nature and limits of the alleged inven-

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<sup>72</sup> It appears that British specifications have also been stored in Bombay at the Record office : copies of specifications issued for the years from 1670 to 1931, bound in volumes of 100 copies : but that they have been discontinued since 1932. And British Abridgements from the year 1861 up to date. It is submitted that the storage in the Record office having regard to its method and to all circumstances does not amount to public knowledge in fact in India. So far as has been able to be ascertained British specifications are not kept in any other public institute in India.

tion has therefore to be made with the nature and limits of what was previously published. This comparison is not infrequently the crux of the whole question whether or not there has been anticipation so as to create want of novelty ; and in the process of making the comparison, difficult and fine questions of construction may arise.

In considering any document which is alleged to amount to an anticipation it is necessary to construe any ambiguous or doubtful passages or expressions in the light only of the existing knowledge in the art at the time the document was written : that is to say the existing common knowledge at that time. In considering the meaning of an oral communication, similarly, it is submitted, only that meaning will be attached to the communication which is within the limits of the existing common knowledge at the time it was made. And in considering the implication of a prior user, it is similarly submitted that a communication will be understood to have occurred only of so much as a person seeing the user would be expected to understand having regard to the existing common knowledge of the time when he saw the thing used.

A similar question arises in regard to the making and construction of the specification relating to the Patent which is said to be anticipated. In that case also any ambiguous or doubtful passages or expressions are to be read in the light of the existing common knowledge in the art at the time when the grant to which the specification relates was made.

The question however remains : what standard of what person's knowledge is to be deemed to be treated as the background or basis of any such process of construction ?

As to this process of construction (which is preliminary to any process of comparison) certain definite principles have been evolved in the decided cases. Broadly speaking, it may be sufficient for present purposes to state that the standard of knowledge by which the document is to be taken is the common knowledge of a craftsman competent in the art, reading the document at the time when it was made ; or, in the case of a Patent Specification, then reading it at the date of the grant of the Patent to which it relates.<sup>73</sup>

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<sup>73</sup> See Fletcher Moulton (1913 Edn) p. 57, p. 123 and pages 132 and 133 and generally Fletcher Moulton Chapter VIII.

**Provisos as to anticipation :**

Certain express provisos contained in the Indian Patents and Designs Act 1911 which prevent certain cases of an exceptional character being treated as cases of want of novelty may here be noted. They are embodied in Section 13 (1) and Sections 38 and 40 and Section 78A.

Sections of a somewhat corresponding nature in the English Act of 1932 are Section 15 (1) and Sections 41, 45 and 91.

**Want of novelty : how far a question of fact or law :**

Whether an alleged invention is new will depend on the different facts of every case. In the main it is a question of fact.<sup>74</sup>

But it is submitted that a subsidiary question whether any particular alleged communication or alleged publication did or did not amount to common knowledge or to public knowledge, as the case may be, or subsidiary questions either of the construction of the specification of the Patent alleged to have been anticipated or of the construction of the document or specification which is said to amount to the anticipation may be in themselves, or entail, questions which are in truth questions of law.

**At what stages objections for want of novelty may be raised in British India :****(i) Before acceptance of the application :—**

It is generally assumed that Section 5 (1) (e) entitles the Patent Office to raise objections as to want of novelty and not merely as to subject matter. While the wording of Section 5 (1) (e) on this assumption would allow the Patent Office to raise objections on all the grounds of prior user, prior oral publication, and prior documentary publication in any documents or periodicals or scientific treatises, in addition to prior documentary publication in British Specifications and in American Abridgements (deposited at the Patent Office) and in addition to prior documentary publication in Indian Specifications ; yet in actual practice the search of the Indian Patent Office at this stage does not ordinarily go outside the field of Indian Patent Specifications, and does not usually cover British

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<sup>74</sup> *Pickard v. Prescott* (1892) 9. R. P. C. 195 H. L. at p. 200;



Specifications (or very seldom), and rarely covers publications other than Specifications.

When it is observed that the wording of 5 (1) (e) is restricted to the point whether "the invention as described and claimed is *prima facie* not a new manufacture or improvement" it would seem doubtful how a search concerning a want of novelty apart from what appears on the face of the Specification—that is to say a search into other documents for an investigation for documentary anticipation—is at all covered by the wording of 5 (1) (e) or properly speaking authorised or justified thereunder.

*N.B.* The more precise wording of Sections 3, 6 (which concerns chiefly an examination only for comparison between the complete and the provisional specification), and 7 of the English Act may be contrasted with the wording of the provisions of Section 5 of the Indian Act.

(ii) In opposition proceedings before the Controller :—

Under Section 9 (d) of the Indian Act, want of novelty in any form, whether by anticipation by publication by prior user, or by oral publication, or by documentary publication, may be raised by the opposer as an objection to the grant.

Section 9 (d) in this respect differs very materially from the corresponding English Section 11. It will be seen that in England under that section prior user is not available as a ground : nor is the ground of oral anticipation but only documentary anticipation within the limits there stated.

Section 9 (b) in so far as it may be treated as relating to want of novelty and not to prior grant (which it also covers) does not actually add to or affect the grounds stated in Section 9 (d). It may however be treated as covering by express reference a ground of want of novelty for documentary anticipation in a prior Indian Specification ; which ground is already covered, generally, by Section 9 (d).

(iii) On a Petition to Court for revocation :—

The term "new invention" used in Section 26 (1) (b) will, it is submitted, cover objections for want of novelty as well as objections in certain respects for want of subject matter.

Every form of want of novelty, whether for anticipation in

India by prior user, or by oral publication, or by documentary publication in any documents (whether Indian Specifications, British Specifications, Foreign Specifications or Abridgements or periodicals or treatises or books or correspondence) may be raised as a ground for revocation under Section 26 (1) (b).

*N.B. The wording of Section 26 (1) (b) is not altogether happy in contrast to the more explicit wording of Section 25 of the English Act; in which, Section 25 (e) is made clearly to refer to want of novelty, while other sub-sections by their separate inclusion are made by contradistinction to refer to various aspects of subject matter.*

(iv) In an infringement suit as a defence :—

The position is the same as for a Petition to Court for revocation : by virtue of Section 29 (2).

## B. FREEDOM FROM ANY PRIOR GRANT

### Prior grant a ground for invalidity :

It is clear that the Crown cannot purport to make the same grant for the same monopoly to two different persons on different occasions: it cannot issue a second grant in derogation of a former grant. Therefore a Patent for an alleged invention for which a prior grant by a previous Patent has been made is clearly invalid on fundamental principles of the Common Law. Under the English Act of 1907-1932 the possibility of a bar by prior grant is expressly made the subject matter of a search by the Patent Office under Section 8. It is also expressly provided for as being a possible ground of objection in opposition proceedings under Section 11 (1) (bb). Under the English Act of 1907-1932 such an objection for prior grant is also expressly made a ground on which the revocation of a patent may be obtained under Section 25 (2) (a): viz: "that the invention was the subject of a valid prior grant". The same ground is also made available in England as a defence to an action for infringement by virtue of Section 25 (3) of the English Act. The corresponding section in the Indian Act of 1911 ( see Section 26 ) contains no such express provision. Such an objection to the

validity of a Patent must be none the less a good objection in India as in England on general principles.<sup>75</sup>

In India moreover an objection based on prior grant may be understood to be provided for as a ground for opposition under 9 (1) (b); though the wording makes no reference to the existence of any Patent or to the necessity of any grant being actually made. It will be observed that the wording of 9(1)(b) is confined to what has been claimed: while that of 9 (1) (d) may extend to the whole of the contents of a prior specification. In an opposition under (9) (b) therefore it should be shown that the anticipation was contained in the claims alone of a specification which is relied on as being a prior grant without looking elsewhere in that Specification.

Where objection is taken to the validity of a Patent on the ground that the alleged invention described in it has been contained in a Specification of a previous Patent, and where that previous Specification has been published, the objection may be treated as an objection for want of novelty on the lines already fully discussed earlier in this chapter. It is where the previous specification has not been published prior to the grant of the subsequent Patent and yet the application for the previous Patent has or will have precedence over the application for the subsequent Patent, that there is no want of novelty properly speaking and yet there is room for an objection on the ground of "a prior grant".

It should be noted that the prior grant may be contained either in an Indian Specification pertaining to a Patent granted on an original Indian application or in an Indian Specification pertaining to a Patent granted on an Indian application which has been filed under the reciprocal arrangements. In the one case the grant in question dates from the filing of the original application: in the other the grant is antedated to the date of the corresponding United Kingdom or foreign Patent, which may mean that the grant is dated with a date which may be anything up to a whole year previous to the date when the Indian application is actually made. Accordingly

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<sup>75</sup> See Fletcher Moulton p. 76 citing *Crane v. Price* (1842) W. P. C. 412; Also Terrell p. 106; *Ex parte Bailey* (1872) 8. Ch. App Cas 60 at p. 63; *Pugh v. Riley Cycle Co. Ltd.* (1913) 30. R. P. C. 32 at p. 43 (1913) 30 R. P. C. 514 (C. A.) at p. 529; *Rowland & Kennedy v. The Air Council* (1925) 42. R. P. C. 433.

in cases where the prior grant is comprised in a Specification filed under the reciprocal arrangements the position is that such grant is actually not in existence at the time when the application to be objected to is filed. There is in such case no Indian Specification in existence which may be looked at as delimiting the prior grant.

In the United Kingdom this situation is met by a search being provided for to be made by the Comptroller at a date 12 months after the application : this search is regulated by Section 8 of the English Act.

In India there is no provision for any search being made by the Controller in regard to the possibility of an application for a Patent being barred by prior grant : either in cases where the bar would be contained in an Indian Specification pertaining to an original Indian application—when the Indian Specification comprising the prior grant would be in existence at the Indian Patent Office at the time of the application to be objected to—or in the other cases where the Indian Specification containing the prior grant may not come into existence until a date which may be at any date up to one year afterwards.

The result is that the Indian Patent office is not authorised under the Indian Act to afford to an applicant for an Indian Patent any assistance under the present system in the way of information as to the likelihood or otherwise of his application being found to be barred by reason of a prior grant. The applicant must as to this risk, rely on his own enquiries.

The question of the possibility of any objection on the ground of what is commonly referred to as “prior grant”, while it raises a question of novelty in a sense, that is to say whether the new grant if made will be new in the sense of being free from any prior grant, is totally distinct from the other considerations of novelty which have been discussed hitherto in this chapter. An objection to the validity of a patent on a ground of prior grant, such prior grant never having become public knowledge, is not properly speaking an objection on the ground of “want of novelty” in the sense in which that phrase is used in Patent Law : and is therefore to be treated as being a totally distinct objection.

It may be that the circumstances which afford grounds for an objection of prior grant will also afford grounds for an objection

that the Patentee or Applicant for Patent was not the true and first inventor.

## PART IV. UTILITY.

### Utility.

It is true that the Statute of Monopolies does not use any words expressly referring to the necessity of utility in an invention to be patented. Nevertheless the Courts have long since held that patents which are not useful are invalid. Such decisions are quite independent of any express provisions regarding utility in modern legislation : and are based presumably both, on the original principles of the Common Law and on the general scheme and intention of the Statute of Monopolies : which was to sanction only such monopolies as were for the good of the public and of the realm. The decisions appear mostly to have gone on this general ground, that a patent should not be granted for a thing which was adjudged prejudicial to the public ; and if granted should accordingly be held invalid.<sup>1</sup> Certain of the decisions have also gone on the other ground of misrepresentation : that is to say that the patentee has deceived the Crown in representing that his patent has advantages which it has not.<sup>2</sup> In the result the law has been absolutely clear that besides those attributes in connection with its subject matter which have been already discussed and besides the attribute of novelty, it is an essential attribute of a good patent that the invention to which it relates should be useful ; and that want of utility is a ground of invalidity.

**Useful : formerly meant "not prejudicial to the public."**

The proper plea used formerly was that the patent was "prejudicial". Recently in patent phraseology that expression is not much used, having been replaced by the use of the terms "want of utility" or "not useful". The latter term, it is submitted, is how-

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<sup>1</sup> See *Jupe v. Pratt* (1837) W. P. C. 145, 151 ; *Elias v. Grovesend Tinplate Co.* (1898) 7. R.P.C. 455, at p. 467 ; *Ward Brothers v. Hill* (1903) 20. R.P.C. 189, at p. 200 : *Wilson Brothers Bobbin Co. Ltd. v. Wilson & Co. (Barnsley) Ltd.* (1903) 20. R.P.C. 1, at p. 16.

<sup>2</sup> See *Price v. York Street Flex Spinning Co.* (1893) 10 R.P.C. 34, at p. 39 : and *Morgan v. Seaward* (1837) W.P.C. 187.

ever employed, when this question arises at all, in the same sense as the old term "prejudicial" in that it must mean "useful to the public" and not "useful to the patentee".

### Useful : modern special sense.

The term "utility" has now come to be employed with regard to Patents in a very special sense. The word utility might almost be substituted by the term "efficiency" or "workability". The question is whether the invention will work ; and will do what is claimed for it.<sup>3</sup> And if the invention is useful, or efficient, in that respect, it is immaterial whether it is or is not itself practically useful in a high degree.<sup>4</sup> It is immaterial whether the final product is or is not useful, provided the invention itself fulfils the test of utility in the way of efficiency.<sup>5</sup> It is similarly immaterial whether or not the final product is of commercial utility.<sup>6</sup> Or whether the final product is suitable for the purposes suggested.<sup>7</sup>

### Slight amount of utility.

It is well established that a very slight amount of utility in the older sense, of being useful to the public, is required in the invention itself to support a Patent.<sup>8</sup> (There appears to be some authority even for the proposition that it is immaterial, whether or not the final product is even at all beneficial to the public).<sup>9</sup>

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<sup>3</sup> See *Morgan v. Seacard* (1837) W.P.C. 187 : *Wilson v. Union Oil Mills* (1892) 9. R.P.C. 57 at p. 70 : *Fawcett v. Homan* (1896) 13. R.P.C. 398 at p. 405 (C.A.) : *Walseback Incandescent Gas Lighting Co. Ltd. v. New Incandescent (Sunlight Patent) Gas Lighting Co. Ltd.* (1900) 17. R.P.C. 237, 252.

<sup>4</sup> Provided it fulfils the other necessary tests of subject-matter and novelty also. See also : *Philpot v. Hanbury* (1885) 2. R.P.C. 33 at p. 37.

<sup>5</sup> See *Alsop's Patent* (1907) 24. R.P.C. 733 at p. 753. See also *Fletcher Moulton* at p. 80.

<sup>6</sup> *United Telephone Co. v. Bassano* (1886) 3. R.P.C. 311 at p. 313 : *Badische Anilin and Soda Fabrik v. Levinstein* (1887) 4. R.P.C. 449 (H.L.) at p. 462 : *Ehrlich v. Ihlee* (1888) 5. R.P.C. 437, 449 (C.A.) : *Edison & Swan v. Holland* (1889) 6. R.P.C. 243 (C.A.) at p. 233 : *Sunlight Incandescent Gas Co. v. Incandescent Gas Light Co.* (1897) 14. R.P.C. 757 at p. 775.

<sup>7</sup> See *Fletcher Moulton* p. 80.

<sup>8</sup> See *Otto v. Linford* (1882) 46. L.T. (N.S.) 35, at p. 41 : and the cases cited above.

<sup>9</sup> See *Fletcher Moulton* p. 80. Compare *Terrell* p. 107 et seq.

**Utility a question of fact.**

It is purely a question of fact whether any particular invention has or has not fulfilled the requirement of utility.<sup>10</sup>

**Test or tests of utility.**

Tests then for utility and the requisite degree thereof may be shortly stated to be one or all of the following :—

- (1) Has the invention any use as distinct from design ?
- (2) Will the invention work : and do what is claimed for it ?
- (3) Will the invention be sufficiently, even though slightly, useful to the public ?

From what has been already stated it is clear that for a good patent it is essential that the first and second tests must be complied with : it is submitted, (though from the trend of modern cases of this there may be said to be some doubt), that the third test is also to be complied with. In arriving at a decision on the question of utility, it will be assumed, since the Specification is addressed to a person competent in the art concerned, that the help of such a competent person is available to make the invention work.

As the question of utility depends on the particular facts of each case and as a very slight degree of utility is enough to sustain the validity of a Patent against an objection for want of utility, it is unnecessary here further to consider particular cases.

**A distinction between Patents & Designs :**

For an article to be suitable for registration as a design no utility is required. From the definition of the word “design” in Section 2(5) of the Indian Patents & Designs Act it is seen that the features of an article in themselves having utility cannot be registered as a design. That definition reads :—

““design” means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate, or combined, which in the finished article appeal to and are judged solely by the eye ; but does not include any mode or principle of construction or anything which is in substance a mere mechanical

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<sup>10</sup> See *Hill v. Thompson* 1. W.P.C. 235, 237 : *Cornish v. Keene* 1 W.P.C. 50, 506 : *Terrell* p. 107.

device, and does not include any trade mark as defined in Section 478, or property mark as defined in Section 479, of the Indian Penal Code". In practice when an inventor brings to a Patent Agent an article for which the inventor desires to obtain a monopoly, it becomes necessary to decide whether the article should be patented or registered as a design. The distinction may depend on the presence or absence of utility in the invented article. It is submitted therefore that it is convenient in connection with the formulation of any practical tests or utility in regard to a patentable invention not to overlook the necessity of an investigation whether the alleged invention has any use as distinct from design.

### **Connection between utility and sufficiency :**

As has been pointed out, the question of utility is in some cases hardly distinguishable from the question of insufficiency which is considered below.<sup>11</sup> But for the purpose of the effective investigation of the question of utility it has been pointed out that to avoid confusion of thought it should be assumed that the Patent in question has complied with the requirements of novelty and sufficiency.<sup>12</sup>

### **At what stages objections for want of utility may be raised in British India.**

As to objections for want of utility :—

(i) Before acceptance of the application for Patent :—

This objection cannot be raised at this stage.

(ii) In opposition proceedings before the Controller :—

This objection cannot be raised at this stage : want of utility not being among the grounds mentioned in Section 9.

(iii) On a petition to Court for revocation :—

This objection may be raised as a ground under the express provisions of Section 26(1)(e).

(iv) In an infringement suit as a defence :—

The position is the same as for a Petition to Court for revocation : by virtue of Section 29(2).

<sup>11</sup> See *Wilson Bros. Bobbin Co. Ltd. Wilson & Co. Ltd.* (1903) 20 R.P.C. 1. at p. 14 (H.L.) and Cf. *Vidal Dyes Syndicate v. Levinstein* (1912) 29. R.P.C. 245, at p 254. (C.A.)

<sup>12</sup> See *Philpot v. Hanbury* (1885) 2. R.P.C. 33. at p. 37.



### **Principles underlying all current Patent Legislation in the Act of 1911.**

It should be here emphasised that the principles relating to Subject Matter, Novelty & Utility which have been discussed in this chapter are such as spring from the inherent nature of a Patent and have their source in the Common Law and in the Statute of Monopolies; and arise independently of the modern legislation embodied in the Indian Patents & Designs Act of 1911; just as these same principles arise independently of the modern legislation embodied in England in the English Patents & Designs Act of 1907-1932. Owing to the peculiar nature of the Statute of Monopolies, in that it is merely a declaratory Act in which is set down the limits of the prerogative powers of the Crown in regard to monopolies, it might well be contended that no subsequent modern legislation of the legislature either in Parliament in England or in the Assembly in India could make any valid Patent Law which purported to be in derogation of or in disagreement with the provisions of the Statute of Monopolies. It might be argued that any such purported legislation would be *ultra vires* and of no effect: on the ground that the extent of the Crown's prerogative is not a matter for legislation. At any rate no such question arises. For neither the current Statute of 1932 in England nor the current Act of 1911 in India in any way runs counter to any of the broad principles relating to the validity of Patents to which reference has been made in this chapter. Both Acts are expressly framed (See section 79 of the Indian Act of 1911 and Section 97 of the English Act of 1932) in such a way as in no way to take away, abridge or prejudicially affect the prerogative of the Crown.

### **Other requisites for a good patent.**

What has been stated in this chapter will indicate, generally, what can and what cannot be made the material of a good patent. There are other limitations of a good patent also to be considered, which relate not so much to the inherent nature of the material of the invention; but to the manner in which the invention is described in the Specification, or to the circumstances in which the application in relation to the invention is made for the grant, or the manner in which the Patent is managed and worked after grant. If certain of these requirements are not fulfilled the same result

will follow : the Patent will not be a good Patent : either it will not be granted or if granted it may be held to be invalid or be revoked. These other requirements since they do not refer directly to the nature of the invention itself, are dealt with in the next chapter : they will be there considered under the separate heads of Insufficiency, True and first Inventor, and Fraud.

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## CHAPTER VII

### FURTHER REQUISITES OF A VALID PATENT IN REGARD TO THE APPLICATION AND SPECIFICATION— SUFFICIENCY IN THE SPECIFICATION— PATENTEE MUST BE THE TRUE AND FIRST INVENTOR— ABSENCE OF FRAUD

#### PART I.—INSUFFICIENCY

##### Sufficiency of description of the invention in the Specification.

It is proposed first in this chapter to examine the degree of sufficiency which is required for a valid patent in respect of the description of the invention necessary to be contained in the Specification.

##### Origin of the requirement.

The specification or description of the invention, to which a patent relates, was not required originally either by Common Law or by the Statute of Monopolies. The filing of a Specification has since been made compulsory by reference thereto in an express condition or proviso which is contained in the form of the Letters Patent itself ; the material passage in the Indian form of grant being the following :—

“And whereas he hath by and in his specification (of which a printed copy is hereunto annexed) particularly described and ascertained the nature of the invention and the manner in which the same is to be performed”.....

There appears to be no doubt however that the instruction of the public so that they might be in a position to pursue the manufacture or exercise of the invention after the patent had expired, has always been considered part of the motive or policy of the grant of a Patent. This may be appreciated from an investigation of the history of the steps which have from time to time been taken to ensure such a result.

### History of previous requirements.

The history of the development of the Specification and of the requirements as to the degree of sufficiency of description to be embodied therein is traced in some detail in Edmunds on Patents in Chapter VIII. The following short extract is of interest :—

“The instruction of the public in the manufacture or exercise of a patented invention has always been considered part of the motive or policy of the grant, and different means of attaining this object have been adopted at different stages in the history of patent law. The earliest practice, and that to which Lord Coke refers, was to insert in the grant a proviso requiring the inventor and his assignee to take apprentices during the last seven years of the term, and to teach them “the knowledge and mystery” of his invention.

There was, however, no obligation upon a patentee to define clearly the objects to which his patent extended, and the public at once were exposed to the danger of unconsciously infringing the privilege, and had no security for acquiring the invention on the expiration of the patent. The only indications to the public of the scope of the invention were the short recitals in the letters patent themselves.”

Even at that time however it appears to have been the law that if a patent had contained no such recital, even though there was at that time no express condition in the grant requiring a specification or description of the invention, such patent would have been absolutely void for want of consideration.<sup>1</sup>

The next stage of development is described by Edmunds also in the following passage :—

“The description of inventions, which were formerly contained in patents were, however, very meagre and unsatisfactory, and the practice being found inconvenient, it became the custom, near the end of the reign of Queen Anne, to insert a proviso into all patents, obliging the patentee within a given time after the date of his grant, to “particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed”, by an instrument under his hand and seal, called a “specification” and to enrol the said specification in the Court of Chancery. The authority by

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<sup>1</sup> See Edmunds p. 84 citing Hindmarch p. 151.

which this clause was introduced does not appear, and was not, at any rate, parliamentary. It was probably suggested by the Attorney or Solicitor-General of the day. According to Webster, the earliest patent containing the proviso for a specification was that granted 3rd October 1711, to John Nasmyth."

Hence the origin of the present Specification and the present requirements as to sufficiency of description therein.

**Previous objections, on the ground of foreign piracy, to the use of Specifications with full descriptions of invention.**

At various stages of the development of the system of enforcing some sort of detailed Specification, fears were raised that the use of such specifications were harmful, in that they allowed the dissemination of full information of British inventions abroad in foreign states. At one time this difficulty was overcome by Statutory directions to the effect that all specifications should be enclosed in a cover under the seal of the Lord Chancellor and lodged in the office of one of the Masters of Chancery to be nominated by the Lord Chancellor and were to be preserved by that Master. Elaborate provisions were made with a view to ensure that the specifications were only removed and opened on certain occasions and under certain circumstances and conditions; after which they were to be sealed up again with the Master and deposited as before.<sup>2</sup>

Applications used also to be made to dispense with the enrolment of specifications; for example on the ground that foreigners would obtain the invention. The risk of foreign piracy was not unnaturally much agitated.

But in the end the advantages of a system entailing the compulsory filing of specifications were considered to outweigh other disadvantages. An extract of a judgment of Lord Eldon in *Ex parte Koops*<sup>3</sup> refusing an application which was made for enrolment of a specification to be dispensed with, is of interest in this connection. He said:—

"As to the worth of the apprehension suggested, a man has nothing more to do than to pirate your invention in a single instance,

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<sup>2</sup> See Booth's Act, 1792, Geo. III c. 73.

<sup>3</sup> 1802, 6 Ves 595.

and he will then force you to bring an action and then the specification must be produced. But with regard to the King's subjects a very strong objection occurs, which makes it necessary that the specification should be capable of being produced. They have a right to apply to the Patent Office to see the specification, that they may not throw away their time and labour, perhaps at a great expense, upon an invention upon which the patentee might afterwards come with his specification, alleging an infringement of his patent, when, if those persons had seen the specification, they never would have engaged in their project. The enrolment is, therefore, for the benefit of the public."<sup>4</sup>

The objections against foreign piracy of inventions is under current legislation to some extent met, in regard to certain special patents, such in particular as those relating to military or naval matters, by certain special provisions which allow of specifications for such inventions not to be made public. Apart from this exceptional class of cases, it is now and has been for many years obligatory on an applicant for patent to comply with requirements demanding a high degree of sufficiency in his specification in regard to the description of his invention therein contained.

#### **Sufficiency of description of the invention now demanded by Section 4 of the Act of 1911.**

Certain express directions are now contained in the Indian Patents and Designs Act of 1911 making it obligatory for an applicant for a Patent to file a Specification ; and also making it obligatory upon him to state certain matters therein. Reference in particular may be made to Section 4 of the Act.

#### **General principles evolved from judicial decisions are in practice required to supplement the provisions of the Act.**

Since however the Act is not framed in such detail in this respect, as to afford by itself a complete view of the nature of what is in practice found to be required to be stated in the Specification, it will be convenient here to give certain general explanations ; and to make certain general observations concerning the Sufficiency of description, which has in accordance with the principles long since

<sup>4</sup> See Edmunds p. 86.

laid down in the case law, been required in a Specification for a valid Patent.

This is an instance where the real effect of current Patent Law can only be ascertained not from the Act alone but from the Act and the judicial discussions and decisions read as a supplement to the Act.

**Sufficiency of description is required in three different respects :—**

What is required of the applicant for Patent is, in the current wording of Section 4 of the Act of 1911, that in the Specification he :—

“must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.”

also :—

“the specification must end with a distinct statement of the invention claimed.”

Furthermore the applicant for Patent has always been required to show the utmost good faith ; and accordingly it has long been decided that he must not only describe his invention sufficiently to disclose properly a way of achieving his result but he must also go further and disclose the best way known to him of doing so.

Accordingly it will be found that sufficiency of description is required in the Specification in three quite different spheres :—

1. The limits or ambit of the invention must be sufficiently clearly described ; so that the public may know (particularly during the currency of the patent) what is monopolised and what is not.

2. The nature of the invention and the means of making or effecting it must be sufficiently described : so that the public may know (particularly after the expiry of the patent) how to achieve the results which comprise the new invention.

3. The best of such means known to the Applicant must be sufficiently clearly described : so that the public may not (particularly after the expiry of the patent) be cheated, by being left as it were with a mere empty husk of an invention, while the patentee keeps the kernel of the invention to himself.

The second of the above heads is sometimes found alone

referred to under the topic of "Sufficiency": presumably because this relates to that amount of description which is the minimum sufficient for making the invention at all. But if the Specification fails in respect of the requisite degree of particularity in the matters falling under any one of these three heads, the Patent will be bad for insufficiency. Therefore the term "Sufficiency" or "Insufficiency" must be taken when used in a wide sense to relate to the degree of particularity of description required under all three heads.

**Insufficiency in description of the ambit of the invention: "ambiguity": (sphere No. 1 above)**

There is a clear-cut distinction between the kind of insufficiency which falls within the first of the three categories above-mentioned and that which falls in the last two categories.

In some cases a convenient mode of indicating this distinction has been put into use, when speaking of insufficiency in general, by using the term "ambiguity" rather than "insufficiency" in relation to the first head and retaining the term "insufficiency" proper for matters in relation to the second and third heads. This distinction, using the term ambiguity as confined to the first head above was stated by Lord Hanworth in a recent case, *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.*<sup>5</sup> citing with approval a passage used by Luxmoore J. in the court of first instance, as follows:—

"As he rightly points out; "Insufficiency is directed to the issue whether the description is sufficient to enable those persons to whom the specification is addressed to understand how the subject matter of the patent, if it is an article to be manufactured, has to be made, or if it is a process or method, how it is to be worked. Ambiguity is directed to the issue whether the invention is sufficiently described and ascertained so as to enable the public to understand the scope of the monopoly granted by the Letters Patent." That appears to me to be a useful statement, when one is embarking upon the matters and the evidence to which our attention has been directed."

The remarks here immediately following are confined to the kind of insufficiency which falls under the first of the three heads; being that which was referred to by Lord Hanworth M. R. in the case last mentioned as "ambiguity".

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<sup>5</sup>(1935) 53. R. P. O. at p. 236.



**Importance of sufficiency, under this head, in description of the ambit of the invention.**

There are strong reasons why ambiguity of this sort is not to be permitted in the Specification of a Patent. These were concisely alluded to by Romer L. J. in a passage <sup>6</sup> in the same case.

"Another essential to the validity of the Patent is that the complete specification should sufficiently and clearly ascertain the scope of the monopoly claimed. The reason for that is in order that those who are engaged in the art may know how far they can go without running the risk of having an action for infringement of the patent started against them by the patentee. If the complete specification does not clearly indicate the ambit of the invention, it will redound, to use the words of Section 6 of the Statute of Monopolies, "to the hurt of trade, and be generally inconvenient." One might put it a great deal more strongly—the patent will be a public nuisance, hindering and embarrassing those persons engaged in the particular art, from carrying on their legitimate trade or business."

**As to distinguishing new from old : the former practice distinguished.**

This is a matter upon which there appears to have been some confusion or conflict of view in the decided cases. In the older cases there appears to be authority for the proposition that it should be expressly stated in the Specification in reference to the various things therein mentioned, which of them are old and which new. In the more recent cases however it has been very definitely laid down that no such express statements are required : provided it is made clear from the Specification read as a whole what are the limits of the ambit of the invention—that is to say the new invention—claimed.

In the older cases an objection on the ground of insufficiency was often pleaded in the words that "the Specification did not sufficiently distinguish what was new from what was old." In construing such older cases a rule of construction used to be applied whereby anything described in the Specification which was not expressly stated to be old was considered to be intended to be

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<sup>6</sup> At p. 243.

referred to as new : that is to say as part of the claim comprising the new invention. Now since the adoption of the modern system of claiming clauses no such rule of construction is applied to the reading of a specification. Accordingly in the absence of such rule of construction it is no longer necessary to retain the practice of labelling each item in a specification with separate labels "old" or "new" attached to each which was a necessity to meet that old rule of construction.

A definite change in this respect appears to have been effected from the time of the judgment in *Harrison v. Anderston Foundry Co.*<sup>1</sup>

The judgment of the House of Lords in that case was to the following effect :—

"But the specification may fail in some other essential respect, and so it is said to have done by the First Division of the Court of Session. That Court held that the specification was bad, not because it was ambiguous, or uncertain, or unintelligible, but, according to what was said by the Lord President, because there was no discovery or explanation of the novelty of the invention. "No doubt" (his Lordship said) "a new combination of old parts to produce a new result, or produce a known result in a more useful and beneficial way, may be a good subject-matter of a patent, but only under the conditions that the combination shall be claimed as a combination, and be so described as to shew intelligibly what is the novelty, and what the merits of the invention." Lord Gifford, following the same course of reasoning, said : "The patentees have failed to tell the public what they truly claim as their invention. They should have said what they claimed and what they disclaimed. They should tell us what is new, and if they claim too much the patent goes. With great submission the claim of a combination or arrangement of parts of a machine without more, is in itself a sufficient description of a novel invention i.e. of a combination of parts which have never been combined in the same manner before. The explanation of the novelty is to be found in the description of the arrangement of the parts in the body of the specification. Whether the

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<sup>1</sup> (1876) L. R. 1 A. C. 574.

combination claimed is new or not is a question of fact to be proved on a trial. Where a claim is clearly and distinctly made, there can be no necessity for a patentee to distinguish between what is claimed and what is disclaimed. It is enough to say in answer to Lord Gifford's suggestion that everything which is not claimed is disclaimed. It may be necessary for a patentee sometimes not to disclaim in his specification, but to state what he does not claim. Where, for instance it may not be possible to explain his improvements of a machine without describing other closely connected parts of it which are not patented, it may then be proper and certainly prudent for him to state that he does not claim these as parts of his invention and to add a distinct description and limitation of his claim. The opinions of the Judges of the Court of Session were, in the argument, maintained on the authority of Lord Westbury in *Foxwell v. Bostock* <sup>a</sup> and certainly the observations of that noble and learned lord closely resemble those which I have mentioned of the Lord President and of Lord Gifford. In the case cited, Lord Westbury said, "The term 'combination of machinery' which has of late been a favourite form of words with patentees, is nothing but an extended expression of the word 'machine.' It is the word 'machine' writ large, and as a patent for an improved machine in the specification of which the improvement is not particularly stated and described, would hardly be attempted to be supported, so neither in my judgment can the patent for an improved arrangement or combination be supported in the specification of which there is nothing to distinguish the new from the old."<sup>8</sup> It cannot be doubted that in a patent for an improved arrangement or combination of machinery "the specification must" (as Lord Westbury said in *Foxwell v. Bostock*) "describe the improvement and define the novelty otherwise and in a more specific form than by the general description of the entire machine." But it is clear that if the claim is for a combination of particular parts of the machine and for that only, the differentia (to use Lord Westbury's expression) is sufficiently assigned. And as it is admitted that there may be a good patent for a new combination of parts, all of which or a portion of which are severally old, upon what principle can a patentee claiming

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<sup>a</sup> 4 De. G. J. and S. 13.

a combination be required to distinguish the new and the old parts each other ?" <sup>9</sup>

It is no doubt this changed practice which was intended to be referred to when Fletcher Moulton L. J. made the oftquoted observation <sup>10</sup> that :—

"The patentee must distinguish what is new from what is old by his claim : he need not distinguish what is new from what is old in his claim."

As to distinguishing new from old : present practice and requirements.

Even at the present day it is as true as it was before, that :—

"Every party is bound to tell the public clearly by his specification what he claims and what they may do or not do without risk of an action for infringing the patent." <sup>11</sup> It is essential that it is made clear of what elements that, for which the monopoly is claimed, consists and the nature thereof ; but if that is done that is enough. The result is that an objection for insufficiency alone on the ground that the limits of the ambit of the invention are not sufficiently described, should but rarely be successful.

There will nevertheless still be cases where the claim is unintelligible or ambiguous : i.e. where it is not possible from the specification to understand clearly what is claimed as the monopolised invention and what is not. In such cases <sup>12</sup> an objection of insufficiency on the ground now under discussion will succeed : as clearly appears from the case next mentioned.

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<sup>9</sup> That case has been followed in the following cases : *Moore v. Bennett* 1 R. P. C. 129, 153 (H. L.) *Proctor v. Bennis*, 4 R. P. C. 363, (C.A.) ; *Perry v. La Societe de Lunetiers*, 13 R. P. C. 661 ; *Hookham v. Johnson*, 14 R. P. C. 525, 558 ; *Patent Exploitation Co. v. Siemens Brothers & Co. Ltd.*, 21 R. P. C. 541, (H. L.) ; *British United Shoe Machinery v. Thompson*, 22 R. P. C. 177 ; *British United Shoe Machinery v. Fussell*, 25 R. P. C. 631, (C. A.) ; *Lynch v. Philips*, 26 R. P. C. 389, I. H. ; *International Harvester Co. v. Peacock*, 25 R. P. C. 763.

<sup>10</sup> In *British United Shoe Machinery v. Fussell* (1908) 25 R. P. C. 631 at p. 651.

<sup>11</sup> See *Gibson v. Brand* (1842) 1 Web. P. C. 640.

<sup>12</sup> See *Glover & Co. Ltd. v. American Steel & Wire Co.* (1902) 19 R. P. C. 109 ; *Tubes Ltd. v. Perfecta Seamless Steel Tube Co. Ltd.* (1903) 20 R. P. C. 77 at p. 101 (Lord Davey) ; *British Ore Concentration Syndicate Ltd. v. Minerals Separation Ltd.* (1910) 27 R. P. C. 33 (H. L.) at p. 47 (Lord Halsbury) ; *Linotype & Machinery Ltd. v. Hopkins* (1910) 27 R. P. C. 109 (H. L.) at p. 112 (Lord Loreburn) ; *British Vacuum Cleaner Co. Ltd. v. L. S. W. R. Co.* (1912) 29 R. P. C. 309 at p. 320 (Lord Loreburn).

### Degree of particularity required in description of the ambit of the invention,

A recent case in which the Patent was held invalid solely on the ground of ambiguity in the Specification was the infringement suit of *R. W. Crabtree & Sons Ltd. v. R. Hoe & Co. Ltd.*<sup>13</sup> In that case the point was fully discussed and certain observations made by Mr. Justice Bennett in emphatic language as to the duty of patentees and persons drafting Specifications, to use the clearest possible language in describing the ambit of the invention : that is the scope of the monopoly claimed. The material observations were as follows :—

“The Defendants here contend by way of defence that the Complete Specification of the Patent in suit does not sufficiently or clearly ascertain the scope of the monopoly claimed. In the case of the *Natural Colour Kinematograph Co. Lt. v. Bioschemes Lt.* reported in 32 Reports of Patent Cases, Lord Loreburn is reported at line 16 of page 266 as having used the following language : “There seems to be some danger of the well known rule of law against ambiguity being in practice invaded. Some of those who draft specifications and claims are apt to treat this industry as a trial of skill in which the object is to make the claim very wide upon one interpretation of it, in order to prevent as many people as possible from competing with the patentee’s business and then to rely upon carefully prepared sentences in the specification which it is hoped, will be just enough to limit the claim within safe dimensions if it is attacked in Court. This leads to litigation as to the construction of specifications, which could generally be avoided if at the outset a sincere attempt were made to state exactly what was meant in plain language. The fear of a costly law suit is apt to deter any but wealthy competitors from contesting a patent. That is all wrong. It is an abuse which a Court can prevent, whether a charge of ambiguity is or is not raised on the pleadings, because it affects the public by practically enlarging the monopoly and does so by a kind of pressure which is very objectionable. It is the duty of a patentee to state clearly and distinctly, either in direct words or by clear and distinct reference, the nature and limits of what he claims. If he uses language which, when fairly read, is avoidably obscure or ambiguous, the patent is

<sup>13</sup> (1935) 52. R. P. C. 367 at p. 380 to 382 (Bennett J).

invalid, whether the defect be due to design or to carelessness, or to want of skill. Where the invention is difficult to explain, due allowance will, of course, be made for any resulting difficulty in the language. But nothing can excuse the use of ambiguous language when simple language can easily be employed, and the only safe way is for the patentee to do his best to be clear and intelligible. It is necessary to emphasise this warning." In the same case Lord Parker of Waddington is reported at line 46 on page 268 of the report as having used the following language: "My Lords, I have said enough to dispose of this appeal, but in view of what has just been said by my noble and learned friend Lord Loreburn I should like to add this. Patents are granted by the Crown in consideration of the disclosure of some invention likely to benefit the public and on the representation that such disclosure is made by the complete specification. In preparing the complete specification, therefore the applicant for a patent must observe the utmost good faith. The intentional introduction of an ambiguity for the purpose of misleading the public or of embarrassing them in the exercise of their Common Law right to trade in such manner as they think best, would be alone sufficient to avoid the patent, and in a case reasonably capable of unambiguous statement the want of good faith may be gathered from the terms of the specification itself. In such a case I apprehend that the Court might on its own initiative, declare the patent to be invalid. Further, though it may be true that in construing the instrument inter parties the Court is bound to make up its mind as to the true meaning, this is far from being the case with a specification. It is open to the Court to conclude that the terms of a specification are so ambiguous that its proper construction must always remain a matter of doubt and in such a case, even if the specification had been prepared in perfect good faith, the duty of the Court would be to declare the patent void. Once again, though the Court may consider that the meaning of the specification is reasonably clear, yet if the specification contains statements calculated to mislead the persons to whom it is addressed, and render it difficult for them without trial and experiment to comprehend in what manner the patentee intends his invention to be performed, these statements may avoid the patent. The above principles may be thought to bear somewhat hardly on patentees and their agents. A person may arrive at a valuable invention without adequately comprehending the particular point

in which the invention is new or valuable and a patent agent may be insufficiently instructed by his principal, and, however carefully he may consider the terms of the specification he is employed to draw, he may quite easily fail to anticipate the points which may be raised, if and when the validity of the patent comes in issue. The Court however, will always make due allowance for the difficulties of the case, and will not impute mala fides without strong reason, or be astute to deprive a patentee of the benefit of a valuable invention, either because of his imperfect acquaintance with the art or because of the carelessness or want of skill of his agent. In the case of the present Specification, I can see no difficulty in the way of the Patentee making it clear what he claimed. If his claim was to a monopoly for all mechanical contrivances for preventing the fudge box cylinders being brought into printing contact with the impression cylinder until they were running at the correct speed and in register in the peripheral direction with the impression cylinder and for preventing the disconnection of the mechanism driving the fudge box cylinders whilst they were in contact with the impression cylinder, it would have been possible to have made that claim in plain and simple language. If his claim was limited to the narrow claim for a monopoly in the particular interlocking mechanism described and illustrated, nothing I think, could have been simpler than to say so. But in this case, whether it has been done deliberately or not I do not pause to consider, the Specification is so phrased as to enable the Patentee to contend for either view, and my duty is, on that ground, to hold the Patent void, and to dismiss the action with costs." <sup>14</sup>

**The Ambit may appear from Claiming Clauses or from these read with the rest of the specification.**

It is common for the ambit of the invention to be made clearly apparent from the Claiming Clauses alone. It is the well known common practice to have claiming clauses at the end of a specification. Moreover Rule 13(1) provides that the specification shall terminate with a clear and succinct statement of the invention claimed, distinct from the body of the Specification. These claiming

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<sup>14</sup> (See also *Natural Colour Kinematograph Co. Ltd. v. Bioschemes Ltd.* (1915) 32 R. P. O. 256 at p. 266 at p. 268. See also Terrell (8th edn.) p. 122 et seq.

clauses or "claims" as they are commonly called are usually drafted with the direct object of defining the limits of the invention and of the monopoly claimed. But as the Specification is to be read as a whole, it is not necessary that the claiming clauses should be entirely or solely self-contained.<sup>15</sup>

#### As to the Drawings.

It has been held that ordinarily the Drawings alone cannot define the limits of the ambit of an invention.<sup>16</sup>

But in the case of an invention consisting only of an improvement, semble, the ambit may be made to appear from the drawings alone.<sup>17</sup>

#### Where the invention claimed is for an improvement.

It is as necessary as ever that it should be made clear in what the improvement consists. The decision in *Williams v. Brodie*,<sup>18</sup> the earliest authority for this proposition is still it is submitted, good law.

In that case the invention consisted of an arrangement of inserting a pipe into an old stove for carrying the air into the stove, but the specification embraced the whole apparatus; and the patent was held void.

This is a good example showing how insufficiency and want of novelty overlap in practice. For it would have been equally true to say that the Patent was void for want of novelty as for insufficiency: if that which was claimed was taken to be clear (the whole stove) then it was not new.

#### Where the invention claimed is for a combination.

Where the invention claimed is for a combination it is not necessary to explain which parts of such combination are new.

<sup>15</sup>. See *Fletcher Moulton* at p. 57: *Thorston Nordenfelt v. Gardner* (1884) 1 R. P. C. 61. (C.A.) at p. 69: *Thomas v. Welch* (1866) L. R. 1 C. P. 193: *Parkes v. Stevens* (1869) L. R. 8 Eq 358: *Vickers, Sons & Co. Ltd. v. Siddel* (1898) 7 R. P. C. 292 (H. L.) at p. 303, 306: *Tubes Ltd. v. Perfecta Seamless Steel Tube Co. Ltd.* (1903) 20 R. P. C. 77 (H.L.).

<sup>16</sup> See *Robertson v. Purdey* (1907) 24 R. P. C. 273 at p. 297.

<sup>17</sup> See *George Hattersley & Sons Ltd. v. George Hodgson Ltd.* (1906) 23 R. P. C. 192 (H. L.);

<sup>18</sup> Before 1785. See 1 Web. P. C. 75: and see *Edmunds* at p. 115.



As it was put in argument in *Kaye v. Chubb & Sons Ltd.* by Lord Watson :—<sup>19</sup>

“If you claim a combination, you need not say which of the parts are old.”<sup>20</sup>

**Insufficiency of directions :** (spheres Nos. 2 & 3 above).

Insufficiency of the other kind, that is to say insufficiency of directions how the invention is to be put into effect or performed or carried out may now be considered. The degree of the particularity required was shortly stated by Romer L. J. in *No Fume Ltd. v. Frank Pitchford & Co. Ltd.* (supra) as follows :—

“Let me deal with the question of sufficiency first. Be it observed from the very words I have used, that the Patentee fulfils his duty if in his complete specification he describes and ascertains the nature of the invention, and the manner in which the invention is to be performed, sufficiently and fairly. It is not necessary that he should describe in his specification the manner in which the invention is to be performed, with that wealth of detail with which the specification of the manufacturer of something is usually put before the workman who is engaged to manufacture it.”

**Rules of the construction of the specification.**

What may be sufficient directions to enable an expert to comprehend an invention and to enable him to make the requisite article or to put into practice the requisite process, as the case may be, may be insufficient for a person less skilled in the art. Therefore it is a matter of some importance when a particular specification is in question for alleged insufficiency, to postulate what degree of skill is to be imputed to the person who is to be taken to be the addressee of the specification. Then again a given specification may contain certain omissions in the directions contained in it, it may be as to dimensions or proportions or other details, which a person being given the specification for the purpose of making the requisite invented article or putting into practice the invented process, may be capable himself of making good. Before deciding whether that particular specification is bad or not for insufficiency it will then become necessary to postulate how far it is to be considered reasonable that

<sup>19</sup> 4 R. P. C. 23 ; 4 R. P. C. 289 (C. A.) ; 5 R. P. C. 641 (H. L.)

<sup>20</sup> (1888) 5 R. P. C. at 649 : and see Edmunds at p. 118.

the addressee may by trial and error himself make good what has been omitted in the directions contained in the Specification. Certain principles to be applied in construing a Patent Specification as to both these points have been laid down in the decisions of reported cases. The effect of these principles is noted under the next following sections.

**Degree of skill to be imputed to the addressee.**

It has been held that the person to whom the specification is supposed to be addressed should be taken to be one competently skilled in the art or trade to which the Patent relates.

The point was fully considered together with the effect of previous cases in *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.*<sup>21</sup> where among other passages to the same effect, the test originally stated by Lord Kinnear was cited by Lord Hanworth M. R. with approval in this passage :—

“I then come to the case of *Watson Laidlaw & Co. Ltd. v. Pott, Cassels and Williamson* (1911) 28. R. P. C. 565. Lord Kinnear deals with the matter at page 578, his judgment being one which was approved in a later case by the House of Lords :<sup>22</sup> “It comes back therefore, in my opinion, really to the original question : Has he done enough to show to a well-informed and properly skilled workman what the thing patented is which he is required to construct ?”

In the same case the observations of Jessel M. R. in *Otto v. Linford*<sup>23</sup> were also cited with approval :—

“That was a case relating to the Otto gas engine ; and it had been alleged, among other things, that the patent was void for insufficiency, inasmuch as the specification did not show the proportions in which the air was to be put in as regards the combustible mixture. Sir George Jessel said this, on page 41 : “The first thing to be remembered, in specifications of patents, is that they are addressed to those who know something about the matter. A specification for improvements in gasmotor engines is addressed

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<sup>21</sup> (1935) 52. R.P.C. 231 at p. 240.

<sup>22</sup> (i. e. *British Thomson-Houston Co. Ltd. v. Corona Lamp Works Ltd.* (1922) 39. R. P. C. 49).

<sup>23</sup> (1882) 46. Law Times N. S. 35.

to gasmotor engine-makers and workers, not to the public outside. Consequently you do not require the same amount of minute information that you would in the case of a totally new invention, applicable to a totally new kind of manufacture."

If the Patent relates to more than one art then it may be taken to be addressed in respect of different parts of the Specification to different persons. As it was put by Lord Parker in *Osram Lamp Works Ltd. v. Pope's Electric Lamp Co.* <sup>24</sup>

"Both in interpreting and in considering the sufficiency of a Specification the court is concerned, not with what the patentee meant by the words he used, but with what those to whom the Specification is addressed would, at the date of the Patent, have understood him to mean. It follows, that where questions of interpretation or sufficiency arise, the Court must ascertain the persons to whom the Specification is addressed, and, when the Specification deals with technical matters, must instruct itself as to the technical knowledge which those persons may reasonably be supposed to have possessed at the date of the Patent. A patentee must, in his Specification, describe and ascertain not only the nature of his invention, but also the manner in which the same is to be performed. A Specification may therefore be considered as addressed, at any rate primarily, to the persons who would, in normal course, have to act on the directions given for the performance. These persons may be assumed to possess not only a reasonable amount of common sense, but also a competent knowledge of the art or arts which have to be called into play in carrying the patentee's directions into effect. I say art or arts because in carrying out the directions given by the patentee it may well be necessary to call in aid more than one art. Some of the directions contained in a Specification may have to be carried out by skilled mechanics, others by competent chemists. In such a case, the mechanic and chemist must be assumed to co-operate for the purpose in view, each making good any deficiency in the other's technical equipment. The Specification cannot be considered insufficient merely because the mechanic without the aid of the chemist, or the chemist without the aid of the mechanic would be unable to comprehend the meaning of or to carry into effect the directions given by the patentee."

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<sup>24</sup> (1917) 34. R. P. C. 369 (H. L.) at p. 391.

**Regarding trial and error.**

On the one hand it should be noted that a Specification which is so lacking in the directions given in it that in order to make the requisite product or to carry out the requisite process as the case may be, the addressee is compelled to use further invention of his own, when otherwise he cannot attain the end in view, will be bad for insufficiency.

On the other hand in some instances the addressee may be reasonably expected to have to make some tests in the way of trial and error, though not in the way of invention, before achieving a final result. And in such cases if by reason of certain omissions of details in the Specification some room is left for such tests for trial and error, the Specification is not necessarily bad for that reason.

How far each of these somewhat opposite principles of construction may be applied and their inter-action was considered in the recent case of *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.*<sup>25</sup> in which previous cases were also reviewed. The principle that there must not be the need for any exercise of the inventive faculty by the addressee was emphasised in all the judgments in the Appeal Court. In particular Romer L. J. (after the observations already cited above) said this :—

“Specifications very frequently contain mistakes ; they also have omissions. But if a man skilled in the art can easily rectify the mistakes and can readily supply the omissions, the patent will not be held to be invalid. The test to be applied for the purpose of ascertaining whether a man skilled in the art can readily correct the mistakes or readily supply the omissions, has been stated to be this : Can he rectify the mistakes and supply the omissions without the exercise of any inventive faculty ? If he can, then the description of the specification is sufficient. If he cannot, the Patent will be void for insufficiency. That principle was laid down—I do not know whether for the first time or not in a reported case—in the case of *The King v. Arkwright*, reported in the first volume of Webster’s Patent Cases, p. 64. There Mr. Justice Buller, in summing up to the Jury, said this : “It has been truly said by the counsel, that if the specification be such that mechanical men of

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<sup>25</sup> (1935) 52. R. P. O. 231.

common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that the mechanics may be able to make the machine by following the directions of the specification, without any new inventions or additions of their own." It is plain I think, that by the word "additions" the learned Judge meant inventive additions. That principle has been applied in numerous cases, to which Mr. Whitehead called our attention in his opening; and to which the Master of the Rolls has already referred."

As to trial and error the following observations were made by Maugham L. J. in the same case <sup>26</sup> :—

"I think it emerges from the *Watson, Laidlaw* Case and the *Half-Watt Lamp* Case, that a specification is not bad because, after explaining the nature of the invention and the necessary main condition for carrying it into effect, the patent leaves out some of the further conditions, for example, dimensions, temperatures, quantities or materials involved, being things which necessarily vary with different applications of the invention, to be determined by actual trial and error. Such trial and error can no doubt be described in popular language as further experiments: but they are not experiments—this has already been pointed out by Lord Justice Romer—that involve invention in any true sense. If further inventive steps are necessary the specification would, I think, be bad. The provisoes to that proposition may be repeated for clearness. The inventor must disclose the best conditions of which he knows; and secondly, as I have already said, no experiment involving new invention must be necessary, and everything that is left open must be ascertainable by an ordinary skilled workman by mere trial and error." <sup>27</sup>

#### Sufficiency in description of best method.

The principle that the specification must contain with proper particularity a description of the best method known to the Applicant for Patent at the time of making the application has been confirmed in many cases.

<sup>26</sup> (1935) 52. R. P. C. 231 at p. 250.

<sup>27</sup> See also *Edison & Swan Electric Company v. Holland* (1897) 6. R. P. C. 243. at p. 277 and p. 280; also Terrell (8th edn.) p. 139 et seq.

In *British Dynamite Co. v. Krebs*,<sup>28</sup> it was assumed in the House of Lords to be the law that "the inventor was bound to give.....the best means at his disposal in order to achieve the result." The only question which there arose was whether he had done so or not; and it was held that as the inventor, Baron Noble, had only discovered a certain silicious earth called "Kieselguhr" afterwards, his specification was not objectionable for not containing specific mention of it as being the best material for his dynamite.

The principle was more recently confirmed in *Franc Strohmenger & Cowan Inc. v. Peter Robinson*.<sup>29</sup> The point arose in connection with an application to amend the defence by adding a plea of an objection that the Patentee had not disclosed in his Specification the best method of making the invention known to him. The point was dealt with by Maugham J. in these words:—

"It is suggested that Mr. Langsdorf, the patentee (and the statement is made from the evidence which he himself gave in the box) deliberately omitted to describe the best material known to him for the lining of his patented tie. Now it is perfectly manifest that a patentee is under an obligation to disclose the best method known to him at the date of the complete specification of carrying out the invention, and it is true that, if he omits to do so, the patent is invalid, because the way in which it is generally stated is that the Crown in such a case has been deceived in the grant."

(The learned Judge then went on to consider whether the point could be taken, not having been pleaded; and decided the point was not an issue in that case).

The principle that the patentee is bound to give the best information known to him at the date of the Patent was also confirmed in the recent case of *No-Fume Ltd. v. Frank Pitchford & Co Ltd.*<sup>30</sup>

#### **Insufficiency : how far a question of fact.**

The decision of the question of insufficiency is clearly depen-

<sup>28</sup> (1896) 13. R. P. C. 190 (H. L.) at p. 195.

<sup>29</sup> (1930) 47. R. P. C. 493 at p. 501. (Of also the argument at p. 497).

<sup>30</sup> (1935) 52. R. P. C. 231 (C. A.) at p. 248 (line 42.) in the Court of Appeal. See also Terrell (8th edn) p. 146 et seq; quoting at p. 147 Coleridge J. in *Heath v. Unwin* 2. W. P. C. 236 at p. 243.

dent in many cases on a construction of the Specification. Such questions of construction are finally, as are all questions of the construction of any documents, a question of law for the Court. Thus most of the question of sufficiency so far as it is confined to sufficiency as to the ambit of the invention will ordinarily be a question of law. On the other hand the question of sufficiency in directions as to the means of producing the invention and as to the best means of doing this will largely, if not entirely, be a question of fact ; as to matters of a technical nature ; as to the state of knowledge among persons in the trade to whom the specification may be deemed to be addressed ; and as to whether or not such persons ordinarily skilled in the art in question would in fact be enabled by the description in the Specification to produce the invented result. Evidence will be received on these points. Indeed it is common for the evidence of witnesses to be tendered to prove that the invented result has in fact been achieved from the description in the Specification.<sup>31</sup>

**At what stages objections for insufficiency may be raised in British India.**

(i) Before acceptance of the application :

This is one of the principal topics to which the Patent Office directs its attention when making its examination before accepting any application for Patent. The objection may be raised by the Patent Office at this stage under the express provisions of Section 5 (1) (a), 5 (1) (c) and 5 (1) (d) ; possibly Section 5 (1) (b) may also cover questions of insufficiency.

(ii) In opposition proceedings before the Controller :—

An opposer is entitled to raise objections of insufficiency at this stage under the clear provisions of Section 9(1)(c), which are as follows :—

(on the ground) "that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the specification."

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<sup>31</sup> See *Shaw v. Jones* (1897) 6. R. P. C. 328 and *Fletcher Moulton* at p. 100. Also *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.* (1935) 52. R. P. C. 231 (C. A.) at p. 245 l. 23. Insufficiency in directions for disclosure of the best method known to the patentee was clearly shown to be a question of fact in *Franc-Strohmeier and Cowan Inc v. Peter Robinson* (1930) 47. R. P. C. 493 at p. 502 (Maugham F):

## (iii) On a petition to Court for revocation :—

The Petitioner is entitled to raise objections of insufficiency at this stage but only under the restricted conditions of a case which can be brought under Section 26(1)(g). It is to be noted that the wording of that section relating to revocation proceedings after grant differs considerably from the wording of Section 9(1)(c) which relates only to opposition proceedings before grant. Section 26(1)(g) gives the ground on which a Petitioner may obtain revocation of a Patent after grant as follows :—

“that the whole or a part of the invention or the manner in which the whole or a part is to be made and used as described in the original or any amended specification is not thereby sufficiently described and that this insufficiency was fraudulent or is injurious to the public.”

The result is that on such a Petition it is essential, it is submitted, for the Petitioner to make out a case of fraud or of injury to the public in relation to the insufficiency of which he complains.

In this respect the Indian Act differs materially from the English Acts 1907-1932. Under Section 25(2)(h), Section 25(2)(i) and Section 25(2)(j) of the English Act each of the three different forms of insufficiency already referred to in the present chapter is made a sufficient ground in itself (irrespective of fraud or anything else) upon which to obtain revocation of a Patent in the United Kingdom. As a matter of comparison and contrast (for reference when reading the reports of current English cases on this point) the wording of those three subsections may be noted : it is as follows :—

“25(2)(h) that the complete specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed ;

25(2)(i) that the complete specification does not sufficiently and clearly ascertain the scope of the monopoly claimed ;

25(2)(j) that the complete specification does not disclose the best method of performance of the invention known



to the applicant for the patent at the time when the specification was left at the Patent Office.”<sup>32</sup>

(iv) In an infringement suit as a defence :—

The position is the same for a defendant in such a suit as for a Petitioner on a Petition for revocation : by virtue of Section 29(2).

## PART II.—THE OBJECTION THAT THE APPLICANT FOR THE PATENT IS NOT THE TRUE AND FIRST INVENTOR.

### True and First Inventor.

Having considered in the preceding paragraphs of this chapter that requisite of a valid patent under the head of Sufficiency which relates to the Specification and the degree of clarity of description requisite to be used therein, it is proposed next to consider a different requisite, which also may be discussed in connection with the circumstances in which the Patent was granted : that is to say the topic commonly indicated under the head of “the True and First Inventor.”

### The nature and origin of this requirement.

Formerly it was common to plead when attacking a Patent that “the applicant for patent (or the patentee if after grant) was not the true and first inventor.” This plea was originally used as a means of pleading want of novelty : the words being used primarily in the sense that the invention was not new, since some other person, not the applicant for patent or the patentee, was the true and first inventor of the particular invention in question.

Nowdays this plea is not commonly used if it is merely intended to plead want of novelty ; and should not ordinarily be used for that purpose <sup>1</sup> ; it being more usual, if it is intended to plead want of novelty, simply to plead that the invention was not new, giving the necessary particulars of how it has been anticipated.

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<sup>32</sup> See also Section 26 (1) (d).

<sup>1</sup> See *Morgan & Windover* (1898) 7 R. P. C. 446 at p. 449 ; *Thompson v. Macdonald & Co.* (1891) 8 R. P. C. 5 at p. 9 ; *Pneumatic Tyre Co. Ltd. v. Caswell* (1896) 13 R. P. C. 164 at p. 187 ; *Hickson v. Redfern* (1905) 22 R. P. C. 307 ; *Hill v. Thomas & Sons* (1907) 24 R. P. C. 415 at p. 424 (C. A.) ; *Smith's Patent* (1912) 29 R. P. C. 339 at p. 340.

There is however another meaning also embodied in the words ; and in this other meaning the plea may still be used as raising an objection distinct from an objection of want of novelty pure and simple.

The matter of the True First Inventor is referred to expressly in Section 6 of the Statute of Monopolies to the following effect :—

“Provided.....that any declaration before mentioned shall not extend to any letters patent and grants of privilege .....of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures”.....

The declaration before-mentioned refers to the declaration stating that monopolies ordinarily are illegal. It is seen therefore that what is declared not illegal is only a patent...such as is granted to the true and first inventor or inventors.

This requirement is again referred to in the Indian grant of Patent in the passage to the following effect :—

“Whereas (the patentee) hath declared that he is the true and first inventor (of the invention) (or the legal representative or assign of the true and first inventor)”.....

The result is that it is a fundamental requisite of a valid Patent that the patentee should be the true and first inventor of the invention to which the patent relates ; or that he should at least be the legal representative or assign of the true and first inventor of the invention.

The invention itself may be a new invention and yet the patentee may not be in fact the true and first inventor thereof. The plea for this limited purpose is commonly employed even at the present day as an objection to the proposed grant of a patent or to the validity of a Patent which has been granted.

It becomes necessary to consider the meaning of the term True and First Inventor.

**Meaning of the term “True and First Inventor”.**

The meaning of the word “inventor” in Patent Law differs from the popular conception of the word ; and it is essential to appreciate the meaning which it bears uniformly whenever used in connection with Patent Law.

Whether this legal meaning is one which the word has secondarily acquired in legal use or whether it is in fact the original primary meaning of the word is a matter which is now, though interesting, for practical purposes immaterial. There is much to be said for the latter view, which has been propounded in Haddan's *Compendium of Patents and Designs* :—

“In general parlance an inventor is one who, by thought or experiment, finds out or produces something new, and to a certain extent this is a true definition ; but in British law the term “Inventor” has a wider definition. The term inventor primarily intended an importer, as we should now call it, one who caused the invention to become known in this realm. The etymology of the word supports this view. It is derived from two Latin words in—in or into, venire—to come. As we speak of an inventor of a manufacture, we must imply that the word inventor is used in a transitive sense, that causation is implied in the suffix—*or*. The meaning will be, “he who causes the invention to come in.” The same causation is implied in such words as “grantor”, “assignor”, “lessor”, etc., each meaning the person who causes the act, and from whom it proceeds, thus proving that the above is the correct definition. The popular notion more nearly coincides with a person to whom an invention occurs, one to whom ideas come ; such a person would more correctly be termed an “Inventee”. Stress must be laid on the causation implied in the word inventor, since on this view only is its legal meaning at all understandable, and reconcilable with the judicial decisions to which we shall presently refer, and with the present state of the law on the subject”.<sup>2</sup>

Whichever meaning of the word is in truth the primary and whichever is in truth the secondary, in any event to-day the legal meaning of the word in Patent Law must be acknowledged to differ from its current popular meaning to some extent. Thus it is well established that when an inventor is referred to and the word is used according to the uniform meaning possessed by it in Patent legal parlance, English law does not look for the true and first inventor outside the English realm ; nor does Indian Law look for the true and first inventor outside British India. The term true

and first inventor is accordingly limited to the true and first inventor in British India.

### Meaning limited to the sphere of invention in British India.

The expression "true and first inventor" has thus come to be used in Patent Law in a very limited and peculiar sense. Since it is limited to the sphere of invention in British India; a man who would not in ordinary parlance be considered the true and first inventor of an invention at all, who may have been shown an invention abroad by another, may, by being the first to import that invention into British India, yet be truly the true and first inventor in British India within the meaning of the expression as used in Patent Law. And this, too, even though neither in British India or abroad has he in ordinary parlance invented anything.

### Meaning limited to inventions disclosed.

In general parlance again a person may be considered an inventor even though he keeps his invention to himself as a secret. In Patent Law however this is not so. No one is an inventor in the eyes of the Patent Law unless and until he has disclosed his invention to the State. When the history and policy of patents and monopolies is considered to which reference has already been made in a previous chapter the reason for this is readily understood. The result is that if two persons A and B have discovered a similar invention in different places in British India, and A, who in point of time made the discovery before B, has been working the invention as a secret process and has not disclosed the invention to anyone: and B makes the discovery independently and lodges an application for a Patent: A is not entitled to say that B is not the true and first inventor. A Patent will rightly be granted to B. A good example of this was *Dollond's case*.<sup>3</sup>

In that case it was held in effect that Dollond was the true and first inventor and none the less though a certain Dr. Hall had previously made and used object glasses for telescopes which were similar to Dollond's invention; Dr. Hall having kept his own discovery secret.

Or again: A and B both discover a similar invention indepen-

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<sup>3</sup> (1776) 1 W. P. C. 43 cited in Terrell (8th Edn.) p. 19 and in Edmunds at p. 431.

dently : A in fact made the discovery first and in fact communicated the discovery to the public. B ignorant both of the fact that A had made the discovery and also of the fact that A had communicated it to the public, lodges an application for a patent alleging that he, B, is the true and first inventor. An objection that A and not B was the true and first inventor will prevail ; but in such case no patent will be granted. No patent can be granted to B since B is not the true and first inventor. It is of interest to note that no patent will be granted in such a case either to A : it is true that A is the true and first inventor and therefore it is not for any objection on that score that the patent is refused to A : but A has in this case debarred himself from obtaining any patent since his invention has ceased to be a new and patentable invention by reason of the publication to the public prior to his application. For while it is true, as remarked above, that no one is an inventor in the eyes of the Patent Law until he has disclosed his invention, such disclosure generally speaking should be by the application for the Patent and not before. As was held in *Forsyth v. Riviere* "of two simultaneous inventors (sic) he who first communicates the invention to the public under the protection of Letters Patent is the true and first inventor".<sup>4</sup>

### Definition of "true and first inventor."

To summarise the foregoing remarks a true and first inventor may then be defined for the purposes of Indian Patent Law as "one who, having obtained the invention by his own mental efforts anywhere or from instruction or knowledge acquired abroad (or acquired in British India on a communication from abroad), is the first to disclose the invention in British India."<sup>5</sup>

The following observations bearing on this point were made by Lord Lyndhurst, C., in *Househill Co. v. Neilson*<sup>6</sup> as cited in Edmunds on Patents<sup>7</sup> :—

"If the invention is in use at the time the grant is granted the

<sup>4</sup> Cited in Haddan at p. 115 : (1819) 1 Web P. C. 97. See also Haddan at p. 116.

<sup>5</sup> For further explanation and comments on the words in brackets see Chap. IX below.

<sup>6</sup> (1843) 1. Web. P. C. 719.

<sup>7</sup> 1890 Edn. p. 431.

man cannot have a patent, although he is the original inventor : if it is not in use he cannot obtain a patent if he is not the original inventor. He is not called the inventor who has in his closet invented it but who does not communicate it ; the first person who discloses that invention to the public is considered as the inventor. The party must be an inventor : you need not say the inventor, because another may have invented and concealed it ; but in addition to his being an inventor others must not use the invention at the time of the patent."

**Where more than one person has shared in work resulting in the invention.**

Where the inventor has obtained assistance in the working out of details of the invention, he will none the less remain entitled to describe himself as the true and first inventor, provided that the invention was substantially invented by him and the contribution of his collaborators was confined to matters of subsidiary detail. Observations on the point were made, in, among other cases, the case of *Smith's Patent* <sup>a</sup> by Buckley J. as follows :—

"Now beyond that, supposing that Smith did make as I daresay he did in the course of the elaboration of this thing some trifling suggestions from time to time, as to what should be done by way of altering the model and working out the conception which Youlten had in mind, is he entitled to that ? As to that, I wish to read from Mr. Justice Earle in *Allen v. Rawson* (1 C.B. 551). He said : "I take the law to be that if a person has discovered an improved principle and employs engineers, agents or other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle and may be embodied in his Patent ; and if so embodied the patent is not avoided by evidence that the agent or servant made the suggestion of the subordinate improvement of the primary and improved principle." In that case there was a motion for a new trial on the ground of misdirection, and Chief Justice Tindal in Banc, said this : "It would be difficult to define how far the suggestions of a workman employed in the construction of a

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<sup>a</sup> (1905) 22. R.P.O. 57 at p. 61.

machine are to be considered as distinct inventions by him so as to avoid a Patent incorporating those taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments of something calculated more easily to carry into effect the conceptions of the inventor should render the whole Patent void." Applying this principle, even if Smith did take some small part in making suggestions as to the way of carrying this out, those are not matters which entitle him to take out a Patent in respect of them."

Similar observations were made in *Sirdar Rubber Co. Ltd.* and *Maculich v. Wallington, Weston & Co.* :—<sup>9</sup>

"The only remaining question is as to the true and first inventor. Upon this part of the case, I accept the evidence of the Plaintiff James Mecedry Maclulich in preference to that given by Mr. William James McCormack. If the Patent were otherwise valid, the Plaintiff, would in my opinion, be the true and first inventor. McCormack appears to be an excellent draftsman, and to have assisted in carrying out Maclulich's ideas, but the idea and invention was that of Maclulich, and the only assistance given by McCormack is such as an inventor may properly receive from a workman without in any way ceasing to be sole, first and true inventor of an invention. All the circumstances of the case are in favour of Maclulich."<sup>10</sup>

The test will then be, it is submitted whether the collaborator's help was confined to accessory details or whether it extended to a share in the discovery of the main invention. If the latter be found to be the case, then it may well be that both persons will be found to have been jointly the true and first inventors.

### Case of Master and Servant.

The relationship of master and servant it is submitted does not at all affect the question who is entitled to be described as the true and first inventor. This relationship and the implied obligations on the part of the servant, or his express obligations if contained in a contract of service, may well create a legal duty on his

<sup>9</sup> (1905) 22. R.P.C. 357 at p. 267.

<sup>10</sup> And Cf. Fletcher Moulton p. 73 note (d).

part either to assign the Patent to his master or to hold the Patent after grant in trust for his master. But that is clearly a totally different matter: depending on questions of contractual rights totally distinct from the question who is the true and first inventor.

The principle that the relationship of master and servant does not in itself in any respect give the master any right to describe himself in Patent Law as the true and first inventor was clearly stated in the case of *Heald's Patent* by the Solicitor-General in the following passage:—<sup>11</sup>

"But then I have to deal with the proposition upon which Mr. Graham has challenged his opponents to quote an authority—the proposition that an improvement made by a servant is the property of his employer, so as to entitle the employer to take out a patent for it, or to prevent the servant from taking out a patent for it. I am not aware of any authority which lays down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it."

Compare also *In the Matter of Marshall & Naylor's Patent*.<sup>12</sup> There an attempt was made in argument to contend that the master had been entitled to take out the Patent in his own name (which would entail describing himself as the true and first inventor. The case was one of a Petition for Revocation filed by the servant, Walsh, who claimed to be himself the true and first inventor. It was held by Farewell J. that this claim was justified and the Patent was ordered to be revoked. In the course of argument Farewell J. made the pertinent observation:—"Marshall cannot give a lucid explanation of the invention in any intelligible way. How can he say he invented it?" "It may be observed, if the view should be put forward that where the relationship of master and servant exists and the master employs a servant to discover inventions on his (the master's) behalf, the master thereby has a right to apply for the grant of a Patent in his own name as the true and first inventor, that such a view is at once completely disposed of by the observation above-noted of Farewell J. It appears to be well established

<sup>11</sup> (1891) 8. R. P. C. 429 at p. 430.)

<sup>12</sup> (1900) 17 R. P. C. 553 at p. 555.



that the process of invention such as to constitute a man a true and first inventor cannot be effected other than personally : and cannot be effected on behalf of an employer through the brain of an agent or of a servant. Thus in many cases the real question is a difficult question of fact whether the invention in the main has been invented<sup>13</sup> by the master or by the servant : or by both jointly.<sup>14</sup>

### Whether a question of law or fact.

It is submitted that the question whether a certain person was or was not the true and first inventor will be predominantly one of fact but that even when a finding has been come to as to the facts, there may in some cases remain a question of law : e.g. : as to principles in regard to imported inventions : or as to principles of priority in regard to inventions which have been kept secret. And on such matters it is submitted, the decision of a Court in British India will be guided by the principles which have been enunciated in the English cases.

<sup>13</sup> For a discussion of cases on the topic of "true and first inventor" see Edmunds (1890 edn.) p. 431 and 432 ; Fletcher Moulton (1913 edn.) p. 73 to 75 ; Haddan (1931 edn.) p. 115 et. seq. See also the matter further referred to in Chapter IX below : also the cases referred to under part III of this chapter.

<sup>14</sup> Regarding the different point, for cases where dispute has arisen whether or not the servant was bound to hold the Patent in trust for his master by reason of the obligations arising out of his contract or by reason of personal rights amounting to a trust between the two persons, reference may be made to the following cases :— *Worthington Pumping Engine Co. v. Moore* (1903) 20. R.P.C. 41 ; *Edisonia Ltd. v. Forse* (1908) 25. R.P.C. 546 where the Plaintiff Company obtained the following reliefs (i) a declaration that the Defendant was a trustee of the Letters Patent for the Plaintiff Company (ii) an order on the Defendant to assign the Letters Patent to the Plaintiff or as the Plaintiff may direct (iii) an injunction restraining the Defendant from disposing of or dealing with the Letters Patent or putting them in practice (iv) an account of articles made (by defendants) in accordance with the invention ; *British Reinforced Concrete Engineering Co. Ltd. v. Lind* (1917) 34. R.P.C. 101 and as to the test see at p. 109 ; *Hop Extract Co. Ltd. v. Horst* (1919) 36. R.P.C. 177 ; *Mellor v. William Beardmore & Co. Ltd* (1926) 43. R.P.C. 361 and (1927) 44. R.P.C. 175 ; *Adamson v. Kenworthy* (1932) 49. R.P.C. 57. For a successful action for damages for breach of a "confidence agreement" see *Mechanics and General Inventions Co. Ltd. (in Liqn) and Another v. Austin and others* (1935) 153. Law Times 153. See also Terrell 8th edn. p. 22-24 notes (g) and (h) ; and Fletcher Moulton p. 74 note (q).

**At what stages the objection, that the Applicant for Patent (or the Patentee if after grant) was not the true and first inventor, may be raised in British India :—**

(i) As to objections by the Patent Office before the acceptance of the application :—

This is not one of the matters which the Patent Office is required to investigate in the examination to be made by it under Section 5. Moreover the Patent Office will ordinarily not in fact be in the position to raise any objection of this sort. This objection it is submitted is not one which can be raised at this stage.

(ii) In opposition proceedings before the Controller :—

This objection generally speaking is not one of the grounds mentioned in Section 9 of the Indian Act. In cases of opposition before grant it is therefore not open to an opposer under the Indian Act to oppose on the general ground that the Applicant is not the true and first inventor, if the basis of complaint is that it is a third party who is in fact the true and first inventor. The opposer is only entitled to take the more restricted objection of "obtaining", as it is commonly known : viz. :—that "the applicant obtained the invention from him (i.e. the opposer) or from a person of whom he is the legal representative or assign" That ground of obtaining is open under Section 9(1)(a). Properly speaking that objection relates to a distinct ground ; to which further reference is made towards the end of this chapter. It is of interest however here to note that if that objection is established, it is provided under Section 13(2) of the Indian Act that the Controller may grant the Patent to the opposer instead of to the Applicant. In practice therefore it frequently happens that an objection that the Applicant is not the true and first inventor is ventilated by being raised in the form of an objection under Section 9(1)(a), through an opposition being filed by a person who is in a position to take an objection on the ground that the Applicant obtained the invention from him. Such a person is more than ordinarily interested to oppose the grant since he may not merely succeed in preventing the grant being made to the Applicant but may succeed in obtaining the grant himself.

(iii) On a petition to Court for revocation :—

The Petitioner is entitled to raise this objection at this stage under the express provisions of Section 26(1)(c).

## (iv) In an infringement suit as a defence :—

The Defendant is entitled to rely on this objection as a ground on which to have the Plaintiff's patent declared invalid and to succeed in his defence to the suit : the Defendant's position in this respect being the same as that of a Petitioner in a petition for revocation by virtue of Section 29(2).

### PART III. ABSENCE OF FRAUD : ALSO FREEDOM FROM THE OBJECTION OF OBTAINING

#### Absence of fraud.

The principle has always been upheld that an applicant for a Patent must act in every respect in a *bona fide* manner. Absence of fraud must therefore be considered as one of the fundamental requisites of a good Patent. It is clear, it is submitted, that if it is established that a Patent has been obtained by fraud, the grant will be invalid on the paramount ground that deceit has been practised on the Crown. It is submitted therefore that fraud in general, if it be shown in any respect that the Patent was obtained by fraud, will be sufficient ground in itself upon which a Patent may be invalidated. Similarly, it is submitted that if it is shown, prior to grant, that an application has been made which will have the effect, if the Patent be granted, that the grant will have been obtained by fraud, this will for the same reason be a sufficient ground in itself upon which the grant should be refused to be made. This view appears to be generally accepted in the United Kingdom and it is submitted will prevail equally in British India. The principle was referred to emphatically, though obiter, in *Perrelts Application*<sup>1</sup> where the Assistant Comptroller observed :—"I do not find that the invention was obtained by fraud in the sense of the "moral turpitude" which Mr. Justice Warrington referred to in his judgment in the case of *Ralston's Patent* (1909) 26. R.P.C. 313, at page 331, (lines 22-44). If I had arrived at such a finding, I should refuse to make any grant at all upon the Application, for conscious and deliberate fraud would render the whole Application void."

Fraud of this general nature is not given as one of the express grounds under the Act on which an opposition to grant may be founded nor among the express grounds under the Act on which

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<sup>1</sup> (1932) 49. R. P. C. 406.

revocation proceedings may be based. Nevertheless it is submitted that if a case of general fraud could be made out at any stages of the proceedings, it would be open to be taken as an objection on general principles.

The very strictness of the principle that a high degree of *bona fides* is essential between the Applicant and the Crown in all matters relating to applications for Patents and the very nature of the other requisites of a valid patent may in itself be some reason why cases in which fraud simpliciter in a general sense is made the sole ground of objection are in practice met with but seldom. (In a case for example in which the revocation of a Patent may be successfully obtained by showing insufficiency, there may be no necessity to prove a case of general fraud.)

Moreover fraud in certain specific respects is in certain instances expressly by statute made a ground of objection to invalidate a Patent. In any case where a charge of fraud in a general sense may be supported, the facts will ordinarily involve grounds for proceeding on one or more of such specific statutory objections.

**Specific statutory grounds based on fraud which may be relied on as objections to invalidate a Patent.**

In the United Kingdom under the English Act almost every kind of case of fraud which is likely to be met with is likely to be covered by the wide provisions of Section 25(2)(c) which is an express statutory ground for revocation worded as follows:—"that the patent was obtained in fraud of rights of the person applying for the order (i.e. of revocation) or of any person under or through whom he claims." Or otherwise by the wide provisions of section 25(2)(k) viz. :—"that the patent was obtained on a false suggestion or representation."

In the United Kingdom even under the English Act fraud is not specifically mentioned among the grounds of opposition enumerated in Section 11 : though the objection of obtaining (without mention of fraud) is given as a ground under Sec. 11(1)(a).

The result under the English Act is that while it is made a necessity for a Petitioner in revocation proceedings to show positive fraud of his rights in addition to showing that the Patent was obtained from him, it is only necessary for an opponent in opposition

proceedings, before the grant of the patent, to show that the Patent was obtained from him ; and he need not establish that there was any positive fraud on the part of the applicant for Patent.

Under the Indian Act of 1911 the grounds of objection, in which an express reference to fraud are made, differ in their wording considerably from the provisions abovementioned which are in force under the English Act.

The material grounds of objection open under the Indian Act in revocation proceedings are worded as follows :—

“26(1)(e) that the applicant has knowingly or fraudulently included in the application for a Patent or in the original or any amended specification, as his invention, something which was not new or whereof he was neither the inventor nor the assign nor the legal representative of such inventor ;”

“26(1)(f) that the original or any subsequent application relating to the invention, or the original or any amended specification, contains a wilful or fraudulent mis-statement ;”

In connection with revocation proceedings in India under the Indian Act there is no express mention, under Section 26, of any objection on the ground of “obtaining” ; whether with or without fraud.

The objection which is commonly relied upon for revocation in the United Kingdom that the Patent was “obtained in fraud of the rights of the Petitioner” is not available as a specific statutory ground under the Indian Act.

It is difficult to understand the reason for fraud having been included as an ingredient in the ground given under Section 26(1)(e), coupled as it is with what must amount to an objection for want of novelty or an objection on the ground that the applicant was not the true and first inventor ; since either of those grounds even without any substratum of fraud will in themselves be a sufficient ground for revocation : and are expressly given as such under Section 26(1)(b) or Section 26(1)(c). Section 26(1)(e) being thus a redundancy is seldom likely to be invoked as a ground of revocation. In view of this and in view of the confusion of thought apparent in its wording, it becomes unprofitable here further to consider it.

*N. B. It would appear that Section 26 of the Indian Act is in urgent need of drastic revision : compare and contrast the clear provisions of Section 25 of the English Act.*

The ground made available in India for revocation under Section 26(1)(f) (wilful or fraudulent mis-statement in the application or specification) will it seems be found to cover in practice most cases in which fraud of any nature is sought to be relied on as a ground of objection : just as these are in practice mostly covered, though from a different angle, by the ground made available in England for revocation under the English Section 25(2)(k) together with that under the English Section 25(2)(c).

In regard to opposition proceedings in India it is seen that, like the English Act, the Indian Act contains no direct mention of fraud among the objections enumerated for opposition under Section 9 ; and the ground comprising the objection for "obtaining" given in Section 9(1)(a) is in this respect precisely similar in its wording to the ground under the English Section 11(1)(a) which has been cited above.

In such opposition proceedings to establish an objection under Section 9(1)(a) of the Indian Act it follows, equally, that it is not necessary to show the existence of any fraud at all.

### **Meaning of fraud.**

It has been held in the United Kingdom that fraud when required to be shown must be such as involves grave moral culpability in the person obtaining the Patent. The following observations were made by Stirling J. in the case of *Avery's Patent*<sup>2</sup> in considering the issue of fraud which arose in connection with the question whether the Patent had been obtained in fraud of the Petitioner's rights (being the objection founded on the wording of the English Act) :

"The question still remains in this case : was the patent in the language of the statute obtained in fraud of the Petitioner's rights ? The first point to be determined in answering that question is the sense of the word "fraud" as used in the Statute. "Here we have not to deal with a statute 300 years old, like the Statute of Mono-

<sup>2</sup> (1887) 4. P.O.R. at p. 165 as cited in Edmunds at p. 364 : or 4. R.P.C. 165, 322 (C. A.)

polies, nor is there any current of decision to fix the sense in which the word therein is used, and in my judgment it would be wrong to construe the word, occurring as it does in an Act passed little more than three years ago, and in the absence of any context imperatively demanding such a construction, otherwise than in accordance with the usual construction of the English language, and consequently as involving grave moral culpability in the person obtaining the patent."

Observations to the same effect are made in Fletcher Moulton on Patents thus :—"Fraud here, as ordinarily, implies a dishonest action of some kind. and a mistake honestly made does not give rise to any claim under this head, nor will the Court consider whether a party, who has acted honestly, has correctly interpreted his legal rights. The fraud must be proved conclusively, and the Court is not ready to infer it." <sup>3</sup>

It is submitted that the foregoing observations are equally applicable as defining the nature of the fraud required to be established in order to obtain revocation of a Patent in India under Section 26(f) (or under Section 26(e) should that section be invoked) as under the relative section of the English Act already referred to ; and that the term "fraud", or "fraudulent" in connection with the grounds stated under the Indian Act has the same meaning as it has under the English decisions ; and that the force of such decisions is in nowise affected by the circumstance that the precise ground which was being construed in those cases (i.e. the ground of "obtaining in fraud of the rights of the Petitioner", so worded) does not find a place under the Indian Act.

#### **Only Fraud within British India a ground of invalidity.**

It has been generally held that the only fraud which can be relied on as a ground of invalidity against a Patent is fraud within the country covered by the grant. This principle appears to be a corollary of the principle that the Patent Law does not look for the true and first inventor outside the country covered by the grant. It follows that where there are two rival persons both claiming to be

<sup>3</sup> See Fletcher Moulton on Patents p. 212 who cites also *Avery's Patent* (supra) ; *Jackson's Patent* (1905) 22, R.P.C. 394, at p. 387 ; *Mark's Patent* (1908) 25, R.P.C. 553. See also *Jameson's Patent* (1902) 19, R.P.C. 246 ; cf. *Scott's Patent* (1903) 20, R.P.C. 257.

the true and first inventor of an invention in respect of British India the Indian Patent Law treats as immaterial any transactions which may have taken place between these two rivals outside British India, no matter whether those transactions may have been fraudulent or not. <sup>4</sup>

Questions of the rights in personam between the individuals concerned whether for breach of contract or for equitable relief are of course totally different questions which do not affect the validity of the grant. <sup>5</sup>

### The objection of "obtaining" :

It is provided under Section 9(1)(a) that,

"Any person may, on payment of the prescribed fee, at any time within (four) months from the date of the advertisement of the acceptance of an application, give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds, namely :—

- (a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative or assign ;

Such an objection is for brevity ordinarily known as an objection on the ground of "obtaining". Since if the objection is taken successfully, the grant of a patent will be refused to the Applicant, it here becomes advisable when considering what are the valid requisites of a good patent not to overlook the point that the Patent (or the mode of application for the Patent) must be such as to be free from any objection on the ground that the Applicant "obtained" the Patent from another person.

### The objection of "obtaining" : apart from fraud.

Since it can seldom happen that A will obtain a patent from B against B's wishes and take out a patent in his own name without doing so fraudulently, it will be found in practice that cases involving an objection on the ground of "obtaining" under Section 9(1)(a)

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<sup>4</sup> See *Avery's Patent* (1887) 4. R.P.C. 152 at p. 164 and 322 (C.A.). See also *Meurs Gerkin's Application* (1910) 27. R.P.C. 565 ; *Curwen's Application* (1913) 30. R.P.C. 128 ; 29. R.P.C.App.A. *Halsey's Application* (1914) 31. R.P.C. 101.

<sup>5</sup> See *Fletcher Moulton* p. 74 note (q) and (r) and see the cases cited at p. 256 ante, note No. 14.)



of the Indian act will almost inevitably involve facts constituting fraud. Yet as already observed it is not in any respect a necessity under the Act for success in opposition proceedings on this ground to show any fraud at all. If the applicant can show he was himself the true and first inventor, this is enough to dispose of an alleged objection on the ground of obtaining. To show there was an obtaining by the Applicant from the opponent involves therefore the showing that the Applicant was not the true and first inventor himself.

It follows that under the provisions of Section 9(1)(a) of the Indian Act, which corresponds as already noted to Section 11(1)(a) of the English Act, all that is necessary to be shown to make good an objection in opposition proceedings is: (1) that the Applicant for Patent was not the true and first inventor and (2) that the Applicant obtained the invention from the opponent.

The statutory objection of "obtaining", which even without fraud, as already observed, is a ground upon which the grant of a Patent can be successfully opposed under Section 9 (1)(a) is merely a specific instance of the negation of one of the wider requisites of a valid Patent which have been already previously considered: viz. that the applicant was not the true and first inventor.

It is nevertheless convenient here to note briefly the nature of acts or conduct which may amount to "obtaining" within the meaning of Section 9(1)(a); that is to say irrespective of fraud.  
**Fraud immaterial.**

The case of *In the Matter of an Application for a Patent by I. G. Perrett* and the observations of the Assistant Comptroller in that case are in themselves sufficient authority for the clear proposition that, in regard to objections for "obtaining" simply, the presence or absence of fraud is immaterial: when he said in the course of his ruling on the opposition proceedings<sup>6</sup>:—

"That "obtaining" does not necessarily imply fraud, has been repeatedly held. (See for example, Ruling 1920 (A) in the Appendix to Volume 27 of the Reports of the Patent Cases)."

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<sup>6</sup> (1932) 49. R. P. C. 406 at p. 408.

<sup>7</sup> See also *Griffin's Application* (1889) 6. R. P. C. 296; and 27. R. P. C. App. (i).

**Knowledge is material.**

It is necessary however that the applicant for Patent or an agent of his must be fixed with the knowledge that the invention came from the opponent.<sup>8</sup>

**Acts which may have taken place outside British India are immaterial.**

Clearly if the Applicant for Patent is himself the True and First Inventor, it cannot be said that he "obtained" the invention from anyone else. As already previously observed the Applicant may be the True and First Inventor for all purposes of the Indian Patent Law even though he obtained knowledge of the invention from some other person abroad and imported the invention into India. It follows therefore that whatever events may have occurred outside British India, these are immaterial and can in no way assist in establishing an objection on the ground of "obtaining" under Section 9(1)(a) of the Indian Act. The "obtaining" there referred to must therefore be restricted in meaning to an "obtaining" within British India.

This principle has been held under English Law to apply also to Convention Applications.<sup>9</sup>

**Identity of the Applicant's invention with what is alleged to have been obtained.**

In oppositions on this ground of "obtaining" the issue most commonly in dispute in practice is whether or not the invention described in the Specification of the Applicant for Patent is the same as what is alleged to have been obtained from the opponent. For an objection to succeed, it is, of course, essential to establish identity or at least sufficient similarity.<sup>10</sup>

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<sup>8</sup> See Fletcher Moulton p. 265 : who cites also *Edmund's Application* (1886) Griff 282.

<sup>9</sup> Compare Fletcher Moulton p. 265 citing inter alia the following cases : *Edmund's Application* (1886) Griff 281 ; *Spiel's Application* (1888) 5. R. P. C. 281 ; *Lake's Application* (1888) 5 R. P. C. 415 ; *Higgins Application* (1892) 9. R. P. C. 74 ; *McNeil's Application* (1907) 24. R. P. C. 680 ; 1912. A. ; and, regarding convention applications, *Meurs-Gerkin's Application* (1910) 27. R. P. C. 565.

<sup>10</sup> See *Ashton & Knowle's Application* (1910) 27. R. P. C. 181 ; *Maley & Taunton's Application* (1932) 49. R. P. C. 47 ; Fletcher Moulton p. 266 ; Terrell (8th Edn.) p. 190.

**Where more than one person has assisted in work resulting in the invention.**

The issue of "obtaining" also frequently arises in opposition proceedings in cases where it is the work, manual or mental, of more than one person from which the invention in its final form has originated. Such principles as have been laid down in the English decisions in such cases have already been mentioned in connection with the meaning of the true and first inventor<sup>11</sup>.

**At what stages objections for fraud may be raised in British India.**

It is submitted that if the objection relates to conscious and deliberate fraud, such as to amount to a deceit on the Crown, such an objection, though nowhere mentioned in the Act, could be raised by virtue of general principles of law at any stage : either as an objection by the Patent Office before acceptance of the application : or in Opposition Proceedings before the Controller : or on a Petition to Court for revocation : or in an Infringement suit as a defence.

Regarding specific statutory grounds relating to fraud in some shape or other, the position appears to be as follows :—

(i) As to objections by the Patent Office before acceptance of the application.

No ground based on fraud is mentioned in Section 5 which relates to the search to be made by the Patent Office at this stage. And from the nature of things objections for fraud are not taken, ordinarily, by the Patent Office at this stage.

(ii) In opposition proceedings before the Controller :—

No ground based on fraud is among those made available under Section 9. In practice however circumstances involving fraud may be relied on as a ground in connection with other objections either of "obtaining" [under Section 9(1)(a)] or of insufficiency [under Section 9(1)(c).]

(iii) On a Petition to Court for revocation :—

Fraud is expressly mentioned as a ground under Section 26(1)(e) and Section 24(1)(f).

(iv) In an infringement suit as a defence :—

The Defendant's position is the same as that of a Petitioner in a Petition for Revocation : by virtue of Section 29(2).

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<sup>11</sup> See page 253 ante.

**At what stages an objection for "obtaining" may be raised in British India :—**

(i) As to objections by the Patent Office before acceptance of the application :—

The objection cannot be raised at this stage.

(ii) In opposition proceedings before the Controller :—

The objection of obtaining is expressly allowed to be raised as a ground under Section 9(1)(a).

(iii) On a Petition to Court for revocation :—

The objection (though commonly relied upon in the United Kingdom under the English Act) finds no mention among the grounds stated under Section 26 of the Indian Act. It is not therefore, it would appear, available as a ground for revocation. In many cases the circumstances desired to be relied on may be equally well relied on as an objection relating to "true and first inventor" under Section 26(1)(c).

(iv) In an infringement suit as a defence :—

The position of a Defendant is the same as that above stated for a Petitioner in a Petition for revocation : by virtue of Section 29(2).

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**CHAPTER VIII**  
**FURTHER REQUISITES OF A VALID AND EFFECTIVE**  
**PATENT IN REGARD TO THE MANAGEMENT OF**  
**THE PATENT AFTER GRANT—OBLIGATIONS**  
**NOT TO ABUSE THE MONOPOLY—OBLIGA-**  
**TIONS FOR ADEQUATE WORKING AND**  
**SUPPLY—OBLIGATIONS AS TO**  
**MANUFACTURE IN**  
**BRITISH INDIA**

It is next proposed to consider the requisite obligations which a patentee must fulfil in the management of his patent after grant. In order to retain his patent valid and effective he has certain obligations to the public in regard to working the patent and in regard to supplying the demand of the public for the patented article, which should not be lost sight of when considering what are the requisites of a valid patent. In order that the benefit of a patent may not be lost either wholly or partially it is equally essential for these requisites for working and supply and manufacture in British India to be fulfilled after grant as it is for the other requisites which have already been considered in the preceding two chapters to be fulfilled in what may be termed the earlier stages of the life of the patent.

These obligations are now regulated both in England and in India by Statute in the current Patent Acts.

**Previous English Law.**

Under the Statute of Monopolies (see Section 6) it was expressly provided that a patent was void if "contrary to Law or mischievous to the state by raising prices of commodities at home or hurt of trade or generally inconvenient". It appears that in fact many patents were revoked during the seventeenth century under the Statute of Monopolies alone.<sup>1</sup>

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<sup>1</sup> See Terrell 8th edn. p. 323 citing Hulme.

It is abundantly clear also that the early patents were granted with a view to assisting the grantees to establish new industries in England. This being the basis of the grant it was clearly within the power of the Crown, even without any special further statutory provisions for the purpose, to revoke grants if through neglect by the grantee of his obligations this object was not fulfilled; in such cases the grantee would not have fulfilled the conditions of the grant.

The following observations of Parker J. in the case of *Hatchek's Patents*<sup>2</sup> (when considering the effect of Section 27 of the English Act of 1907) also support this view: viz:—

"The mischiefs aimed at by the Section arose to a great extent, at any rate, from the patentee exercising his exclusive right of sale without exercising his exclusive right of manufacture, contenting himself with preventing manufacture by others in this country and importing articles manufactured abroad. The Statute of Monopolies reserves only the right of the Crown to grant for 14 years the sole right of working or making the invention and says nothing about the sole right of sale. The Crown has, however, always granted by virtue of this reservation, the sole right of sale as well as the sole right of working and making. This has been held to be justified on the ground that the sole right of sale is an ancillary right to the sole right of manufacture, and it might possibly at one time have been open to the Courts to refuse to protect the sole right of sale unless exercised as an aid to the sole right of manufacture in this country. The form of Letters Patent granted by the Crown has, however invariably so far as I can discover, contained a clause providing that if at any time during the term of the Patent it should be made to appear to the King or any six or more members of his Privy Council, that the grant was prejudicial or inconvenient to the King's subjects, the Letters Patent should be void. There is an instance of this clause in a Patent granted in 1618, several years before the Statute of Monopolies and cited in the case of the *Attorney-General v. Simpson* (1901, 2 Chancery, at pages 675 and 676), and it appears from that case that the Privy Council entertained jurisdiction under the clause to regulate charges made by the

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<sup>2</sup> (1909) 26. R.P.C. 1 and 228 at p. 244; or 1909. 2. Ch. 68 at p. 90.

Patentee. (See the same case in the House of Lords, 1904 Appeal Cases, at page 483). In my opinion, Letters Patent have always been voidable under this clause if worked by the patents to the prejudice or inconvenience of the King's subjects in general, and but for the fact that the jurisdiction of the Privy Council under this clause has fallen into disuse, a patentee by abusing his monopoly would always have incurred the risk of losing his patent rights."

It appears also that many early patents were in fact revoked on the ground of non-manufacture in England: on the principle that this was an abuse of the monopoly.

Later however it appears to have been decided that actual manufacture in England was not obligatory; provided that the demand in England was properly met.<sup>3</sup>

Though even in former days, if a patentee abused his monopoly rights, there would have been ample inherent power in the Crown to insist on the issue of compulsory licenses, yet in fact there was no machinery to regulate the issue of such licenses; nor were they in practice issued.

The first Statute to regulate these matters was the English Act of 1883.

### English Law in 1883.

The material provisions of the English Act of 1883 were as follows :—

By section 22 :—

"If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

- (a) The patent is not being worked in the United Kingdom; or
  - (b) The reasonable requirements of the public with respect to the invention cannot be supplied; or
  - (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed;
- the Board may order the patentee to grant licenses on such terms as

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<sup>3</sup>. See *Badische Anilin und Soda Fabrick v. W. G. Thompson Ltd. etc.* (1904) 21. R. P. C. 473.

to the amount of royalties, security for payment or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus."

### English Law in 1902.

The material provisions of the English Patents Act of 1902 were as follows :

By Section 3 :

3. Section twenty-two of the principal Act (relating to the grant of compulsory licences by the Board of Trade) is hereby repealed and the following provisions shall be substituted therefore :—

(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent ;

(2) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council ;

Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default ;

(4) On the hearing of any petition under this section, the patentee and any person claiming an interest in the patent as exclusive licensee, or otherwise, shall be made parties to the proceedings, and the law officer, or such other counsel as he may appoint, shall be entitled to appear and be heard ;

(5) If it is proved to the satisfaction of the Judicial Committee that the patent is worked, or that the patented article is



manufactured, exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory license or, subject to the above proviso, to an order for the revocation of the patent ;

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent, or manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms (a) any existing industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met ;

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding ;

(8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council, or any order made by the Judicial Committee under this Act, may be enforced by the High Court as if it were an order of the High Court ;

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but, in awarding costs on any application for the grant of a licence, the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee :

(10) For the purposes of this section, three members of the Judicial Committee shall constitute a quorum ;

(11) This section shall apply to patents granted before, as well as after, the commencement of this Act."

**English Law : in 1907.**

The material provisions of the English Act of 1907 were as

follows :—

By Section 24 :

“(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as inclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(a) If by reason of the default by the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced,

or the demand for the patented article or the article produced by the patented process is not reasonably met ; or

- (b) If any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

By Section 27 :—

(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The Comptroller shall consider the application, and if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either—

- (a) forthwith ; or
- (b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom, to an adequate extent :

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

- (3) If within the time limited in the order the patented article

or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured, or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the Law Officer or such other Counsel as he may appoint shall be entitled to appear and be heard."

### English Law in 1919.

The material provisions of the English Act of 1919, which repealed both Section 24 and Section 27 of the Act of 1907 and enacted a new section 27 were as follows :—

"1. For section twenty-seven of the Patents and Designs Act, 1907 (hereinafter referred to as the principal Act), the following section shall be substituted.

"27. (1) Any person interested may at any time apply to the Comptroller alleging in the case of any patent that there has been an abuse of the monopoly rights thereunder and asking for relief under this section.

(2) The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances :—

- (a) If at any time after the expiration of four years from the date of the patent, the patented invention (being one capable of being worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working :

Provided that, if an application is presented to the Comptroller on this ground, and the Comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the Comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose :

- (b) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement:
- (c) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms :
- (d) If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted :
- (e) If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process :

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage inventions but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay.

(3) On being satisfied that a case of abuse of the monopoly rights under a patent has been established the Comptroller may exercise any of the following powers as he may deem expedient in the circumstances :—

- (a) He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall

apply as are provided in this Act in respect of patents so indorsed, and an exercise by the Comptroller of this power shall entitle every existing licensee to apply to the Comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the Comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the Comptroller may make such order; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee :

- (b) He may order the grant to the applicant of a licence on such terms as the Comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent and in such case the patentee and all licensees for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register : In settling the terms of a licence under this paragraph the Comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

- (c) If the Comptroller is satisfied that the invention is not

being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital of an exclusive licence on such terms as the Comptroller may think just, but subject as hereinafter provided :

- (d) If the Comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the Comptroller may on reasonable cause shown in any case, by subsequent order extend the interval so specified :

Provided that the Comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession :

- (e) If the Comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just.

(4) In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding subsection, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but, subject thereto, the licence shall be so framed as :—

- (a) To secure to the patentee the maximum royalty compatible with the licensee working the invention within the

United Kingdom on a commercial scale and at a reasonable profit :

- (b) To guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the Comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order.

(5) In deciding to whom such an exclusive licence is to be granted, the Comptroller shall unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent.

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the Comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the Comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention.

(7) Every application presented to the Comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The application must be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

(8) The Comptroller shall consider the matters alleged in the application and declarations, and, if satisfied that the applicant has a bona fide interest and that a prima facie case for relief has been made out, he shall direct the applicant to serve copies of the appli-



cation and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent and shall advertise the application in the illustrated Official Journal (Patents).

(9) If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall, within such time as may be prescribed or within such extended time as the Comptroller may on application further allow, deliver to the Comptroller a counter statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.

(10) The Comptroller shall consider the counter statement and declarations in support thereof and may thereunder dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the Comptroller himself appoints a hearing. In any case the Comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.

(11) All orders of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(12) In any case where the Comptroller does not dismiss an application as hereinbefore provided, and

- (a) if the parties interested consent, or
- (b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Comptroller conveniently be made before him ; the Comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the Comptroller, and, where the whole proceedings are so referred, the award of such arbitrator

shall if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the Comptroller under this section, and, where a question or issue of fact is so referred, the arbitrator shall report his findings to the Comptroller.

(13) For the purposes of this section, the expression "patented article" includes articles made by a patented process.

By Section 2 :—

"2. For section twenty-four of the principal Act, the following section shall be substituted :—

"24. (1) At any time after the sealing of a patent the Comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words 'licences of right', and a corresponding entry to be made in the register, and thereupon—

- (a) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in default of agreement, may be settled by the Comptroller on the application of either the patentee or the applicant :

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this subsection as if they had been imposed by the Comptroller thereunder in like manner as if the terms had been settled by the Comptroller :

- (b) in settling the terms of any such licence the Comptroller shall be guided by the following considerations—
  - (i) he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights ;
  - (ii) he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom ;

- (iii) he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted.

Provided that, in considering the question of equality of advantage, the Comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom ;

- (c) any such licence the terms of which are settled by the Comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation :
- (d) every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register :
- (e) if in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a licence upon terms to be settled by the comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would

have been recoverable against him as licensee if the license had been dated prior to the earliest infringement :

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods :

- (f) the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The Comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the Illustrated Official Journal (Patents) and shall satisfy himself that the patentee is not precluded by contract from making such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary :

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences.

(3) Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the Comptroller within the prescribed time and in the prescribed manner, and the Comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement, if already made, to be cancelled.

Any order under this sub-section shall be subject to appeal to the Court.

(4) All indorsements of patents under this section shall be entered on the register of patents and shall be published in the Illustrated Official Journal (Patents), and in such other manner as to the Comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.

(5) If at any time it appears that in the case of a patent so indorsed there is no existing licence the Comptroller may, if he thinks fit, on the application of the patentee and on payment by him

of the unpaid moiety of all renewal fees which have become due since the indorsement, after due notice cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made."

By Section 3 :—

"3. After section twenty-seven of the principal Act, the following section shall be inserted :—

"27A. Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties."

### **English Law in 1928.**

The material provisions of the English Act of 1928 were solely directed to preventing applications being made except after three years after grant and were as follows :—

By Section 2 :—

"2. The following amendments shall be made in section twenty-seven of the principal Act :—

- (1) In sub-section (1), after the words "at any time", there shall be inserted the words "after the expiration of three years from the date of the grant of a patent," and for the words "any patent" there shall be substituted the words "that patent" :
- (2) In paragraph (a) of sub-section (2) the words "at any time after the expiration of four years from the date of the patent" shall be omitted, and for the words "the date of the patent" there shall be substituted the words "the grant of the patent."

### **Present day law in the United Kingdom.**

The material provisions of the current English Statute are contained in Section 27 and Section 83A together with (as to licenses of right) Section 24 of the Patents & Designs Acts 1907-1932. The present Section 27 is substantially the same as Section 27 of the 1919 Act : for convenience of reference however it is here set out with such passages as differ from the 1919 act in italics. The present Section 83A is for purposes of patents precisely the same

as the former Section 27A of the 1919 Act : it has been transferred to a later part of the Statute merely for the purpose of making it applicable also to designs as well as to patents. For convenience of reference it is also set out here italicised in the same manner. The present Section 24 (concerning "licenses of right") is for convenience of reference also set out here italicised in the same manner. This, together with the observations contained in the earlier part of this chapter, it is hoped, will enable the evolution in England of the law regarding the abuse by the patentee of his monopoly to be traced at a glance up to the present day. The arrangement adopted in this chapter of setting out the exact wording of previous English statutory provisions, in sequence, showing the precise nature of the changes of wording effected, with the relative dates, though tedious, appears to be necessary for the extent to be appreciated to which the principles and reasoning of English decisions will be applicable in India. In many cases it will be seen that such decisions are based on a wording to be interpreted which is precisely similar (and in other instances not materially different) in both countries.

Possibly also to some the process of the clarification of the law in this sphere in England, through the changes noted, may be of interest for purposes of comparison with the relative sections of the Act now in force in India.

The following are the sections in point which are in force in England at the present day :—

"27. (1) Any person interested may at any time *after the expiration of three years from the date of sealing a patent* apply to the Comptroller alleging in the case of that patent that there has been an abuse of the monopoly rights thereunder and asking for relief under this section.

(2) The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances :—

- (a) If the patented invention (being one capable of being worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working :

Provided that, if an application is presented to the Comptroller on this ground, and the Comptroller is of opinion

that the time which has elapsed since the *sealing* of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the Comptroller may *make an order adjourning* the application for such period as will in his opinion be sufficient for that purpose.

- (b) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement :
- (c) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms :
- (d) If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted :
- (e) If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee, whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process :
- (f) *If it is shown that the existence of the patent, being a patent for an invention relating to a process involving the use of materials not protected by the patent or for an invention relating to a substance produced by such a process, has been utilised by the patentee so as unfairly to prejudice in the United Kingdom the manufacture, use or sale of any such materials :*

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without delay.

(3) On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the Comptroller may exercise any of the following powers as he may deem expedient in the circumstances :—

- (a) He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the Comptroller of this power shall entitle every existing licensee to apply to the Comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the Comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the Comptroller may make such order ; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee :
- (b) He may order the grant to the applicant of a licence on such terms as the Comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringements of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for



infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register :

In settling the terms of a licence under this paragraph the Comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

- (c) If the Comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the Comptroller may think just, but subject as hereinafter provided :
- (d) *If the Comptroller is satisfied that the monopoly rights have been abused in the circumstances specified in paragraph (f) of the last foregoing subsection, he may order the grant of licences to the applicant and to such of his customers and containing such terms as the Comptroller may think expedient.*
- (e) If the Comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the Comptroller may, on reasonable cause

shown in any case, by subsequent order extend the interval so specified :

Provided that the Comptroller shall take no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or *part of His Majesty's dominions outside the United Kingdom* :

- (f) If the Comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just.

(4) In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding sub-section, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but subject thereto, the licence shall be so framed as—

- (a) to secure to the patentee the maximum royalty compatible with the licensee working the invention within the United Kingdom on a commercial scale and at a reasonable profit ;
- (b) to guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the Comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom or if he fails so to work the invention within the time specified in the order.

(5) In deciding to whom such an exclusive licence is to be granted the Comptroller shall, unless good reason is shown to the

contrary, prefer an existing licensee to a person having no registered interest in the patent.

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the Comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the Comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention.

(7) Every application presented to the Comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The applications must be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

(8) The Comptroller shall consider the matters alleged in the applications and declarations, and, if satisfied that the applicant has a *bona fide* interest and that a *prima facie* case for relief has been made out, he shall direct the applicant to serve copies of the application and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent and shall advertise the application in the Official Journal (Patents).

(9) If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall within such time as may be prescribed or within such extended time as the Comptroller may on application further allow, deliver to the Comptroller a counter-statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.

(10) The Comptroller shall consider the counter-statement and declarations in support thereof and may thereupon dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the Comptroller himself appoints a hearing. In any case the Comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon

matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.

(11) All orders of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the *Attorney-General* or such other counsel as he may appoint shall be entitled to appear and be heard.

(12) In any case where the Comptroller does not dismiss an application as hereinbefore provided, and

(a) if the parties interested consent : or

(b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Comptroller conveniently be made before him :

the Comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the Comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the Comptroller under this section, and, where a question or issue of fact is so referred the arbitrator shall report his findings to the Comptroller.

(13) For the purposes of this section, the expression "patented article" includes articles made by a patented process.

Section 83A, which enacts the effect which an order for the grant of a license shall have in law, is as follows :—

Section 83A :—

"83A. Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee (or *proprietor of a registered design as the case may be*) and all other necessary parties.

Section 24 which concerns regulations affecting the "licenses of right" to which reference is made in Section 27 is as follows :—

"24. (1) At any time after the sealing of a patent the Comp-

troller shall, if the patentee so requests, cause the patent to be indorsed with the words "licences of right", and a corresponding entry to be made in the register, and thereupon—

- (a) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in default of agreement, may be settled by the Comptroller on the application of either the patentee or the applicant :

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this sub-section as if they had been imposed by the Comptroller thereunder in like manner as if the terms had been settled by the Comptroller ;

- (b) in settling the terms of any such licence the Comptroller shall be guided by the following considerations—
  - (i) he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights ;
  - (ii) he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom ;
  - (iii) he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted :

Provided that in considering the question of equality of advantage, the Comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom.

- (c) any such licence the terms of which are settled by the Comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation ;
- (d) every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register ;
- (e) if in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a licence upon terms to be settled by the Comptroller, no injunction against him shall be awarded and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement :

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods ;

- (f) the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The Comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the Official Journal (Patents) and shall satisfy himself that the patentee is not precluded by contract from making

such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary :

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences.

(3) Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the Comptroller within the prescribed time and in the prescribed manner, and the Comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement if already made, to be cancelled.

*(4) Where a patent of addition is in force any request made under this section for an indorsement either of the original patent or of the patent of addition shall be treated as a request for the indorsement of both patents, and if refused as respects the one shall be refused as respects the other also, and where a patent of addition is granted in respect of a patent which is indorsed under this section the patent of addition shall also be so indorsed.*

(5) All indorsements of patents under this section shall be entered on the Register of Patents and shall be published in the Official Journal (Patents), and in such other manner as to the Comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.

(6) The Comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, cancel the indorsement and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made.

*Provided that before acting on any application for the cancellation of an indorsement, the Comptroller shall advertise the application in the prescribed manner and shall satisfy himself that there is no existing licence or that all existing licensees consent to the application.*

(7) *Any person may within the prescribed time and in the prescribed manner, give notice at the Patent Office of opposition to an application for the cancellation of an indorsement and where any such notice is given the Comptroller shall, after giving notice of the opposition to the applicant and after giving to the applicant and to the opponent an opportunity of being heard, decide on the case.*

(8) *Any decision of the Comptroller under this section shall be subject to an appeal to the Court.*

#### **Summary of the history of the law in the United Kingdom :**

It is thus seen that there have been the following changing policies in the United Kingdom :—As to the tribunal empowered to order the remedies for an abuse by the Patentee of his Monopoly : in 1883, this was the Board of Trade : in 1902 the Board of Trade plus the Judicial Committee of the Privy Council : in 1907 the Board of Trade plus the Court (in respect of section 24), and the Comptroller with a right of appeal to the Court (in respect of section 27): in 1919 the Comptroller with a right of appeal as mentioned in the Act of 1919 to the Court, and in certain cases with power for the Comptroller to refer certain matters to arbitration : the act of 1928 did not affect this matter. At the present day : the tribunal is the same as in 1919.

As to the remedies which that tribunal was given power to enforce : 1883 the power was restricted to ordering compulsory licenses : in 1902 the power granted was not restricted to granting licenses but was extended to revocation : in 1907 these powers were continued but it is to be noted that whereas under the 1902 Act both remedies either of revocation or compulsory licenses were open in a case of manufacture exclusively or mainly outside the U. K. under the 1907 Act only the remedy of revocation could be resorted to in such a case : in 1919 these powers were further extended and elaborated so as to include :—

(i) compulsory ordinary licenses.

(ii) granting an exclusive licence to the applicant.

(iii) ordering an endorsement of "licenses of right" such licenses of right being created for the first time by the Act of 1919.

(iv) ordering revocation of the patent, or,

(v) making no order.



Any one of these various remedies being equally available in a proper case. The act of 1928 did not affect these matters. At the present day : the remedies available are the same as in 1919.

As to the grounds on which the remedies could be exercised these were broadly speaking :—

In 1883 :

- (i) reasonable requirements of the public not supplied.
- (ii) interference with the working of an invention of a third party :
- (iii) non-working in the United Kingdom.

In 1902 :

- (i) reasonable requirements of the public not satisfied (i.e. (a) an existing or new industry unfairly prejudiced or (b) demand for patented article not reasonably met.)
- (ii) manufacture exclusively or mainly outside the United Kingdom.

In 1907 :

- (i) reasonable requirements of the public not satisfied (i.e. (a) default of patentee to manufacture adequately or to carry on the patented process adequately or to grant licenses on reasonable terms so as to result in an existing or new industry being unfairly prejudiced or so as to result in demand being not reasonably met, or (b) any industry being unfairly prejudiced by conditions imposed by the patentee.)
- (ii) manufacture exclusively or mainly outside the United Kingdom.

In 1919 :

- (i) demand not met to an adequate extent or on reasonable terms.
- (ii) existing or new industry of the United Kingdom prejudiced by refusal of patentee to grant licenses on reasonable terms.
- (iii) existing or new industry of the United Kingdom prejudiced by conditions imposed by patentee.
- (iv) non-working in the United Kingdom on a commercial scale.
- (v) working in the United Kingdom being hindered by importation from abroad by patentee or his sub-purchasers.

It should be noted that the above grounds were all referred to under the 1919 Act under the general term of an "abuse of monopoly

rights" and that the following proviso was expressly made applicable to all the said grounds :—

"that for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage inventions but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay."

The 1928 act is not material for the present purpose.

At the present day : the grounds are the same as those stated above with reference to the Act of 1919 plus the following additional sixth ground (created by section 27(2)(f) of the present Patent Act 1907 to 1932) :—

(vi) Use by the Patentee of the existence of his patent so as unfairly to prejudice the manufacture, use or sale by a third party of certain materials not protected by the patent.

#### **Previous Indian Law.**

The first statutory provision in British India directly intended to prevent the abuse of the monopoly by the patentee appears to have been the Act of 1883, the material provisions of which were as follows :—

#### **Indian Law : in 1888.**

By Section 43 :—

"43. If on the petition of any person interested it is proved to the Governor General in Council that, by reason of an inventor who has acquired an exclusive privilege under this Part failing to grant licenses on reasonable terms—

(a) the exclusive privilege is not being worked in British India, or

(b) the reasonable requirements of the public with respect to the invention cannot be supplied, or

(c) any person is prevented from working or using to the best advantages an invention of which he is possessed, the Governor General in Council may order the inventor to grant or may himself on behalf of the inventor grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Governor General in Council, having regard to the

nature of the invention and the circumstances of the case, may deem just."

It is seen that this section of the Indian Act of 1888 is taken from the English Act of 1883 (see page 270 above) the wording of Section 22 of which it follows almost verbatim: the only material difference being that the tribunal, in which the power to issue the compulsory licenses is vested, is, in this case, the Governor General in Council.

This was directly followed by the Act of 1911. To make the position in all respects clear, it will be as well to set out here the material provisions of that Act as originally passed, which were as follows :—

#### **Indian Law : in 1911.**

By Section 22 :—

"22. (1) Any person interested may present a petition to the Governor General in Council, which shall be left at the Patent Office, together with the prescribed fee, alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory license, or, in the alternative, for the revocation of the patent.

(2) The Governor General in Council shall consider the petition, and if the parties do not come to an arrangement between themselves, the Governor General in Council may, as he thinks fit, either dispose of the petition himself or refer it to a High Court for decision.

(3) The provisions of sub-section (4) of section 15, prescribing the procedure to be followed in the case of references to the Court under that section, shall apply in the case of references made to the Court under this section.

(4) If the Governor General in Council is of opinion, or where a reference has been made under sub-section (2) to a High Court, that Court finds, that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered to grant licenses on such terms as the Governor General in Council or the High Court as the case may be, may think just, or if the Governor General in Council or the High Court is of opinion that the reasonable requirements of the public

will not be satisfied by the grant of licenses, the patent may be revoked by order of the Governor General in Council or the High Court :

Provided that an order of revocation shall not be made before the expiration of four years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

- (a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licenses on reasonable terms, any existing trade or industry or the establishment of any new trade or industry in British India is unfairly prejudiced, or the demand for the patented article or the articles produced by the patented process is not reasonably met ; or
- (b) if any trade or industry in British India is unfairly prejudiced by the conditions attached by the patentee before or after the commencement of this Act to the purchase, hire or use of the patented articles or to the using or working of the patented process.

(6) An order of the Governor General in Council or of the High Court directing the grant of any license under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and made between the parties to the proceeding.

By Section 23 :—

“23. (1) At any time not less than four years after the date of a patent granted under this Act, any person may apply to the Governor General in Council for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside British India.

(2) The Governor General in Council shall consider the application and, if after inquiry, he is satisfied—

- (a) that the allegations contained therein are correct ; and

- (b) that the applicant is prepared, and is in a position to manufacture or carry on the patented article or process in British India ; and
- (c) that the patentee refuses to grant a license on reasonable terms ;

then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in British India, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Governor General in Council may make an order revoking the patent either—

- (i) forthwith ; or
- (ii) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within British India to an adequate extent.

(3) No order revoking a patent shall be made under the last sub-section which is at variance with any treaty, convention arrangement or engagement with any foreign country or British possession.

(4) The Governor General in Council may, on the application of the patentee, extend the time limited in any order made under sub-section (2), clause (ii), for such period not exceeding two years as he may specify in a subsequent order, or revoke any order made under sub-section (2), clause (ii) or any subsequent order if sufficient cause is in his opinion shown by the patentee."

These provisions of the Indian Act of 1911 followed closely those of the English Act of 1907.

### **Present day law in British India.**

The material provisions of the current Indian Act are contained in Sections 22, 23 & 23A of the Act of 1911 as amended by the Act of 1930. For convenience of reference these are set out here in full with those passages which differ from the 1911 Act in italics: viz :—  
Section 22 :—

"22. (1) Any person interested may present a petition to the

Governor General in Council which shall be left at the Patent Office together with the prescribed fee, alleging that the demand for a *patented article in British India is not being met to an adequate extent and on reasonable terms* and praying for the grant of a compulsory license, or, in the alternative, for the revocation of the patent.

(2) The Governor General in Council shall consider the petition and if the parties do not come to an arrangement between themselves the Governor General in Council may, as he thinks fit, either dispose of the petition himself or refer it to a High Court for decision.

(3) The provisions of sub-section (4) of section 15, prescribing the procedure to be followed in the case of references to the Court under that section, shall apply in the case of references made to the Court under this section.

(4) If the Governor General in Council is of opinion, or, where a reference has been made under sub-section (2) to a High Court, that Court finds, that the *demand for the patented article in British India is not being met to an adequate extent and on reasonable terms* the patentee may be ordered to grant licenses on such terms as the Governor General in Council or the High Court, as the case may be, may think just, or, if the Governor General in Council or the High Court is of opinion that the *demand will not be adequately met* by the grant of licenses, the patent may be revoked by order of the Governor General in Council or the High Court ;

Provided that an order of revocation shall not be made before the expiration of four years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(5) For the purposes of this section the *demand for a patented article shall not be deemed to have been met to an adequate extent and on reasonable terms* :—

- (a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licenses on reasonable terms, any existing trade or

industry or the establishment of any new trade or industry in British India is unfairly prejudiced, or

- (b) if any trade or industry in British India is unfairly prejudiced by the conditions attached by the patentee to the purchase, hire or use of the patented article or to the using or working of the patented process.

“23. (1) At any time not less than four years after the date of a patent granted under this Act, any person may apply to the Governor General in Council *for relief under this section* on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside British India.

(2) The Governor General in Council shall consider the application, and, if after inquiry, he is satisfied :—

- (a) that the allegations contained therein are correct ; and
- (b) that the applicant is prepared, and is in a position to manufacture or carry on the patented article or process in British India ; and
- (c) that the patentee refuses to grant a license on reasonable terms ;

then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in British India, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Governor General in Council may make an order :—

(a) revoking the patent either—

(i) forthwith ; or

(ii) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within British India to an adequate extent, or

(b) *ordering the patentee to grant a license to the applicant which may be a license exclusive to him or otherwise as the Governor General in Council may direct.*

(3) No order revoking a patent shall be made under the last sub-section which is at variance with any treaty, convention,

arrangement or engagement with any foreign country or British possession.

(4) The Governor General in Council may, on the application of the patentee, extend the time limited in any order made under sub-section (2) clause (ii) for such period not exceeding two years as he may specify in a subsequent order or revoke any order made under subsection (2) clause (ii) or any subsequent order if in his opinion sufficient cause is shown by the patentee."

Section 23 A :—

"23A. An order of the High Court under section 22 or of the Governor General in Council under Section 22 or *Section 23*, directing the grant of any license, shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and *executed by the patentee and all other necessary parties.*"

**Summary of the history of the law in British India.**

It is thus seen that the position in British India has been :— As to the tribunal empowered to order the remedies for an abuse by the Patentee of his Monopoly : in 1888 this was H. E. the Governor General in Council : in 1911 it was still H. E. the Governor General in Council, alone in regard to the powers under Section 23, but in regard to the powers under Section 22 it was H. E. the Governor General in Council with an alternative power either to dispose of the matter himself or to make a reference under Section 22(2) to the High Court : in 1930 the same : at the present day the same.

As to the remedies which that tribunal was given power to enforce :—In 1888 : the power was restricted to ordering compulsory licenses. In 1911 : the power granted was not restricted to granting licenses but was extended to revocation : it is to be noted that in a case of manufacture exclusively or mainly outside British India, the only remedy made available was revocation : In 1930 : the power of granting compulsory licenses in a suitable case was made available for a case of manufacture exclusively or mainly outside British India equally as on other grounds, and the remedies of compulsory licenses or revocation were continued. At the present day : the position is the same.



As to the grounds on which the remedies could be exercised these were broadly speaking :—

In 1888 :—

- (i) reasonable requirements of the public not supplied.
- (ii) interference with the working of an invention of a third party.
- (iii) non-working in British India.

In 1911 :—

(i) reasonable requirements of the public not satisfied (i.e. (a) default of patentee to manufacture adequately or to carry on the patented process adequately or to grant licenses on reasonable terms so as to result in an existing or new industry being unfairly prejudiced or so as to result in demand being not reasonably met ; or (b) any industry being unfairly prejudiced by conditions imposed by the patentee).

(ii) manufacture exclusively or mainly outside British India.  
In 1930 :

(i) demand of a patented article in British India not met to an adequate extent and on reasonable terms (i.e. (a) default of patentee to manufacture adequately or to carry on the patented process adequately or to grant licenses on reasonable terms so as to result in an existing or new industry being unfairly prejudiced or so as to result in demand being not reasonably met ; or (b) any industry being unfairly prejudiced by conditions imposed by the patentee).

(ii) manufacture exclusively or mainly outside British India.  
At the present day : the same.

### **Comparison between the Indian and English law.**

As to the Act of 1888, it is seen that this section of the Indian Act of 1888 is taken from the English Act of 1883 (see page 270 above) the wording of Section 22 of which it follows almost verbatim : the only material difference being that the tribunal, in which the power to issue the compulsory licenses is vested, is, in this case, the Governor General in Council.

As to the Act of 1911 as originally passed this was in effect precisely similar to the English Act of 1907 ; Sections 22 and 23 of the Indian Act of 1911 corresponding to Sections 24 and 27 respec-

ively of the English Act of 1907, except that it should be noted that whereas under the Indian Act of 1911 applications under both sections were required to be made equally to H. E. the Governor General in Council, under the English Act of 1907, on the contrary, while applications under Sec. 27 were to be made to the Comptroller (with a right of Appeal to the Court), applications under Sec. 24 were to be made to the Board of Trade who if satisfied of a *prima facie* case was to make a reference to the Court.

As to the Act of 1930 the objects of this Act appear from the Statement of Objects & Reasons in regard to Clause 16 of the Bill<sup>1</sup>. The object of the first amendment in Section 2 is said to have been merely to make the main ground of application for the grant of a compulsory license or revocation more clear. It does not purport to make any change in the law. In this connection it may be noted that though the phrase "that the demand of a patented article in British India is not being met to an adequate extent and on reasonable terms" is in the Indian Act by the amendment of 1930 substituted for the phrase "that the reasonable requirements of the public with respect to a patented invention have not been satisfied" which was used both in the English Act of 1907 and in the Indian Act as originally passed in 1911, yet the definition of the meaning of both these two phrases which is given in Section 22 (5) is verbatim the same. This seems conclusive proof that no alteration in the law was effected by the change of phrase. Another amendment was directed to empower H. E. the Governor General in Council to grant a license or exclusive license as an alternative remedy to revocation in a case of manufacture exclusively or mainly outside British India (under Section 23 (2)) in a suitable case. This has already been referred to in the summary above. Other amendments were directed to delete sub-section (6) of Section 22 (as to the mode of operation of any order made) and add a new section in similar terms but applicable both to Sections 22 and 23: that amendment makes no alteration in the grounds or remedies available. It is to be observed that these were all in the main minor amendments. The provisions of the English Act of 1919 as a whole have not been enacted in British India. In Particular no provision for the creation of "licenses of right" or for the order of the

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1. See App. No. 6 below.

compulsory endorsement of a Patent with the words "licences of right" has been brought into operation in British India. Neither as to the Tribunal nor as to the grounds nor as to the remedies (except to the extent above noted) does the Act of 1930 in any respect alter the Act of 1911 as originally passed. It is seen that the Indian Act of 1911 almost exactly reproduced the effect of the English Act of 1907, the Indian Sections 22 and 23 corresponding to the English Sections 24 and 27 respectively ; but the Indian Act as amended by the Act of 1930 does not reproduce the effect of the English Act of 1919. Indeed it appears doubtful what real advantage was sought to be gained (apart from the new Section 23A) by the alterations effected in Sections 22 and 23 by the Indian Act of 1930. Accordingly for all practical purposes the Indian Act of 1911 may be treated as identical with the English Act of 1907.

The English cases on the construction of the English Act of 1907 (up till 1919) may therefore usefully be taken as a guide to the construction of the Indian Act of 1911.

**As to the proper general construction of Sections 22 & 23 :  
whether a protective or a free-trade policy.**

It can be said that Section 22 "deals primarily with cases where the trade of this country has been injured by an abuse of the monopoly conferred by the Patent, irrespective of anything which is being done abroad." While Section 23 "deals primarily with cases where the object or the effect of the use of such rights in the way they have been used has been to favour the development of industries abroad" at the expense of industries in British India. And that "the Sections may sometimes overlap, but that is the broad dividing line between them."<sup>2</sup>

It has also been held, in the same case, in effect that the sections must be construed as intending to ensure that manufacturers or merchants in this country will at least enjoy equal advantages with manufacturers or merchants in other countries : but at the same time that the sections should not be construed as going so far as to intend to ensure that the manufacturers or merchants of this country should enjoy a protection not enjoyed by similar persons abroad. Whether this judicial interpretation pronounced in 1909

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<sup>2</sup> See *Hatschek's Patents* (1909) 26. R. P. C. 228.

would have by now acquired any additional gloss which would have given to it in England a more protective tinge must remain now a matter of conjecture ; since the English Act in question has long ago ceased to be the subject of any judicial interpretation. This is however the judicial interpretation which the sections acquired in England while in operation. It will be of interest to note here the carefully reasoned passage in the judgment of Parker J. where this construction was reached :—

“The question was much discussed as to whether anything more could be required of a patentee than to deal with this and other countries on the same terms and in the same manner, or whether the patentee is bound to exclude foreign goods altogether for the benefit of the trade of this country. It was argued that the mere fact that a patentee has allowed goods made abroad, whether under the Patent or resulting from the patented process, to be imported into this country, and to compete in this country with goods here, is an improper use of his patent rights. In other words, it was argued that the policy of Section 27, is not only to secure fair play for the traders of the United Kingdom but to give such traders a preference over foreign traders and prevent the latter from entering into competition with the former on equal terms so far as the patentee can, by an exercise of his monopoly, secure inequality. This argument in effect asserts that the policy of the Act is a protective and not a free-trade policy. Whatever be one's own personal views as to the advantage or disadvantage of a protective policy compared with a free-trade policy, I am not prepared to hold that a patentee who has allowed part of the demand in this country to be supplied by the importation of goods from abroad, has necessarily precluded himself from proving that the manufacture of the patented article, or the use of the patented process, in this country, is adequate within the meaning of the 27th Section, or from giving satisfactory reasons why it is not adequate. If this had been the meaning of the Legislature, I think that on so important a matter of principle, clearer words would have been used. The policy of the Section appears to me to be directed to securing fair play between foreign industries and the industries of this country, and not to secure for the latter during the period of the Patent a protection which they would not enjoy if no Patent had been granted, and

which the Legislature can always secure for them either temporarily or permanently, if and when, it considers fit."

Whether or not the Government of India in the coming industrial development of India will be satisfied with this "free trade" policy as being sufficient encouragement to indigenous industrial enterprise or whether they will prefer a more positive "protective" policy in respect of the working of Indian Patents in India is a matter of policy for their decision. Unless there is effected any amendment of the Sections, it is submitted that the judicial interpretation given above will be the one which should commend itself to the Courts in India. To put any other construction on the Sections 22 and 23 now would make for much uncertainty both among inventors and the public; who may it is submitted reasonably expect that the Sections will retain in India the same meaning which has been placed on the same words in precisely similar sections in the Courts in the United Kingdom.

**As to decisions bearing on the construction of Section 22.**

There appear to be no reported Indian decisions of any Petitions lodged under Section 22 of the Indian Act: as such decisions are made direct to H. E. the Governor General in Council and as there is no appeal from his decision these petitions do not come before the Courts. They are thus not reported in the Indian Law Reports.

There appears to be an almost equal scarcity of any reported English decisions of Petitions lodged under the precisely corresponding Section 24 of the English Act of 1907. The reason for this is no doubt somewhat similar. Such Petitions under such Section 24 were made, as already noted, to the Board of Trade in the first instance. They would accordingly not as a rule be reported in any English Law Reports. It is true that the English Act provided for a reference by the Board of Trade to the Court. But there do not appear to be any reported decisions of the Court on such a reference.

Some guidance as to the principles of construction to be employed may it is submitted be obtained from general observations contained in the reported English decisions on the other section (Section 27 of the English Act of 1907) corresponding to Section 23 of the Indian Act of 1911.

In addition to this, considerable assistance is to be obtained, it is submitted, from certain English cases which were decided on English Acts prior to the Act of 1907. The difference in general meaning between the phrases used in the Act of 1883 and in the Act of 1902 on the one hand and the phrases used in the Act of 1907 on the other hand is for many cases negligible. Therefore certainly the cases on the Acts of 1883 and 1902 are in point. It would seem also that as to general principles the more recent English cases on the Act of 1919-1932 may also be relied on as authority to show when the Court may be expected to enforce the remedies of compulsory licence or revocation for non-supply of the patented invention to the public in British India.

It may be observed that there appear to have been very few contested cases on this question of the extent of the obligation of the patentee to afford an adequate supply of the patented article in the United Kingdom and on the correlated question of the extent to which compulsory licences would be granted for the patentee's default. Probably it is correct to say that though resort to the statutory remedies in this respect was not of high frequency, yet the mere presence of these statutory enactments gave the aggrieved party a sufficiently strong weapon in his bargaining negotiations for the grant of a licence to effect in practice the purpose for which they were enacted; and to ensure a sufficiently adequate supply on sufficiently reasonable terms of the patented article.

As to what amounts to the "demand not being met to an adequate extent and on reasonable terms": and as to what amounts to "unfairly prejudiced" within the meaning of Section 22 of the Indian Act.

The English decisions in the following cases brought under the English Act of 1883 (the wording of which has been set out earlier in this chapter) are of interest as instances showing in what nature of circumstances and on what grounds recourse may be had to a Petition for a compulsory licence. In two of the cases referred to it is clear that a compulsory licence would have been issued had it not been, in one case, for the offer made by the Patentee; and but for the fact that it was shown in the other case that the applicant company was not in a position to manufacture in the event of any

compulsory licence being granted. In the third case a compulsory licence was ordered.

(i) In the case of *the Incandescent Gas Light Company's Patent (Meteor Petition)*,<sup>3</sup> the position was complicated by a certain pending suit for infringement but the principal matters of interest for the present purpose are these. The Incandescent Gas Light Co. Ltd. (to whom reference will be made as the Patentee Company) was the patentee in respect of two patents being No. 15286 of 1885 and No. 124 of 1893. These patents related to "the manufacture of an illuminant appliance for gas and other burners" and to "an improvement in incandescent burners" respectively. A company of which the full name was the Continental Gas Gluhlicht Actien Gesellschaft "Meteor" vormals Kroll, Berger and Co. but to which reference will be made for brevity as the Meteor Company was the owner of a Patent No. 24083 of 1896 (originally granted to one Thompson) relating to "Improvements in burners for incandescent petroleum lamps." It seems that the Meteor Coy. had agreed to grant the exclusive right of manufacturing lamps under its Patent to a company styled the Stock and Debenture Corporation Ltd.

On the 18th February, 1897 a letter had been addressed (by Thompson) to The Incandescent Gas Light Company Ltd., as follows :—

"I have recently patented an invention for an incandescent petroleum lamp, No. 24083 of 1896, as a communication from abroad. In order to develop the same commercially in this country, I or my principals will require the use of a mantle containing thorium, of which substance I understand you claim the monopoly for this purpose. Will you kindly inform me on what rate of royalty and on what terms you will grant a licence to import such mantles from abroad for use for such patented lamp. I should also be glad to know whether, and on what terms, you would be disposed to undertake to supply mantles equal in quality to those you supply for the gas burners to be used with the said lamp. Awaiting the favour of an early reply, I remain." On the 22nd February, 1897, the Patentee Company had replied as follows :—

"In reply to your enquiry of the 18th instant, we are not disposed to grant any license or to supply mantles."

The Petitioners then lodged their Petition in which they contended that by reason of the aforesaid default of the Patentee company to grant a licence on reasonable terms under their said patents, the petitioners were prevented from working or using to the best advantage the said invention of patent No. 24083 of 1896; and further that the reasonable requirements of the public with respect to the invention of the Patentee Company could not be supplied.

The Petition was presented by both the Meteor Company and the Stock Corporation.

The Board of Trade being of opinion that a *prima facie* case for relief had been made out, appointed Mr. Roger W. Wallace Q. C. as Referee to hear the petition and to report; and the matter was heard before him as Referee. On behalf of the Patentee Company it was urged that it had not been made out by the Petitioners that the Patentees had been guilty of any default within the meaning of Section 22, of the Patents &c., Act, 1883, and that under the circumstances no unreasonable refusal on the part of the Patentees had been shown. It was also submitted that the Stock and Debenture Corporation Ltd. were not in such a position as to warrant the grant of the licence to them.

During the course of the hearing the Stock and Debenture Corporation withdrew from the Petition.

An application was then made for leave to amend the petition by asking for the grant of a licence to The Meteor Company on their giving an undertaking to manufacture in this country and the Referee was asked to give his decision on this point before going any further, and it was said that if the decision was against the Petitioners, there would be an end of the matter. The Referee intimated that he was against the Petitioner's Counsel on this point; and could not allow such amendment. It was in these circumstances that the Referee's decision came to be made recommending the dismissal of the Petition. As was pointed out by the Referee the procedure was that he reported to the Board of Trade and the Board of Trade gave the decision. Finally by the Order of the Board of Trade, which was made on the 19th of May 1898, the petition was dismissed.



(ii) See *Levinstein's Petition*.<sup>4</sup> The Farbwerke vormals Meister Lucius and Bruning carrying on business at Hoechst-am-Maine in Germany (to whom reference will be made for brevity as the Patentee Company) were the patentees in respect of two English patents No. 9642 of 1889 relating to "the production of oxysulphonic acids of naphthaline" and No. 15176 of 1889 for "Improvements in the production of amido-naphthol-mono-sulphonic acids and the manufacture of their diazo compounds and azo colouring matters therefrom."

It appears that Levinstein Ltd. was a company carrying on manufacture on a large scale as manufacturing chemists at Manchester. They had for a long time been engaged in the production of colouring matters and were the owners of several patents for new dye-stuffs. They desired to manufacture these new dye-stuffs but these could only be manufactured by employing the patented processes of the Patentee Company. Prior to the filing of the Petition there was correspondence between the Levinstein Company and the Patentee Company in which the former asked for and the latter refused a licence. The Levinstein Co. then filed the Petition for a compulsory licence on the grounds in effect the Patentee Company had wholly failed to introduce the use of their patented processes into the United Kingdom, that the Levinstein Coy. was well able to introduce and carry on the manufactures if licensed so to do, that the Levinstein Company had applied to the Patentee Company for a licence but that the Patentee Company had refused and still refused to grant any such licence as was necessary to enable the Petitioners to introduce the patented manufactures within the United Kingdom and to work and use to the best advantage the said inventions of which the Petitioners were possessed. They prayed for an order under Section 22 of the English Act of 1883 that the Patentee Company should grant to the Levinstein Company a license under the two patents of the Patentee Company upon the terms set out in a Schedule to the Petition or upon such other terms as might be just. The letters which comprised the correspondence before suit as well as the matter contained in the Petition and also the terms of the compulsory licence prayed for, which were stated in the said Schedule, are all fully reported in the report in 15. R. P. C. 732 ; and are instructive. The Board of Trade considered that a *prima*

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<sup>4</sup> (1898) 15. R. P. C. 732.

*facie* case had been made out and ordered that the matter should proceed ; and appointed Mr. R. Wallace Q. C. as referee to hear the Petition. At the hearing it was argued in effect for the Patentee Company that they had not been guilty of any "default" within Section 22 of the English Act of 1883. That the Patentee Company had always offered to sell their goods to the Petitioners at a fair price. And that there had never been any default to grant licenses by the Patentee Company on reasonable terms. That though the Patentee Company did not manufacture in the United Kingdom it had always been ready to sell at a reasonable figure. Up till that date there had been no demand in the United Kingdom for their acids. That the Levinstein Company could not make the materials any cheaper than the Patentee Company. No license to make should be granted. The point was also pressed that an applicant for a license under the Section could not assert that because in other countries in which he wished to compete there were no patents, the Patentee in England therefore should be compelled to be put on such terms that the applicant could successfully compete with the free traders in those other countries.

It was argued for the Petitioner Company in effect that the Patentee Company only held its patents in England for the sake of blocking trade. That the original idea of granting a patent to an importer of an invention was as a reward for the introduction of the invention : reference was made to Coke's Institutes Vol. 3 page 184. In this case there had been no introduction. The Patentee Company did not work any of its patents in England, nor had it granted licenses to anyone in England, nor did it wish to, nor would it. There was therefore default. If there had been no patents in England the processes would have been worked. As to sub-section (b), the requirements of the public were shown by their desire for the Petitioner Company's dyes. As to sub-section (a), it was clear that the Petitioner Company was prevented from working its own inventions to the best advantage. The Referee evidently reported to the effect that a compulsory license should be issued. And upon consideration of the Referee's Report the Board of Trade made an order granting a compulsory licence. For convenience of reference it may be worth while to set out here the terms of such order and the terms of the Schedule referred to in that Order by which the terms of the compulsory license were stated.

## THE ORDER

After reciting Section 22 of the English Act of 1883 the order proceeded as follows.

“And whereas, on the 11th of June 1889, a patent numbered 9642 was granted to Oliver Imray, of 28, Southampton Buildings, London, patent agent, for an invention communicated to him by The Farbwerke vormals Meister Lucius, and Bruning, of Hoechst-am-Maine, in the German Empire (hereinafter called the Patentees), relating to the production of oxysulphonic acids of naphthalin : And whereas, on the 24th of May 1892, the said patent was duly assigned by the said Oliver Imray to the Patentees, which said assignment was, on the 27th of May, 1892, duly registered at the Patent Office : And whereas on the 26th September, 1889, another patent numbered 15176 was also granted to the said Oliver Imray for an invention, in like manner communicated to him by the Patentees, relating to improvements in the production of amidonaphthol-mono-sulphonic acids, and the manufacture of their diazo compounds and azo colouring matters therefrom : And whereas, on the 24th of May, 1892, the said patent was assigned by the said Oliver Imray to the Patentees, which said assignment was, on the 27th of May, 1892, duly registered at the Patent Office : And whereas the Petitioners presented a petition to the Board of Trade under the said section for an order that the Patentees, under the said Letters Patent No. 9642 of the 11th of June, 1889, and No. 15176 of the 26th of September, 1889, should grant to the Petitioners a license under or in respect of the inventions described and claimed in and by the Specifications of the said repective Letters Patent : And whereas, on consideration of the said petition and of the matters therein mentioned, it has been proved to the Board of Trade that the said Petitioners are persons interested in the matter of the said Petition, and that by reason of the default of the Patentees to grant licenses on reasonable terms the said patents are not being worked in the United Kingdom, and that by reason of the default aforesaid the said Petitioners are prevented from working and using to the best advantage certain inventions of which they are possessed : Now, therefore, the Board of Trade, in exercise of the power conferred upon them by Section 22 of the Patents, Designs, and Trade Marks Act, 1883, and of all

other powers enabling them in this behalf, do hereby order as follows :—

(1) That a license, to take effect from the date of this Order and in the form set forth in the Schedule hereto, be forthwith granted by the Patentees to the Petitioners to make, use, exercise, and vend within the United Kingdom the inventions described and claimed in and by the Specifications of the said Letters Patent Nos. 9642 and 15176 of 1889 for the unexpired residues of the respective terms of the said Letters Patent at a royalty of one half penny for each pound weight avoirdupois of products made by the licensees under the said Letters Patent or either of them, but so that in each year a minimum royalty of £250 per annum shall be paid by the licensees, and the Patentees shall forthwith deposit such license duly executed by them with the Board of Trade.

(2) The said Petitioners, before the 6th day of August 1898, shall execute and deposit with the Board of Trade a counterpart license in the form aforesaid, and in default of their doing so this Order shall be of no effect.

Dated this 6th day of July, 1898.

(Signed) Courtenay Boyle,  
Secretary, Board of Trade."

### THE SCHEDULE

The Schedule was worded as follows :—

"This indenture, made the                      day of                      , between The Farbwerke vormals Meister Lucius, and Bruning, of Hoechst-am-Maine in the Empire of Germany (hereinafter called the Patentees), of the one part, and Levinstein, Ltd., and Ivan Levinstein, managing director of Levinstein, Ltd. of Minshall Street, Manchester, in the county of Lancaster (hereinafter called the licensees), of the other part : Whereas, by an Order of the Board of Trade dated the 6th day of July, 1898, and made under Section 22 of the Patents, Designs, and Trade Marks Act, 1883, it was ordered that a license, to take effect from the date of the said Order, should be granted by the Patentees to the licensees to make, use, exercise, and vend the inventions described in the Letters Patent hereinafter mentioned (to the benefit of which the Patentees are entitled) in the form set out in the Schedule to the said Order, being the form of these presents :

Now, this indenture witnesseth that in pursuance of the said Order the Patentees do hereby grant to the licensee license within the United Kingdom to make, use, exercise, and vend the inventions described and claimed in and by the Specifications of the Letters Patent Nos. 9642 and 15176 of 1889 mentioned in the said Order : to hold, exercise, and enjoy the said license for and during all the residues now to come and unexpired of the respective terms of the said Letters Patent and during any further term for which the said Letters Patent or either of them may be extended ; and the licensees hereby covenant with the Patentees that the licensees will, during the continuance of this license, pay to the Patentees half-yearly, on every 6th day of January and 6th day of July, royalties at the rate of a half penny for each pound weight avoirdupois of product made by the licensees under the said Letters Patent or either of them in the half years then ending respectively : Provided always that if the royalties payable in any year ending on the 6th day of July shall not have amounted to the sum of £250 the licensees shall, on such 6th day of July, pay to the Patentees such further sum as with the said royalties shall amount to the said sum of £250 hereinafter called the yearly rent. The licensees do hereby also covenant with the Patentees that the licensees will, during the continuance of the license, keep proper accounts in separate books containing full particulars of all products made by them under this license, and of all other things which may be material for the purpose of showing the amounts payable to the Patentees by way of royalty, and will at any time produce the same for the inspection of the Patentees or any person appointed by them, who shall be at liberty to make copies from or extracts from any of the accounts or matters therein contained, and that the licensees will within ten days after each of the half-yearly days aforesaid deliver to the Patentees an account in writing, showing all the particulars and matters aforesaid with respect to the products made during the preceding half year : And it is hereby agreed and declared that the Patentees shall be at liberty at any time during the continuance of this license to enter upon any factory or place of business of the licensees in which manufacture of the said products shall be carried on at any reasonable hour with a view of obtaining all such information as may be material for the purpose of ascertaining the amount of royalty payable to them

under this license : And it is hereby also agreed and declared that if any payment of royalties or yearly rent under this license shall be in arrear for one month after the same shall have become due (whether payment thereof shall have been demanded by the Patentees or not), or if the licensees shall make default in the performance of any obligation on their part herein contained, and shall not have made good the same within fourteen days after the Patentees shall have by notice in writing required them to do so, then the Patentees may, with the consent of the Board of Trade, by notice in writing to the licensees revoke this license as from the date of such notice without prejudice to the right of the Patentees to recover any monies then due hereunder : And it is hereby also, agreed and declared that if the said Letters Patent or either of them shall become void, or shall be declared by a Court of Law to be void, the licensees may, with the consent of the Board of Trade, by notice in writing to the Patentees, revoke this license.

As witness, &c."

(iii) See *Bartlett's Patent (the Gormully and Jeffery Mnfg. Co's Petition)*.<sup>5</sup> The material facts in that case were these. In 1890 Bartlett had obtained a patent (No. 16783 of 1890) for an Invention relating to an improvement in tyres or rims for cycles or other vehicles. At the date of the Petition now under consideration this patent was vested in the Dunlop Pneumatic Tyre Co., Ltd. The Gormully and Jeffery Manufacturing Company was a company which manufactured and sold tyres and rims for cycles : they were the proprietors of another patent (No. 5370 of 1894) granted to one Lorraine for Improvements in wheels. Desiring to manufacture certain wooden rims in combination with a particular kind of tyre which they were unable to do without a license from the Dunlop Company, they brought this Petition for a compulsory license. Previous to the filing of the petition they had written to the Dunlop Company asking if they would grant them a license and stating they would pay royalty at the highest rate that the Dunlop Company received from anyone. Previous to the filing of the Petition there were also interviews between the Solicitors of the parties at which it had been stated by the Solicitor for the Dunlop Company that that Company had purchased the Patent

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<sup>5</sup> (1899) 16. R.P.C. 641.

(Bartlett's Patent) upon a condition that they granted one license to one W. E. Bartlett and that they might grant besides that, only one other license ; and that they had already granted that one other license to a certain Company being the Clipper Pneumatic Tyre Co., Ltd. It had been suggested by the Gormully Company that the Dunlop Company and Bartlett and the Clipper Company might join in granting the license asked for ; but nevertheless the Dunlop Company had refused to grant a licence. The Gormully Company then by this Petition applied to the Board of Trade for a compulsory license. That the license in question was a valuable one and the question in issue important sufficiently appears from the fact that the North British Rubber Co., Ltd. who had been the owners of Bartlett's Patent previously to the Dunlop Co. had assigned their ownership, on terms reserving a license to themselves, for £200,000 sterling ; and that the Clipper Company had paid £70,000 for the license which they had acquired from the Dunlop Company. The grounds of the Petitioners case were in effect that their own Patent was one of utility to the public, for which there had been an extensive use in the United States ; and that they could not manufacture their article without a license from the Dunlop Company ; and that in view of the refusal of the Dunlop Company to comply with their request for a license, they were entitled to claim the issue of a compulsory license.

The Petition was opposed not only by the Dunlop Company but also by the North British Rubber Company Ltd. and the Clipper Pneumatic Tyres Company Ltd. who both gave notice of objection and applied for leave to appear and take part in the proceedings. They alleged, for various reasons, that they were each interested in the matter and in effect that the grant of any further license additional to those already existing would be highly prejudicial to their interests. The North British Rubber Co. Ltd. stated that at the date of their notice of objection they were licensees of Bartlett's Patent ; that they had at some previous time been the owners of that Patent but had assigned it for £200,000 and for the license they then held. They also stated that the present owners had bound themselves to grant only one other licence ; that this had been granted. Leave was granted to both Companies to appear and take part in the proceedings. The Board of Trade appointed Mr. W. R.

Bousfield Q. C. Referee to hear the Petition and report. It was objected to the Petition that the Petitioners were an American Company and ought not to be allowed to compete with English firms. As to this the Referee indicated that he might require an undertaking that the Petitioners proposed to manufacture in England and that the Petitioners were prepared to work under the license if granted.

After a good deal of discussion as to whether or not it was necessary that the Petitioners should seek the relief asked for against all the three companies mentioned, the Petition for greater safety was finally amended by adding the words "and the North British Rubber Company Ltd. and any other person interested in the Patents" after the name of the Dunlop Pneumatic Tyre Company Limited.

During the hearing eventually a certain offer to manufacture and supply on certain terms to the Gormully Company the tyres required was made by the North British Rubber Co. Ltd. There then followed some discussion as to whether this offer was a reasonable offer or not: the Referee holding in effect that apart from any question of costs if the offer was a reasonable offer, even though it was made after the Petition had been filed and was part-heard, the Board of Trade would not resort to issuing a compulsory license provided it was satisfied that the offer was made *bona fide*. After argument it was held that the offer was a reasonable offer. The Referee asked the Petitioners whether or not they were willing to accept the offer. On the Petitioner refusing to accept the offer, the Referee recommended to the Board of Trade that the Petition, in view of the offer, should be dismissed. And eventually the Board of Trade agreeing with the report of the Referee dismissed the Petition. During the hearing it was pointed out on behalf of the Petitioners how they might suffer in the case of an offer being made so late by having to pay the costs of the expensive proceedings without any remedy: this was commented upon but in view of the Act it was held impossible for the Board of Trade to grant any costs in respect of the Petition in such a case.

#### **Reported decisions bearing on the construction of Section 23 of the Indian Act.**

In respect of Section 23 of the Indian Act equally as for Section 22 there are no reported Indian decisions. In this instance



the position is however different in regard to the precisely corresponding English section (section 27 of the English Act of 1907). For not only has that section been very carefully considered by the Supreme Court in England when Petitions under that section have come before the English Court on appeal from the Comptroller and those cases have been reported ; but several cases of the decisions in the first instance of the Comptroller have also been reported in the Official English Reports of Patent Cases. The principles laid down in those English decisions are therefore directly and precisely in point in considering the proper construction of Section 23 of the Indian Act of 1911.

**As to what amounts to "manufactured exclusively or mainly outside British India" within Section 23(1).**

These phrases have been judicially considered and construed in the following interesting and illuminating passages in the judgment of Parker J. in *Hatschek's Patents*<sup>\*</sup> thus :—

"The first question is this, what is the state of circumstances the existence of which imposes this serious liability on a patentee. In the words of sub-section 1 it is whenever "the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom." There is no difficulty in the use of the word "exclusively", but the use of the word "mainly" gives rise to the difficulty. The sub-section may, and it was argued that it did, include every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom. If it is the true meaning, then in every case in which more than 50 per cent of the patented articles manufactured anywhere are manufactured abroad, the patentee can be called upon to justify the use he has made of his monopoly and to defend his patent rights. I cannot think that this is the true meaning of the sub-section. However great may be one's belief in the industrial supremacy of the inhabitants of these islands, it would at least be somewhat arrogant to assert that wherever the manufacture of a patented article in the United Kingdom is less than one-half of the total manufacture of the whole world, there arises a presumption that British trade has not had fair play—a presumption that the patentee

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\* (1902) 26. R. P. C. 228 at p. 240.

has been abusing his monopoly. If the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected having regard to the industrial development of other countries I do not think any presumption against the patentee can fairly arise, nor do I think that the Legislature intended it should arise. The word "mainly" is used in the sub-section in close connection with and as an alternative to the word "exclusively," and, having regard to this fact, I do not think that a process or article can be said to be mainly carried on or manufactured abroad merely because it is carried on or manufactured abroad to a somewhat greater extent than within the United Kingdom. For example, if the total manufacture in the United Kingdom were 1200 and the total manufacture elsewhere 1250, giving a total 2450 in all, I do not think it could be said that the manufacture was mainly abroad within the meaning of the Section; to come within the sub-section the disparity must, in my opinion, be greater than a mere small percentage, and indeed if the article be manufactured or the process be carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is done abroad, I do not think the state of circumstances is that contemplated by sub-section 1.

It was further argued before me that sub-section 1 institutes a comparison, not between the extent to which an article or process, the subject of a British Patent, is manufactured or carried on in this country and the extent to which it is so manufactured or carried on abroad, but between the number of patented articles made abroad, either in accordance with the Specification, or by means of the process described in the Specification and imported into this country and the number of such articles so made in this country. This argument was based on the use of the word "patented", it being contended that the use of this word showed that the Legislature was only referring to what was done within the area of the monopoly created by the patent and that the manufacture of the articles or the carrying on of the processes abroad did not come within the area of the monopoly unless and until the goods manufactured, or the goods resulting from the process were imported into this country. I cannot conceive that if the Legislature had meant this it would not have said it in plainer words. In my opinion, therefore, the sub-section institutes a compari-

son between the extent to which the article or process, the subject of the Patent, is manufactured or carried on in this country, and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured or resulting from the process so carried on abroad are or are not imported into this country. I have come to this conclusion more easily because the real strength of the argument to the contrary consisted in considering how far-reaching would be the effect of the Section if I gave the words in the Section their *prima facie* meaning and at the same time held that whenever the article or process was manufactured or carried on to a greater extent abroad than in the United Kingdom, the case was within sub-section 1. As I have already held that this is not so, there is nothing to justify me in departing from the plain words.

It has also been suggested that the sub-section only institutes a comparison between what is being done abroad and at home respectively by the patentee, his licensees and agents, and that what is done otherwise may be left out of account. I cannot think that is the true meaning of the Section. Suppose the patentee had no foreign patents, and yet for some reason of his own chose to prevent the industry arising here, while industries in the patented article or process were being developed abroad, I think the Section would apply. It seems to me that the Section is meant to hit any abuse of the monopoly, the object or result of which was to benefit foreigners at the expense of the traders within the United Kingdom."

As the material phrases in the Indian Act are the same it is submitted that the principles enunciated in that case will be equally applicable to British India.

As to what amounts to "adequate extent" and "satisfactory reasons" within section 23(2).

These phrases also were considered and construed in the same judgment : thus :—

"I will pass now to the other sub-section, assuming that the Applicant has satisfied the Comptroller that the state of circumstances contemplated by the first sub-section has arisen. The patentee is then clearly on his defence and must either prove that the article or process is manufactured or carried on in the United Kingdom to an adequate extent, or give satisfactory reasons why it is

not so manufactured or carried on. The difficulty in construing these provisions arises from the use of the somewhat elastic expressions "adequate" and "satisfactory", the meaning of which depends largely on the point of view from which the facts which may be proved are considered. In my opinion the Legislature has used these somewhat vague expressions advisedly, it being left to the Comptroller, subject to an appeal to the Court, to determine in each case, and having regard to all the circumstances, whether the extent to which the article or process is manufactured or carried on, is adequate, and if not, whether the reasons put forward are satisfactory. I shall not, therefore, attempt to define the meaning of these expressions, but in considering any case which may arise, there are, in my opinion, one or two general observations, which ought to be borne in mind. First, as I have already said, the patentee is on his defence, and this being so, I do not think the extent to which the article is manufactured, or the process carried on, can be considered adequate if it be less than it would have been, but for the fact that the patentee has exercised the rights conferred by his Patent to the hurt of British industry,—for example the fact that he has given foreign traders a preference over British traders. Similarly, I do not think that any reasons can be satisfactory which do not account for the inadequacy of the extent to which the patented article is manufactured or the patented process is carried on in this country by causes operating irrespective of any abuse of the monopoly granted by the Patent. The first thing therefore, for the patentee to do is, by full disclosure of the manner in which he has exercised his Patent rights, to free himself from all suspicion of having done anything to hamper the industry of the United Kingdom. When once he has satisfied the Comptroller of this, he will have gone a long way towards proving what he has to prove, and even if he cannot prove adequacy, he ought to be able to show satisfactory reasons for inadequacy. This construction of the Act is in accordance with Article II of the 1902 Convention which provides that no Patent is to be revoked in any country, which is a party to the Convention, until three years at least from the date of application for the Patent, and then only if the patentee cannot show reasonable cause for his inaction. It is therefore the conduct of the patentee which is in question. Has he done anything which he ought not to have done, or omitted to do anything which he ought to have done,

having regard to his obligations towards the traders of this country ? In considering the conduct of a patentee various questions may arise as to whether he has or has not exercised his rights fairly and properly, having regard to the interests of the trade of the United Kingdom, and for the most part these questions must be decided with reference to all the circumstances of the particular case, including, I think, the nature of the patented invention. But a patentee certainly ought not to give foreigners any preferential terms in the grant of licences or otherwise, nor ought he to utilise the period prescribed by sub-section 1 in developing foreign industries as opposed to the industries of the United Kingdom, and at the end of the period seek to defend his conduct by offering to grant licences in this country on the same terms as he has granted them abroad. If he exercises his rights in such a way as to give other countries four years start of this country in developing a new industry, he is not, in my opinion, exercising his rights fairly as regards the trade of this country. He must at least take the same pains to develop the new industry here as he does abroad.” .....

(The learned Judge then considered whether the policy of the Section was protective or free trade in the passage already cited :<sup>7</sup> and continued).

“It follows from what I have said above that “adequate” cannot mean simply adequate to supply the demand in this country, or be considered only with reference to the demand in this country for the patented article or the article produced by the patented process. The demand in this country may in some cases not only be a demand for the patented article but a demand for the patented article as made by a particular firm or as made abroad. If, for example, the Patent be for a new article, and such article be manufactured both here and abroad, and part of the demand here be for the article made abroad, because it is got up more to the taste of a section of the public, I do not think that the manufacture here could on that account alone be said to be inadequate. To so hold would, in effect, be to force a patentee to use his patent rights to exclude altogether the import of foreign goods. I agree that the demand and supply in this country are to be considered, though they are not the only

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<sup>7</sup> See page 307 above.

facts to be considered upon the question of adequacy. If there was insufficient manufacture here to meet the demand for the home-made article, it might well be that the manufacture might be held to be inadequate, but, even if there were no demand here at all, the manufacture might be inadequate because the rights of the patentee might have been so exercised as to preclude the growth of a demand by the imposition of unreasonable prices or unreasonable terms for licences, or simply because the patentee had wholly neglected this country in his efforts to develop a foreign trade. Every case must be considered on its own merits and with reference to its own attendant circumstances.

It was suggested that if a patentee could prove that an industry in a patented article or founded on a patented process could not be carried on in this country or as profitably as it could be carried on abroad owing to difference in the cost of material or labour, or other local conditions, he would have given a satisfactory reason within the meaning of the Section. I do not think this suggestion is entirely correct. Certainly the fact that persons who were carrying on the industry in this country would make smaller profits than persons carrying it on abroad would, in my opinion, be no satisfactory reason at all. I can conceive cases in which a patentee having obtained a Patent may find it impossible to work it in the United Kingdom because of the nature of the invention, or because of local conditions which prevail here, but not in other countries, although these cases must, I think, be rare, and may be exceedingly difficult to prove. The extra cost of labour or material may well be counter-balanced by superior skill or in other ways. But it can never in my opinion, be sufficient for a patentee, defending himself under the Section, to prove that he cannot now start an industry with any chance of profit. The question really is : could he have done so if he had used his monopoly fairly as between home and foreign trade, or if he had devoted the time and money which he has expended in developing a foreign industry to developing a home industry ? It may well be that having developed the industry abroad and given foreigners several years start, he may find it difficult, if not impossible, to develop an industry on the same lines here, and yet such an industry might well have arisen but for the preference he has given to foreign countries. It was also suggested that the Section only

contemplates revocation, if revocation would lead to the establishment of a new industry or the further development of an existing industry in this country, so that if the patentee had by an abuse of monopoly succeeded in precluding the possibility of such establishment or development, his Patent ought not to be revoked. I dissent entirely from this suggestion. I see no reason why the Section should not have been intended to penalise a patentee who has abused his monopoly and by a revocation of the Patent this country becomes at any rate free from restraint on its trade which is opposed to the spirit of its common law."

It is submitted these principles are also equally applicable to British India.

### Various English Cases.

The following cases may usefully be referred to :

(i) *Johnson's Patent*.<sup>9</sup> In that case, which related to a patent for improvements in sewing machines, the Patentee admitted that the machines made in accordance with the patented invention were wholly made abroad : the defence was that it was contended that owing to the special tools and the high precision of manufacture required, certain important parts could not be made in the United Kingdom or could only be made with great difficulty and expense and delay. It was held after a consideration of the Particular circumstances of that case that satisfactory reasons for non-manufacture had not been given ; and an order was made revoking the Patent forthwith.

(ii) *Worring and Kortenbach's Patent*.<sup>9</sup> The demand for the patented article in the United Kingdom was in connection with manufacturing umbrellas in the United Kingdom almost solely for export and sale abroad. In that case the Patentees maintained that they had misunderstood the meaning of the Section ; as they had been under the impression that the Act merely required them to supply the patented article to the public in the United Kingdom and that they had complied with the requirement by supplying it to their depots in London, Manchester & Glasgow. They did not contend that the patented article had been manufactured to an

\* (1909) 26. R. P. C. 52.

\* (1909) 26. R. P. C. 163.

adequate extent in the United Kingdom; and they asked to be allowed time for making arrangements for the article to be manufactured in the United Kingdom and for thereby complying with the section. An order was made that the Patent should be revoked forthwith. The Comptroller-General in the course of his decision observed :—"It seems to me that, if I were to comply with the Patentees' request to allow them further extension of time in order that they may manufacture the Patented article in this country, I should be establishing a precedent to the effect that any Patentee, who has failed to comply in any way with the requirements of the section until after an application has been made to revoke his Patent may have an extension of time allowed him for complying with the section, provided that he merely maintains that he has misunderstood its meaning. I therefore order, subject to an appeal to the Court, that the Patent be revoked forthwith and that the Patentees pay to the Applicants the sum of 30 guineas in respect of their costs."

(iii) *Ilgner's Patent*.<sup>10</sup> As to certain points relating to onus of proof, evidence, and procedure: also concerning concurrent remedies.

(iv) *Hatschek's Patent*.<sup>11</sup> The rulings in this case have already been noted above.

(v) *Weber's Patent*.<sup>12</sup> In that case it was admitted that the process had been carried on exclusively abroad, but it was contended that satisfactory reasons had been given for non-working in the United Kingdom. The principal reasons alleged were that:—(1) W. had made repeated and *bona fide* efforts to sell or licence the patented process in this country. (2) W. had treated this country fairly, and had not given any preference to foreign countries. (3) The failure to work had been due to the conservatism of English manufacturers; and (4) W. had now entered into a *bona fide* contract giving an option to purchase the Patent rights for this country. An order was made that the patent would be revoked, not forthwith, but at a later date (after 9 months) unless in the meantime it was

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<sup>10</sup> (1909) 26. R.P.C. 198.

<sup>11</sup> (1909) 26. R.P.C. 1. and 228.

<sup>12</sup> (1909) 26. R.P.C. 300.



shown to the Comptroller's satisfaction that the patented process was carried on to an adequate extent in the United Kingdom.

(vi) *Boull's Patent*.<sup>13</sup> In that case there was found to be a substantial working in the United Kingdom at the date of the hearing of the application though there had been no manufacture at the date when the Application was filed. The Application was refused : but without costs. The following general observations made by the Comptroller General in the course of his decision will also be of interest :—"In conclusion, I desire to make a few observations, on some of the arguments addressed to me by the Patentees' Counsel. I understood them to maintain that it was enough for the Patentees to show in these cases that they had made genuine and *bona fide* efforts to carry out the obligations enforced on them by the Act, and that if I am satisfied of that, I ought not to consider whether they might not have taken more efficient or more businesslike steps to attain this end. I cannot assent to this argument. I think that in this case, as in every other case which is tried by a judge or jury, the standard to be applied is what a reasonable man or a reasonable business man should do in the circumstances. It is not enough for the efforts to be sufficient in the patentees' own estimation ; they must conform to the standard which an intelligent business-man, in this country, would place before himself and adopt. Otherwise a foreigner might excuse himself for doing little or nothing here, by urging that he had done his best according to the standard of his own country, or his own peculiar notions of business requirements. It was also urged that there was no obligation on the part of a patentee to show any substantial manufacture here, until a demand for the patented article or process had arisen or been created. In my view it is not possible to accept the argument thus widely stated. The consideration of the adequacy of manufacture in this country does, no doubt, depend to some extent upon the demand existing for the article here or in neutral markets, but it does not follow that, if there is no demand existing, there is no obligation on a Patentee to start an industry here. If he does in fact manufacture in foreign countries and if there is in fact a demand for the article or process abroad, the absence of any demand here does not seem to be a valid excuse. The Patentee must, in such cases, make an effort to create

a demand here, and the establishment of an industry will in itself help to create in many cases a demand for the article or process in question. Stress was also laid on the fact that the article in question was a complicated and delicate piece of mechanism, and it was stated that many of the parts could not be properly manufactured here. I think it possible that there may be exceptional instances in which this is the case, but I shall be slow to believe without the strongest evidence that manufacturers and workmen of this country are incapable of turning out even the finest and most delicate machinery. In this case I am satisfied from the evidence that the manufacture of the machine as a whole would present no real difficulties to the engineering firms of this country."

(vii) *Boult's Patent*.<sup>14</sup> In that case the application was dismissed with costs.

(viii) *Lake's Patent*.<sup>15</sup> In that case the patent related to "improvements in sound-magnifying horns for phonographs and the like." It was held by the Comptroller in construing the Specification that the real invention of the patentee had been sufficiently manufactured in the United Kingdom: that although a sound-box was claimed in combination there was no claim for any special form of sound box; and that it was not necessary therefore for the sound box to be manufactured in the United Kingdom. That the applicant had not discharged the onus cast upon him under Section 27(1). It was also held that what the "patented article" is in each case must be determined after an examination of the Specification as a whole. Also in accordance with the decision in *Hatschek's* case it was held that the patentee should not be called upon to produce his witnesses before the Comptroller until a *prima facie* case had been made out by the Applicant. The Application was dismissed with costs. The following observations contained in the decision may be of interest:—

"The declarations of the Applicant, apart from allegations as to the wholesale importation of infringing machines (which it is suggested is acquiesced in by the Patentees) were directed only to showing by evidence that the sound boxes used in

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<sup>14</sup> (1909) 26. R.P.C. 427.

<sup>15</sup> (1909) 26. R.P.C. 443.

connection with the special form of sound-magnifying horn under the Patent, are all made in the United States. There is no evidence or suggestion that the sound-magnifying horn itself is wholly made abroad. The Patentees' evidence on the contrary is to the effect that 11,000 of these special horns have in fact been made by Edison and Swan in this country. The Applicant's Counsel admitted that they could carry the case no further at the hearing unless they could obtain admissions from the Patentees' witnesses, or were allowed to raise the whole question of adequate manufacture under Sub-section 2, and they asked me to allow them to cross-examine the Patentees' witnesses. Applying the principles laid down in *Hatschek's case*<sup>10</sup> it appears to me that until a *prima facie* case is made out by the Applicant under Sub-section (1) of Section 27, I can neither allow a cross-examination of the Patentees' witnesses, nor ought I myself to call or examine witnesses for the purpose of assisting the application. When a *prima facie* case has been made different considerations may no doubt arise, and the questions of adequate working, or "sufficient reasons" under Sub-section (2) may have to be investigated.

In this case, as the Applicant produced no further evidence in support of his case and was not prepared to call the Patentees' witnesses as his own, I have to decide on the Declarations before me, whether the Applicant has made out a *prima facie* case in support of the allegations that the patented article is mainly or exclusively manufactured abroad. The only evidence that I can find relates to the manufacture in the United States of the sound boxes used in connection with the patented horn, and if a sound box were the "patented article" it is possible that a *prima facie* case might be raised, I have therefore to decide what the patented article really is; and whether the evidence relating to the manufacture of the sound boxes abroad is relevant to the issues raised in this case. It appears to me that I can only decide this question by a careful construction of the Patentees' Specification. It has been laid down by numerous authorities that a Specification must be construed like an ordinary legal document. It must be construed as a whole, taking into consideration the title, the description, and the illustrations which are annexed. Particular Claims are not to be isolated but are to be

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<sup>10</sup> (1909) 26 R. P. C. 238.

read in connection with the description &c, of the invention, and bearing in mind the existing state of the art of which the Court is assumed to have knowledge."

(ix) *Bremers & Hogner's Patents*.<sup>17</sup> It was held by Parker J. in effect that the Patents Act of 1907 was not intended to penalise want of success where a Patentee had done his best and that their want of success up to that time in establishing their industry had been due to circumstances beyond their own control and not to the manner in which they had exercised their rights conferred upon them by the Patent in question. The order prayed for revocation was refused.

(x) *Kent's Patent*.<sup>18</sup> On the facts of that case the Application for revocation was refused.

(xi) *Osborn's Patent*.<sup>19</sup> On the facts of that case a defence based on absence of demand for the Patented article in the United Kingdom was held to be a sufficient reason ; and the application for revocation was dismissed.

(xii) *Jottrand's Patent*.<sup>20</sup> In that case the application was dismissed : but it should be noted that the Comptroller emphasised during his decision that on that application, under Section 27 of the English Act, he had no power to make any order except for revocation and had no power as an alternative remedy to make an order for compulsory licenses. He pointed out that many of the arguments addressed to him appeared to be more suitable for a Petition for a compulsory license. In this respect in reading such a case the English law as it then stood must be distinguished from the present Indian Law under which it would be open in such a case for an order for a compulsory license to be made.

(xiii) *Fell's Patent*.<sup>21</sup> In that case though there was undoubtedly some manufacture within the United Kingdom, it was held that no sufficient reasons had been given for the earlier inaction of the Patentees or for the lateness of the attempt they had made. The Patent was ordered to be revoked forthwith.

<sup>17</sup> (1909) 26. R.P.C. 449.

<sup>18</sup> (1909) 26. R.P.C. 666.

<sup>19</sup> (1909) 26. R.P.C. 819.

<sup>20</sup> (1909) 26. R.P.C. 830.

<sup>21</sup> (1910) 27. R.P.C. 25.

(xiv) *Mercedes Patent*.<sup>22</sup> This was an application on the part of Fiat Motors Ltd. for the revocation of seven patents of the Mercedes Daimler Motor Co., Ltd. In this case the chief point in dispute was whether a manufacture in the United Kingdom by infringers, apart from or in addition to any manufacture by the Patentees or their licensees, can be relied on by the Patentees in establishing an adequate extent of manufacture of the "patented article" in the United Kingdom. It was held that the term "patented article" (in Section 27(1) of the English Act of 1907 means an article which is the subject of a British Patent and is manufactured in accordance with the Specification or by means of the process therein described, by whomsoever manufactured, and that consequently manufacture by infringers in this country must be taken into account in favour of the Patentee under the Section 27(1). The decision of the Comptroller refusing the application for revocation was upheld on appeal by Parker J.

It is submitted, as the wording of the Indian Act is the same as that considered in that case, the principle is equally applicable in British India.

(xv) *Taylor's Patent*.<sup>23</sup> On the particular facts of that case on appeal from the Comptroller's decision after considerable argument it was held by Parker J. that no order of revocation should be made. It was pointed out however by the Court that the dismissal of the application would not prejudice any future application for revocation if, when circumstances had altered, there was or continued to be a neglect to work the invention within the jurisdiction.

The cases above referred to are all cases which arose in connection with Section 27 of the English Act of 1907 and will therefore be equally applicable generally on questions of construction arising on Section 23 of the Indian Act of 1911 which is now operative in British India.

### **Compulsory Licenses.**

Since the amendment effected by the Indian Act of 1930, compulsory licenses may be obtained equally under Section 22 and under Section 23 ; just as an order for revocation may be made equally under section 22 and section 23.

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<sup>22</sup> (1910) 27. R.P.C. 762.

<sup>23</sup> (1912) 29. R.P.C. 296.

**As to "patented article".**

The term "patented article" has been construed so that it includes articles manufactured by persons other than the patentee or his licensees : as was held, for example, in the application for revocation of the Mercedes Patent.<sup>24</sup>

**At what stages objections for non-working or non-supply may be raised in British India (and in what form).**

Since any objections for non-working or non-supply cannot be thought of until a patent has been granted to the patentee against whom the complaints are to be made, it is obvious that, unlike other objections, whereby the invalidity of the patent may be urged, these objections cannot be made at any stage except after the grant. These objections do not go to the root of the patent in the sense that if these objections are established it results in the patent having been bad *ab initio* : if these objections are established it results in what has till then been a good patent being terminated and revoked.

Under the Indian Act of 1911 it is provided that no order on an objection for non-working or non-supply can be made until after four years from the date of the patent (under Section 22(4) and Section 23(1)). On the wording of Section 22 it seems possible that a petition could be presented at any time after grant, though no order could be made on it until after 4 years after grant : under Section 23 it is clear that no petition can be presented until 4 years after grant.

In all cases the objections are raised by way of Petition to H. E. the Governor-General in Council under those sections ; H. E. the Governor-General in Council may refer petitions under Section 22 to the High Court : petitions under Section 23 are decided by H. E. the Governor-General in Council in all cases.

These objections as to non-working or non-supply can also be taken as a defence in an infringement suit by virtue of Section 29(2) of the Indian Act of 1911.<sup>25</sup>

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<sup>24</sup> See further comments above at page 332.

<sup>25</sup> See *Fletcher Moulton* p. 304 : and See *Thermos Ltd. v. Isola Ltd.* (1910) 27. R.P.C. 195 (C.A.) ; *Vidal Dyes Syndicate v. Read Holliday & Sons Ltd.* (1911) 28. R.P.C. 323. (C.A.) ; *Saccharin Corp'n. Ltd. v. National Saccharin Coy. Ltd.* (1909) 26. R.P.C. 737 & (1910) 27. R.P.C. 354 (C.A.) *Colman v. Cook & Co.* (1912) 29. R.P.C. 175 ; and cf. *Badische Anilin etc. v. W. G. Thompson & Coy. Ltd.* (1904) 21. R.P.C. 473 (prior to the 1907 Statute).

## **CHAPTER IX**

### **PROCEDURE RELATING TO APPLICATIONS FOR PATENTS IN BRITISH INDIA—TO WHOM A PATENT MAY BE GRANTED—APPLICATIONS BY THE TRUE AND FIRST INVENTOR: ORDINARILY OR AS COMMUNICATEE FROM ABROAD—BY HIS LEGAL REPRESENTA- TIVE—BY HIS “ASSIGN”—RECIPROCITY APPLICATIONS—QUALIFICATIONS OF THE APPLICANT—THE STAGES OF PROCEDURE BETWEEN APPLICATION AND GRANT OF THE PATENT (WHEN UNOPPOSED)— OBJECTIONS FROM THE PATENT OFFICE PRIOR TO ACCEPTANCE OF THE APPLICATION.**

**To whom a Patent may be granted in British India : qualifications  
of the Applicant.**

Under Section 3 of the Indian Patents & Designs Act of 1911 it is provided as follows :—

“3(1) An application for a patent may be made by any person whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor or the legal representative or assign of such inventor and for which he desires to obtain a patent, and must be accompanied by a specification and by the prescribed fee.

(4) Where the true and first inventor is not a party to the application, the application must contain a statement of his name,

and such particulars for his identification as may be prescribed, and the application must show that he is the legal representative or assign of such inventor."

Therefore it follows that either the applicant (or at least one of the applicants when there are more than one) must be what the law regards as "the true and first inventor" or the applicant (or at least one of the applicants when there are more than one) must be either the legal representative or what is described in the Section as the "assign" of the true and first inventor.

**As to application by the true and first inventor himself.**

An underlying principle of all Patent Laws in all countries and of all systems of Patent administration has been the reward of the true and first inventor of a new invention, by the benefits of a monopoly to be granted to him rather than to anyone else. The true and first inventor therefore in India, as in the United Kingdom, has always been entitled to make the application himself, in his own name, for the grant of a Patent.

The question who is entitled to describe himself as the "true and first inventor," and the meaning of the term, has already been discussed and defined in a preceding chapter.<sup>1</sup>

The form of application to be used in such case is Form No. 1 of the forms given in the Second Schedule of the Indian Patents & Designs Act of 1911.<sup>2</sup>

It is to be observed that if a person who desires to make such an application is, at the time, in person outside British India, there is nothing to prevent him availing himself of the facilities of the post in order that he may himself have the advantages of being in the position of a true and first inventor within British India : and there is nothing to prevent such a person in this way from making the application himself in his own name : signing the requisite application form himself abroad, and posting it, either direct to the Indian Patent Office or to his Patent Agent in India to be presented by the Patent Agent at the Indian Patent Office.

In the latter case the Patent Agent will present the application at the Patent Office in Calcutta on behalf of and as agent for

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<sup>1</sup> See Chapter VII p. 248 et seq.

<sup>2</sup> See Appendix No. 5 below.



the true and first inventor, in whose name the application will be made. In either case the Patent if granted will be granted in the name of the person who is actually abroad. The rules require that the applicant will give an address for service within British India (i.e. Rule 4).<sup>3</sup> These rules will in all respects be complied with if the true and first inventor, though himself abroad, gives the address of his Patent Agent in British India.

**As to application (by a person who is the true and first inventor) on a communication from abroad.**

As previously noted, a person, being himself in this case in British India, may still be the true and first inventor for all purposes of Patent Law (even though he has in common parlance himself invented nothing) if he, in British India, has only acquired knowledge of the invention by a communication from another person who is abroad.

In such a case he would appear to be neither doing anything wrong nor stating anything inaccurate if he were to make the application on Form No. 1, which is the ordinary form for use where the application is made by the true and first inventor.<sup>4</sup> For reasons of convenience however, in order to distinguish cases where the true and first inventor is the true and first inventor only by reason of a communication from abroad, a separate form, being Form No. 1B is prescribed under the Act for use by an applicant for grant of a Patent on a communication from abroad. This Form No. 1B is the proper form for use in these cases.<sup>5</sup> That there is no question but that the applicant in this case is making the application in the full capacity of being himself the true and first inventor, is made clear by the retention in the form of the same words:—"that I (or we) claim to be the true and first inventor(s) thereof." Indeed the two forms in both cases are word for word the same except that Form 1B contains, after the words "that I am (or we are) in possession of an invention for....." the additional words "which invention has been communicated to me (or us) by....." <sup>6</sup>

<sup>3</sup> See Appendix No. 5 below.

<sup>4</sup> See *Avery's Patent* (1887) 36 Ch. D. 307 at p. 316 ; Terrell (8th edn.) p. 15.

<sup>5</sup> See Appendix No. 5 below.

<sup>6</sup> As to cases where the invention is partly originally invented and partly communicated ; *Moser v. Marsden* (1893) 10. R. P. C. 350 at p. 359.

The application for Patent is in all these cases made, of course, in the name of the communicatee; and the Patent, if granted, is granted directly in his name.

The facilities of this method of application may be regarded as being conveniently available to assist especially in the progressive development of new industries and manufactures in British India and to foster the introduction, wherever beneficial, of new commercial, agricultural or industrial processes and machines into this country. It being an established principle of Patent Law that the person who is the communicatee on a communication from abroad of an invention is himself the true and first inventor within British India, it is immaterial who is the communicator outside British India. It is true that the form of application requires that the applicant, the communicatee, shall state the name of the communicator; but this provision would appear to have been inserted merely for purposes of record which may serve thereafter as an index of the bonafides of the application, in the event, later on, of any dispute arising to which the origin of the communication may be relevant. The communicatee in no respect depends, for his status of true and first inventor or for his right to make the application, on any status or rights previously possessed by the communicator.

This method of application (i.e. on a communication from abroad) is also commonly used where there is a person abroad who is interested to obtain a Patent in British India, when he is content that the actual grant may be made in the name of another person, such as his Patent Agent, who is resident in British India. In a case where a Patent Agent thus obtains a Patent in his own name, as communicatee, he will be under a legal duty to hold the Patent in trust for the benefit of the person abroad. In most such cases an assignment will be arranged for of the Patent after grant by the Patent Agent in British India to the person abroad, who will thereafter become the registered owner of the Patent. This method of application has in such cases the advantage that once the person abroad has communicated the particulars of the invention to the Patent Agent in British India there is no need to be troubled with any of the subsequent proceedings relative to the obtaining of the grant.

This method is particularly useful also, in cases where the

person interested in the obtaining of the Patent is abroad, where it is of urgent importance to save time in making the application ; and where it is not feasible to obtain the preparation and signature of the application Form by the person who is actually abroad in sufficient time to enable the papers to reach the Indian Patent Office by a specific desired date. In special cases it is even occasionally possible for the necessary communication of the invention to be made by cable by the person abroad to a Patent Agent in India who will then lodge the necessary application in the capacity of a communicatee.

It may be noted however that in the use of this method of application by a person, who is abroad, and desires to have the benefit of an Indian Patent to be thus granted in the name of another person as communicatee, he will be more amply safeguarded, where such other person is a Patent Agent, in the United Kingdom than he will be in British India. For in the United Kingdom there is the direct protection afforded by the Rules of the Chatered Institute of Patent Agents of the United Kingdom which expressly forbid Patent Agents (who are in the United Kingdom necessarily fellows of that Institute) from themselves having any interest in a Patent : while in India, there being no corresponding Institute of Patent Agents of India and no such Rules, this protection is generally speaking absent ; that is to say except in so far as a person practising in British India may be a Fellow of the Institute of Patent Agents of the United Kingdom and to that extent be governed by the Rules applicable in the United Kingdom.

**As to Application by a legal representative of the true and first inventor.**

In the United Kingdom even prior to the Act of 1932, it appears to have been the practice of the Patent Office in the United Kingdom in a case where an application for a Patent has been made by the true and first inventor and he has died after application but before grant, to make the grant in the name of the legal personal representative of the deceased ; if the Patent Office has had notice of his death.<sup>7</sup>

In the United Kingdom, further, by virtue of the special pro-

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<sup>7</sup> See Fletcher Moulton p. 253.

visions of Section 43 of the English Acts of 1907-1932 it is provided that "if the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to his legal representative." By Section 43(2) further provision is made that in such case the legal representative must make a declaration "that he believes the deceased to be the true and first inventor of the invention." Also under Section 93 of the English Patents & Designs Act 1907-1932 it is provided that the word "inventor" and "applicant" is to include the legal representative of a deceased inventor or applicant. The result is that it is clear that in the United Kingdom, in the event of the death of the true and first inventor before application, application may then be made by his legal representative.

The position is substantially the same in British India.

Under the wording of Section 3, quoted above,<sup>8</sup> express provision is made for an application for the grant of a Patent being made by a person who is the legal representative of the true and first inventor.

The proper form is then Form No. 1A.<sup>9</sup>

For the purposes of the Patent Office, in order that a person may establish that he is the legal representative of the true and first inventor, all that is necessary is for him at the time of lodging the application, to "produce for inspection the probate of the will or the letters of administration of the estate of the inventor or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require."<sup>10</sup>

It may be noted that in the case of an application for Patent being made in the name of B in his capacity as legal representative of A, while the Patent if granted will in every case be granted in the name of B, yet it may frequently happen that B will be under a legal duty to hold the Patent for the benefit of A's estate. If necessary B may assign the Patent itself after grant to the person or persons who are shown to have become entitled to it on A's death in succession to him.

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<sup>8</sup> See page 334.

<sup>9</sup> See Appendix No. 5 below.

<sup>10</sup> i. e. Rule 10(3) : see Appendix No. 5 below.

It would appear that in a case where application is made by a person abroad as legal representative of the true and first inventor, such person equally as in a case of an application by the true and first inventor himself, may adopt the facilities afforded by the Post Office, if such person desires to make the application in his own name; either posting the requisite form of application direct to the Indian Patent Office in India or to a Patent Agent in India for presentment by him to the Indian Patent Office.

**As to application by an "assign" of the true and first inventor.**

In this respect until the year 1932, there was a marked difference between the English and the Indian Acts in regard to the persons by whom application for a Patent might be made.

In the United Kingdom prior to 1932, all along, save for the exceptional provisions concerning applications after the death of the true and first inventor by his legal representatives, it had never been open to any person who was not himself the true and first inventor to apply for the grant of a Patent in his own name.

In British India ever since the Act of 1859 (see Secs. 4 and 38 thereof) and under all sub-sequent Acts, provision has all along existed for an application being made by a person who was an "assign of the true and first inventor."

In the United Kingdom by an amendment made in the British Patents & Designs Act of 1932, provision has now for the first time been made allowing the grant of a Patent to be made to a person who is an "assign . . . .". The result is that the position in this respect is, generally speaking, in both countries now for the first time the same.

This being one of the few occasions on which the English Statute has been altered so as to follow the Indian Act, it may therefore be supposed that some practical benefit has been found to exist in a provision allowing the application to be made by a person who can call himself an assign of the true and first inventor.<sup>11</sup>

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<sup>11</sup> The cause of the amendment in England appears to have been due to certain matters relating to international obligations with foreign countries. It appears that in the United Kingdom the application is still required to be made in the name of the true and first inventor, though the Patent may be granted from the first in the name of the person who is the "assign": see Sec. 1 (unaltered) of the English Acts 1907-1932 and Sec. 12 (as amended by the 1932 Act).

At the same time it may be observed that it is somewhat difficult to define the meaning of the phrase "assign of the true and first inventor", used as it is in regard to a situation prevailing before any grant of Patent has come into existence. Clearly, it is submitted, there can properly speaking be no property either in English law or in Indian law in a bare invention or idea prior to the grant of a Patent. Therefore there can be no one, it is submitted, legally speaking to whom as the so-called "assign" any right of property in the invention before the grant of Patent can be transferred. It would seem therefore that by this phrase no reference can be intended to a person who is the legal representative or assign in respect of the invention so as to be a transferee thereof. A person may exist, of course, who is the legal representative of a deceased inventor in general : and it can be understood that by Statute such a person is granted a right of making application for a Patent after the death of the original true and first inventor. But the word "assign" does not seem capable of bearing such a meaning. For there cannot, one supposes, be a person who is the "assign" in general of another person dead or alive. He must, it would seem, be an assignee of certain particular rights. If so, then of what rights ? A mere idea, which is all that an invention before the grant amounts to, is not a chose in action or anything of such a nature as to be capable, it is submitted, of assignment under the Indian Transfer of Property Act : it is submitted it is not a thing capable of assignment either under Indian or English law. It might be said that what is meant by the phrase is the person who is the assignee from the true and first inventor of the right which the true and first inventor had to make an application for Patent at the Patent Office. It would seem extremely doubtful however whether any such right ever exists : or if it does exist whether it can from the nature of things be assignable. It would seem on the contrary from its nature to be a right personal to the true and first inventor. However the phrase has been used in Patent Acts for many years in India ; and the system of allowing a nominated substitute of the true and first inventor to apply instead of the true and first inventor has apparently been worked with success in many countries. It is submitted that the word assign then means nothing more than a "nominee" ; or a person to whom the original true and first inventor has given express consent for his making an application for a Patent in respect of a particular inven-

tion in place of the original true and first inventor himself, who at the same time undertakes not to make any application for the Patent himself. For it is comprehensible that the true and first inventor may agree by personal contract that he will not make any application in his own name and that he will not take any objection against another person's making an application, provided that other person is allowed in law to do so. And it is comprehensible that by statute that other person may be expressly allowed to make such an application and to receive a grant of a Patent in his own name. Otherwise for any wider meaning than this, the word "assign" in this context becomes somewhat incomprehensible.<sup>12</sup>

Whether a transaction which is to be relied on as a so-called "assignment" within the meaning of Section 3 of the Act, is required to have all the requisites of a valid personal contract, such as good consideration, or whether a bare expression of authority from the so-called assignor even without any consideration is sufficient, does not appear to have been decided : nor whether such expression of authority is required to be in writing or oral in order to be binding.

It is submitted that generally speaking in order to constitute an assignment within the meaning of Section 3 of the Indian Patents & Designs Act, such as to be in law binding on the person making it, there will be required to be a contract between the so-called assignor and so-called "assignee" with good consideration : that such a contract may be either oral or in writing : but if it be in writing that it should then be stamped with a twelve annas stamp under Article 5(c) of the Indian Stamp Act. On the other hand it might well be in a particular circumstances, where the true and first inventor had given a bare expression of consent to another person to make application for a Patent and that other person had acted thereon and altered his position accordingly, that as between them the true and first inventor would be estopped on general principles of estoppel from denying that the other person was an "assign" within the meaning of the Section.

The proper form to be used in the case of an application for a Patent where the applicant is an "assign" of the true and first inven-

<sup>12</sup> See also Edmunds at p. 196 : where it is pointed out that "an inventor has by law no property in his invention, and no interest in it recognizable by law except under a patent." He refers also to Hindmarch 233.

tor is the same Form No. 1A as is used by an applicant who is a legal representative of the true and first inventor.

For the purposes of the Patent Office, in order that a person may establish that he is entitled to make an application for a Patent in the capacity of an "assign of the true and first inventor," all that is required is in effect that he should either "produce the original deed of assignment or other document from the true and first inventor under which he is enabled to apply for a Patent" or have "the application itself endorsed by the true and first inventor in the presence of two witnesses with a statement that the said inventor agrees that the application shall be made without his name as an applicant for patent."<sup>13</sup>

The form of such endorsement, which is couched as a letter of authority addressed to the Controller, is given as a supplement to Form No. 2 in the Second Schedule of the Act ; and is worded as follows :—

To

The Controller of Patents and Designs,  
1, Council House Street, Calcutta.

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Endorsement by Inventor (see Rule 10(2)).

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I (or we).....

.....  
referred to on the reverse of this document as claiming to be the true and first inventor(s) agree that the said application be made without my (or our) name (s) as (an) applicant (s) for a patent.

Dated this       day of       19  
(Signed).....

Signature of two witnessess.

1.....

2.....

This method of application is commonly adopted and is particularly useful where it is desired that a Patent should be granted in

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<sup>13</sup> Rule 10 (2) See Appendix No. 5 below.



the name of a limited Company from the first. A limited Company though it has not the capacity to apply as a true and first inventor itself, is yet fully capable of applying as an assign of the true and first inventor for a grant of a Patent in its own name.

The method is also similarly available where the grant of the Patent is desired to be obtained in the name of a partnership firm from the first.

Instances frequently arise where an employee of a company or of a firm by reason of the terms of his employment is bound to make over all benefits of inventions achieved by him to the company or firm by whom he is employed. In such a case though the true and first inventor is the employee, the requisite application for Patent may be made under Form No. 2 by the Company or firm by whom he is employed, in the capacity of his assign.

#### **Foreign Companies.**

A practice appears to be in existence, which is an extension in a sense of the course last mentioned, of using this method of application to enable limited companies registered and carrying on business only outside British India to make application for Patents in British India in circumstances, where the so-called assignment has been outside British India from an employee of the company who is working outside British India, whose name is given as the purported true and first inventor : the application for Patent and the grant of the Patent, if granted being in such cases made in the name of the foreign company itself from the first. It is difficult to see how such applications are justified. For the employee, who may well have been a true and first inventor for the purposes of the Patent Laws of the country in which he resides and for the purposes of the application for, and grant of, a Patent of that country, is in no sense a true and first inventor in respect of any invention for the purposes of Indian Patent Law : since he has neither invented his invention in British India nor imported it into British India and has never himself been in, or come to, or communicated with, British India. And if he is not such true and first inventor, obviously there can be no assignment from him as true and first inventor ; and obviously there can be no person who is entitled to be described as an "assign of the true and first inventor" by virtue of his name in respect of any invention.

No doubt it is immaterial whether the transaction relied on as the so-called assignment takes place in British India or outside. But it is submitted that if an application is to be made by an applicant in the capacity of an assign of the true and first inventor, this postulates the existence of a person who was in fact "the true and first inventor" of the particular invention in the proper sense of the phrase in accordance with the principles of Indian Patent Law : that is to say the true and first inventor in British India.

There would seem on the other hand nothing to prevent a foreign company, in this class of case, from itself acting as the communicator from abroad of the invention, the Indian Patent for which may then be applied for and obtained by the Patent Agent in British India of the company or by any other suitable person as on a communication from abroad in the name in the first instance of such Patent Agent or other person : and the foreign company may obtain ownership thereafter of the Patent by assignment of the Patent itself after grant. Or, if the foreign Company is especially desirous of obtaining the grant from the first in its own name, there would seem nothing to prevent it from achieving this end in the following manner :—viz. for the company to arrange for the communication of the invention to the Patent Agent or any suitable person in British India, who thereby becomes the true and first inventor of the invention in British India, and then for the application for the Patent to be made in the name of the foreign company itself as an assign from such person as true and first inventor. Either of such courses will avoid the difficulties which may otherwise inevitably arise at a later stage in the event of any attack on the Patent on the ground that the person mentioned in the original application was not in truth the true and first inventor in British India.

In cases where the person desiring to make the application in the capacity of an assign of the true and first inventor is abroad (as in cases of applications by foreign companies such as those referred to), he makes the application by availing himself of the facilities of the post, either posting the application direct to the Indian Patent Office in British India or to a Patent Agent in India for presentment by him to the Indian Patent Office on behalf of the applicant. It is necessary for the applicant, though abroad, in such cases to sign the application from himself, which he may do abroad.

### **Who may apply for the grant of a Patent.**

Any person who is entitled to call himself the true and first inventor, (except, possibly, in a case where he has given up his rights to another person so as to constitute that other person an "assign" within the meaning of Section 3 of the Indian Act of 1911), is entitled to make an Application for a Patent. Where there may have been more than one person who is entitled to call himself the true and first inventor, as where there have been joint true and first inventors, any one of such persons is entitled to make an application for a Patent. Where the true and first inventor of an invention has died without having made an application for the grant of a Patent in respect of his invention, any person who is entitled to describe himself as his legal representative is entitled to make an application for the Patent. Presumably also where there are in existence more than one of such persons, any one of them may make the application. Where there has been a transaction amounting to an assignment within the meaning of Section 3 of the Indian Act of 1911, the person who is entitled to call himself an "assign" of the true and first inventor is entitled to an application for a Patent. Presumably if there were to be an "assignment" within the meaning of the section to two or more persons (whether jointly or otherwise) any one of such "assigns" would be entitled to make an application for a Patent. It would appear at first sight, considering the usual implications of the word "assign", that in a case where there has been a transaction amounting to an assignment within the meaning of Sec. 3 of the Indian Act of 1911, then the original true and first inventor is no longer entitled to make an application himself for the Patent in question. But in view of the doubtful meaning (already referred to) of the word "assign" as used in the Section, if the true position is that in law no rights other than personal rights between the so-called "assignor" and the so-called "assignee" are created by such a transaction, then it would seem to follow that, apart from any personal remedies available against him by his "assign", there is nothing in law to prevent the original true and first inventor himself making an application in his own name even in such a case.

Subject to the foregoing remarks any person who is entitled to call himself the true and first inventor, or any person who is entitled to call himself the legal Representative or Assign of the true and first inventor is entitled to make an application for the grant of a Patent.

**Other persons besides the true and first inventor may be joined.**

Provided one of the applicants is a true and first inventor, or a legal representative of the true and first inventor, or an assign of the true and first inventor, there is no objection to the name or names of an other person or persons being joined with his in the application.

In this way it is at times found convenient in making an application for a Patent in cases where an employee of a limited company or of a partnership firm is the true and first inventor, but it is desired that the company or firm by whom such person is employed should also have an interest, as a grantee, in the Patent from the first, for the application to be made out in the names of both the employee and the company or firm as joint applicants, while stating that the employee alone is the true and first inventor. In such case the grant of the Patent, if made, will be made in both the names of the employee and of the company or firm.

#### **Absence of disqualifications for applicants for Patents.**

Apart from what is necessary for the Applicant to enable him to be in a position to make the requisite declaration as already explained, there are no other legal disqualifications which will debar a person from being entitled to apply for and to receive the grant of a Patent. Ordinary legal incapacity such as might prevent the person from making a valid contract does not affect the matter.

#### **Application by infants.**

The words "any person" which occur in Section 3 of the Indian Act of 1911 in themselves might seem to show that a Patent can be applied for by or for an infant. But apart from this it seems that there has never been any suggestion under the Patent Law in England that a grant of a Patent could not be made to an infant. It has been decided that a Patent may be granted to an infant : See *Cheaven v. Walker* 1876. 5 Ch. D. 858.<sup>14</sup>

Section 74 of the Indian Act of 1911 corresponding to Section 83 of the English Act expressly provides for declarations being made on behalf of an infant by the guardian of the infant. The section

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<sup>14</sup> Cf. Terrell (8th edn.) p. 12.

clearly covers the making by an infant of an application for a Patent which may be granted to the infant.

It will be noted that the Section also provides for a Petition to the Court and an order being made thereon appointing the requisite guardian for the infant for the purpose.

#### **Applications by married women.**

There is nothing to prevent a married woman being a patentee in British India : or from making an application in her own name.

In England the Married Women's Property Act 1882 expressly recognises such right of a married woman as to make it clear that she is entitled to make an application in her own name for a Patent.

#### **Applications by lunatics.**

Similarly there is nothing to prevent a Patent being granted to a lunatic.

Under Section 74 of the Indian Act of 1911 his committee may make the application for him.

As in the case of an infant, the section provides for the necessary Petition being made to the Court and the necessary order being made thereon for the appointment of the Committee.

#### **Applications by Corporations.**

It has been decided in England that a Corporation cannot apply as the true and first inventor for a Patent : presumably because it is considered that a Corporation, such as a limited company, can have no brain or inventive faculty of its own.<sup>15</sup> It has been held however, as already mentioned earlier in this chapter, that a Corporation may be the grantee in its own name of a Patent where the invention has been communicated to it from abroad : also where there has been a transaction amounting to an assignment from the true and first inventor before grant within the meaning of Section 3 and the Corporation has made the application as an assign from the true and first inventor.

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<sup>15</sup> See *Bloxam v. Elsee*, 1 Car & P 558 at p. 564 : *Carey's Application* (1889) 6 R. P. C. 552 ; *Societe Anonyme du Generateur du Temple's Application* (1896) 13 R. P. C. 54.

A similar practice is in fact followed at the Patent Office in British India. And in British India while an application for patents by a company purporting to be the true and first inventor will not be entertained, yet not only may a company apply as a person to whom an invention has been communicated from abroad but it may also in British India apply and receive a grant as the Assign of the true and first inventor.

### **Applications by Government Servants.**

It is provided by Rule 10(1) that:—"If the true and first inventor or any applicant for a patent is in the service of the Crown, he shall disclose that fact in the application and shall state the office which he holds."

Government Servants in British India are in most instances affected by certain regulations of Government which have the effect, as a term of their contract of service or otherwise, of limiting to a considerable extent the right which they would otherwise have as private individuals of taking out, and enjoying the privileges of, Patents. In British India Government Servants are in the majority of cases governed directly by the Fundamental Rules or by other Rules for their particular service which either contain Rules similar in many respects to the Fundamental Rules or expressly provide that the Fundamental Rules shall be applicable to members of that particular service.

The current provisions of Rules No. 48A and 48B made effective from 27th June 1933, together with Rule 48 of the Fundamental Rules which immediately precedes these, are as follows:—

"48. Any Government servant is eligible to receive without special permission (a) the premium awarded for an essay or plan in public competition or (b) any reward offered for the arrest of a criminal or for information or special services in connection with the administration of justice ; and also any remuneration or reward payable under any special or local law or in accordance with the provisions of any Act or regulation or rules framed thereunder.

48A. A Government servant whose duties involve the carrying out of scientific or technical research shall not apply for or obtain, or cause or permit any other person to apply for or obtain, a patent for an invention made by such Government servant save with

the permission of the Local Government and in accordance with such conditions as the Local Government may impose.

48B. If a question arises whether a Government servant is a Government servant to whom Fundamental Rule 48-A applies, the decision of the Local Government will be final.”<sup>16</sup>

These Rules No. 48A and 48B have also been made applicable by H. E. the Governor-General in Council with effect from 27th June 1933 to those services in respect of which power to make rules is delegated to him, in exercise of the powers conferred on him by Rules 33(2), 37, 42 and 44(d) of the Civil Services (Classification, Control and Appeal) Rules and with the previous sanction of the Secretary of State in Council in accordance with Rule 9 of those rules.<sup>17</sup>

The General Instructions concerning the mode of application of Rules No. 48A and 48B are worded as follows :—

“General instructions for regulating the grant of permission for the taking out of Patents by Government Servants whose duties involve the carrying out of scientific or technical research.

1. Application for permission under rule 48-A of the Fundamental Rules should be made by the Government Servant making an Invention to the head of his Department or, if he is himself the head of the Department, to the Department of the Local Government under whom he is serving.

2. The head of the Department should deal with the application confidentially and with expedition so that the inventor may not be prejudiced by delay in making his Application at the Patent Office, and should forward it with his recommendations to the Department of the Local Government under whom he is employed.

3. Permission may be granted by the Department of the Local Government to the Applicant without any restriction if the Invention has no connection with the Government servant's official duties and has not resulted from facilities provided at Government expense.

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<sup>16</sup> See G. I. F. D. Notification No. F. 11(21) R. 1-33 dated 1st November 1933.

<sup>17</sup> See the Post & Telegraphs Compilation of the Fundamental and the Supplementary Rules (2nd edn.): and the 31st List of Corrections to the same No. 555.

4. If the Invention is made in the course of the Government Servant's official duties or has resulted from facilities provided at Government expense, then—

- (a) if the Invention is of such general interest and utility that the public interest will be best served by allowing the public a free use of the Invention, the Application for taking out a Patent should be refused and the Invention should be published. An *ex gratia* payment should ordinarily be made to the Inventor as a reward in all such cases ;
- (b) if the Invention is not of the kind mentioned in (a) but is of sufficient public utility as is likely to make its commercial exploitation profitable, the Inventor should be directed to take out a Patent and to assign his rights under the Patent to the Secretary of State for India in Council. In all such cases, the Inventor should be rewarded either by a suitable lump sum payment or by a liberal percentage of the profits made by Government in connection with the Invention ;
- (c) in other cases, the Inventor should be allowed to take out a Patent for his own benefit subject to his undertaking to permit Government the use of the invention either without payment or on such terms as they may consider reasonable.

5. When the Invention has been assigned to the Secretary of State for India in Council under paragraph 4(b) above, the Department of the Local Government concerned may exploit the Patent themselves, or—

- (a) advertise the Patent and grant Licenses on payment to manufacturers, or
- (b) sell the rights under the Patent to a firm or to a private person.

6. In order to secure reasonable uniformity of practice and to secure for Government the full benefits of Inventions, the Controller of Patents and Designs should ordinarily be consulted before any awards are made under clauses (a), (b) and (c) of paragraph 4 above



or steps are taken for the exploitation of the Patents under paragraph 5 above.”<sup>18</sup>

### **Applications by Legal Representatives.**

This aspect of the matter has already been referred to.<sup>19</sup>

### **Applications for patents in India under Reciprocal arrangements.**

It will be observed that there are other official forms provided for use in cases where the application for the patent is made under the Reciprocal Arrangements with the United Kingdom and certain other countries and states ; which is done by virtue of Section 78A of the Indian Patents & Designs Act of 1911. Such forms are No. 2, and No. 2A of the forms in the Second Schedule of the Act.<sup>20</sup>

### **Reciprocal arrangements with the United Kingdom :—**

By Section 78A(1) it is provided as follows :

“If His Majesty is pleased by Order in Council to apply such of the provisions of section 91 of the Patents and Designs Act, 1907, as relate to inventions or designs, to British India, then any person who has applied for protection for any invention or design in the United Kingdom or his legal representative or assignee, shall be entitled to a patent for his invention or to registration of his design under this Act, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the United Kingdom :

Provided that :

- (a) the application is made in the case of a patent within twelve months, from the application for protection in the United Kingdom.”

And by Section 78A(3) it is provided :—

“The application for the grant of a patent or the registration of a design under this section must be made in the same manner as an ordinary application under this Act” :<sup>21</sup>

### **Section 91 of the English Patents & Designs Acts 1907-1932**

<sup>18</sup> See also Section 21 of the Indian Patents & Designs Act and in particular the proviso to sub-section 4 thereof.

<sup>19</sup> See page 333.

<sup>20</sup> See Appendix No. 5 below.

<sup>21</sup> For the further provisions of the Section see Appendix No. 5 below.

to which reference is made in Section 78A (above) is the section of the English Act which contains the corresponding reciprocal arrangements enabling applications to be made in the United Kingdom for United Kingdom Patents within one year of an application for an Indian Patent having been made in British India. The wording of Section 91, which may be set out here for convenience of reference, is as follows :—

“91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state or his legal representative or assignee shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act 1905, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the foreign state.

Provided that—

- (a) The application is dated, in the case of a patent within twelve months, and in the case of a design or trade mark within six months, from the application for protection in the foreign state ; and
- (b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) Where the same applicant has made two or more applications for protection of inventions in any foreign state to which the provisions of this section apply, and the Comptroller is of opinion that the whole of the inventions in respect of which the applications were made are such as to constitute a single invention and may properly be included in one patent, he may, if a separate application dated within twelve months from the date of the earliest of the foreign applications is made in respect of each of the foreign applications, accept one complete specification in respect of the whole of these inventions and grant a single patent thereon. The patent shall bear the date of the earliest of the foreign applications, but in considering the validity thereof and in determining other

questions under this Act, the court or the Comptroller as the case may be, shall have regard to the respective dates of the foreign applications relating to the several matters claimed in the specification.

(3) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

- (a) in the case of a patent, by reason only of the publication of a description of, or use of the invention ; or
- (b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or
- (c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(4) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905 : Provided that—

- (a) In the case of patents the application shall be accompanied by a complete specification which, if it is not accepted within eighteen months from the application for protection in the foreign state or in the case of applications made in accordance with the provisions of sub-section (2) of this section from the earliest of the applications for protection in the foreign state, shall with the drawings, samples and specimens (if any) be open to public inspection at the expiration of that period ; and
- (b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(5) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(6) Where it is made to appear to His Majesty that the legislature of any part of His Majesty's dominions outside the United Kingdom has made satisfactory provision for the protection of inventions, designs, or trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that part of His Majesty's dominions, with such variations or additions, if any, as may be stated in the Order."

The condition mentioned at the beginning of Section 78A of the Indian Act that the provisions of the section are to be effective only if His Majesty, (that is to say in England), is pleased to extend the benefit of the English Section 91 to Indian Patents, has been fulfilled as was made known by an Order in Council made on 26th November 1920.<sup>22</sup> For convenience of reference the wording of such Notification may here be set out: it is as follows:—

"Notification No. A.-33, dated the 26th November 1920. The following Order of His Majesty in Council applying to British India the provisions of section 91 of the United Kingdom Patents and Designs Acts, 1907 and 1919, so far as relates to Patents and Designs, is republished for general information.

At the Court at Buckingham Palace, the 13th day of October 1920.

PRESENT :

The King's Most Excellent Majesty in Council.

Whereas by section 91 of the Patents and Designs Acts, 1907 and 1919 (7 Edw. 7, c. 29 and 9 and 10 Geo. 5, c. 80), it is in regard to International and Colonial Arrangments relating to the registration of Patents and Designs, provided, *inter alia*, as follows:—

- (5) Where it is made to appear to His Majesty that the Legislature of any British Possession has made satisfactory provision for the protection of Inventions, Designs or Trade Marks, patented or registered in this country, it shall be lawful for His Majesty by Order in Council, to apply the provision of this section to that Possession, with such variations or additions, if any, as may be stated in the Order.

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<sup>22</sup> Notification No. A-33 dated 26th November, 1920, published in the Gazette of India 1920, Part I at page 2241.

And whereas it is made to appear to His Majesty that the Legislature of British India has made satisfactory provision for the protection of Inventions and Designs patented or registered in the United Kingdom.

Now, therefore, His Majesty, by and with the advice of His Privy Council, by virtue and in pursuance of the provision of the above-recited sub-section, and of every other power Him thereunto enabling, doth order, and it is hereby ordered, that the provisions of section 19 of the Patents and Designs Acts, 1907 and 1919, so far as relates to Patents and Designs shall apply to British India.

This Order shall take effect from the 2nd September 1920.

Sd. ALMERIC FITZROY."

The result is that the provisions contained in Section 78(A) (allowing applications for Indian Patents to be made within 12 months of English applications for patents in the United Kingdom), as set out above, are in full operation in British India.

**As to reciprocal arrangements with other parts of His Majesty's dominions and with certain Indian States.**

By Section 78A(4) it is further provided as follows :—

"Where it is made to appear to the Governor-General in Council that the legislature of any other part of His Majesty's dominions (or of any State in India) has made satisfactory provision for the protection of inventions or designs, patented or registered in British India, the Governor-General in Council may, by notification in the Gazette of India, direct that the provisions of this section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of inventions or designs patented or registered in that part of His Majesty's dominions (or that State, as the case may be)".

The Governor-General in Council has in fact been satisfied that such satisfactory reciprocal provision in favour of British Indian Patents has been made in several instances by the Governments of other dominions and states ; and the Governor-General in Council has accordingly on various occasions made certain Notifications in the Gazette of India for that specific purpose ; and has

thereby given the requisite directions so that the provisions of Section 78A are made applicable in such cases ; thus enabling an application for a Patent in British India to be made within one year after an application in the respective other dominion or state, and enabling inventors to have the benefit of these reciprocal arrangements contained in Section 78A of the Indian Act where an application for patent has previously been made in the particular other dominion or state referred to.

For convenience of reference the several Notifications of this nature which have been so published and made effective are the following :—

NOTIFICATION No. A-342, dated the 27th February 1922.

“Whereas it appears to the Governor-General in Council that the Government of the Island of Ceylon has made satisfactory provision for the protection of inventions patented in British India.

Now, therefore, in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents and Designs Act, 1911 (II of 1911) the Governor-General in Council is pleased to direct that the provisions of the said section shall apply for the protection of inventions patented in the Island of Ceylon”.<sup>23</sup>

NOTIFICATION No. A-342, dated Simla, the 13th April 1922.

“Whereas it appears to the Governor-General in Council that the Legislature of New Zealand is making satisfactory provision for the protection of inventions or designs patented or registered in British India.

Now, therefore, in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents and Designs Act, 1911 (II of 1911) the Governor-General in Council is pleased to direct that the provisions of the said section shall with effect from the 15th July 1922, apply for the protection of inventions or designs patented or registered in the dominion of New Zealand”.<sup>24</sup>

NOTIFICATION No. A-342, dated Simla, the 2nd May 1922.

“Whereas it appears to the Governor-General in Council that the Legislature of the Union of South Africa has made satisfactory

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<sup>23</sup> Published in the Gazette of India 1922, Part I, p. 223.

<sup>24</sup> Published in the Gazette of India 1922, Part I, p. 480.

provision for the protection of inventions or designs patented or registered in British India.

Now, therefore in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents and Designs Act, 1911 (II of 1911) the Governor-General in Council is pleased to direct that the provisions of the said section shall apply for the protection of the inventions or designs patented or registered in the Union of South Africa."<sup>25</sup>

NOTIFICATION No. A-342, dated Simla, the 16th October 1923.

"Whereas it appears to the Governor-General in Council that the Legislature of the Commonwealth of Australia is making satisfactory provision for the protection of inventions patented, and of designs registered, in British India.

Now, therefore, in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents and Designs Act, 1911 (II of 1911) the Governor-General in Council is pleased to direct that the provisions of the said section shall, with effect from the 1st January 1924, apply for the protection of inventions patented, and of designs registered, in the Commonwealth of Australia".<sup>26</sup>

NOTIFICATION No. A-342, dated Delhi, the 22nd November 1923.

"Whereas it appears to the Governor-General in Council that the Legislature of the Dominion of Canada has made satisfactory provision for the protection of inventions patented, and of designs registered in British India.

Now, therefore, in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents and Designs Act, 1911 (II of 1911), the Governor-General in Council is pleased to direct that the provisions of the said section shall, with effect from the 1st February 1924, apply for the protection of inventions patented, and of designs registered, in the Dominion of Canada".<sup>27</sup>

NOTIFICATION No. A-342, dated Simla, the 4th August 1928.

"Whereas it appears to the Governor-General in Council that

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<sup>25</sup> Published in the Gazette of India 1922, Part I, p. 564.

<sup>26</sup> Published in the Gazette of India 1923, Part I, p. 1361.

<sup>27</sup> Published in the Gazette of India 1923, Part I, page 1656.

the Legislature of the Irish Free State has made satisfactory provision for the protection of inventions or designs patented or registered in British India.

Now, therefore, in pursuance of the provisions of sub-section (4) of section 78-A of the Indian Patents & Designs Act, 1911 (II of 1911) the Governor-General in Council is pleased to direct that the provisions of the said section shall apply for the protection of inventions or designs patented or registered in the Irish Free State".<sup>28</sup>

DEPARTMENT OF INDUSTRIES AND LABOUR NOTIFICATION No. A-293, dated the 20th November 1935.

"Whereas it has been made to appear to the Governor-General in Council that the Legislature of the Baroda State has made satisfactory provision for the protection of inventions patented, and of designs registered, in British India, the Governor-General in Council, in pursuance of the provisions of sub-section (4) of Section 78-A of the Indian Patents & Designs Act, 1911 (II of 1911) is pleased to direct that the provisions of the said section shall, with effect from the 7th December 1935, apply for the protection of inventions patented, and of designs registered, in the Baroda State."

#### Summary.

The countries therefore in regard to which, if an application for Patent has there been made, an application for an Indian Patent may on that account under the reciprocal arrangements be made here at any date up to twelve months later (without fear of anticipation by publication in India of the Invention or previous foreign application), are the following :—

Under Sec. 78A (1) :—

THE UNITED KINGDOM.

Under Sec. 78A (4) :—

AUSTRALIA.

BARODA STATE

CANADA.

CEYLON.

IRISH FREE STATE.

NEW ZEALAND.

UNION OF SOUTH AFRICA.

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<sup>28</sup> Published in the Gazette of India, Part II, dated the 25th August 1928, page 1160.



And by the same reciprocal arrangements when an application for an Indian Patent has been made in India, the applicant has a similar full twelve months in which he can thereafter (without fear of any anticipation by publication of the Indian Patent Specification in the foreign country) make an application for a foreign Patent in any one of the same countries mentioned in the previous list.

#### **Qualification of an applicant for Patent under the reciprocal arrangements.**

For applications for an Indian Patent made under such reciprocal arrangements, all that is necessary to be declared by the Applicant about himself is to the effect that he is the person who made the foreign application or that he is the legal representative of such person : or that he is the assignee of such person.<sup>29</sup>

#### **The International Convention for the Protection of Industrial Property.**

This international convention was originally made on 20th March 1883, and has since been revised at Brussels on 14th December 1900, and at Washington on 2nd June 1911 and at The Hague on 6th November 1925.

Almost every civilised country of the world, with but few exceptions, has subscribed to it and has thereby become a contracting party. As a result of this convention reciprocal arrangements in connection with Patents and carrying reciprocal benefits which are broadly speaking of the same nature as those created under the special reciprocal arrangements already mentioned in the last preceding paragraph of this chapter, are available and in effective operation between every country which is a contracting party to this International Convention.

It is by virtue of this International Convention and the reciprocal arrangements thereunder that an American Patentee avails himself of the right, if he chooses, within a year after his American application, to obtain in the United Kingdom a British Patent which will then have priority from the date of his American Patent ; and *vice versa*. And so with German Patents in respect of priority for the United Kingdom and with British Patents in respect of

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<sup>29</sup> See Form No. 2 (See Appendix No. 5). Also Form No. 2A in the case of an application by a legal representative or assign of the foreign applicant.

priority for Germany : and so with the patents of every country which is a party to the Convention.<sup>30</sup>

British India has not subscribed to this International Convention and is not a party thereto. Having no system for the registration of Trade Marks, British India is not qualified to become a party to the International Convention. Unless and until an Act allowing and regulating the registration of Trade Marks in British India is passed, there can therefore be no possibility of any reciprocal benefit for inventors or merchants in regard to the priority of Patents in British India and the other countries named under the International Convention.

Though the Convention is not applicable to British India, yet practitioners in India may desire to refer to this International Convention in connection with English or American or German or other Patents which may have been obtained in any of these countries with a priority date from some other country under this International Convention. For the full text of a translation of this International Convention and most useful comments on procedure to be adopted thereunder reference may conveniently be made to Haddan's Compendium of Patents and Designs at p. 415.<sup>31</sup>

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<sup>30</sup> It may be of interest here to note a list, alphabetically arranged, of the countries which have subscribed to the International Convention :—

Australian Commonwealth	France	New Zealand
Austria	Germany	Norway
Belgium	Great Britain	Poland
Brazil	Greece	Portugal with Azores and Maderia
Bulgaria	Hungary	Roumania
Canada	Irish Free State	Spain
Ceylon	Italy	Surinam and Curacao
Cuba	Japan	Sweden
Czecho-Slovakia	Jugo-Slavia	Switzerland
Danzig Free State	Latvia	Syria and Lebanon
Denmark	Luxemburg	Trinidad and Tobago
Dominican Republic	Mexico	Tunis
Dutch Indies	Morocco (French Zone)	Turkey
Esthonia	Morocco (Spanish Zone)	United States of America
Finland	Netherlands	

<sup>31</sup> Or see the pamphlet entitled "International Convention for the protection of Industrial Property and International Agreement regarding False Indication

For present purposes Clause 4 thereof, which is the operative Clause of the reciprocal arrangements now under discussion, is sufficient here to be stated ; which is :—

*“Art. 4.*

A. (1) *Any person who has duly deposited an application for a Patent, or for the registration of a utility model, industrial design or model or trade mark in one of the countries of the Union, or his legal representative or assignee, shall enjoy, for the purposes of deposit in the other countries, a right of priority during the periods hereinafter stated.*

(2) *Every application which, under the domestic law of any country of the Union, or under international treaties concluded between several countries of the Union, is equivalent to a regular national application, shall be recognised as giving rise to a right of priority.*

B. *Consequently, a subsequent deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another deposit, by publication or exploitation of the invention, by the putting on sale of copies of the design or model, or by use of the mark, and these acts cannot give rise to any rights of third parties or of personal possession. Rights acquired by third parties before the date of the first application which serves as a basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.*

C. (1) *The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs or models and trade marks.*

(2) *These periods start from the date of deposit of the first application ; the day of deposit is not included in the period.*

(3) *If the last day of the period is a dies non or a day when the Office is not open to receive the deposit of applications in the*

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of Origin” issued by the Board of Trade in the United Kingdom ( 1934 edn : price 4d net). As a matter of interest and convenience of reference by those to whom the text of this International Convention is not in India readily available an English translation of the French text of the convention in full is set out in Appendix No. 6.

*country where protection is claimed, the period shall be extended until the first following working day.*

D. (1) *Any person desiring to take advantage of the priority of a previous deposit shall be bound to make a declaration giving particulars as to the date of such application and the country in which it was made. Each country will determine for itself the latest time at which such declaration must be made.*

(2) *These particulars shall be mentioned in the publications issued by the competent authority, for instance, on the patents, and the specifications relating thereto.*

(3) *The countries of the Union may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings &c.) previously deposited. The copy certified as correct by the authority by whom the application was received, shall not require any legal authentication, and may in any case be deposited at any time within three months from the deposit of the subsequent application without payment of any fee. They may require it to be accompanied by a certificate from the proper authority, showing the date of the application, and also by a translation.*

(4) *No other formalities may be required for the declaration of priority at the time of depositing the application. Each of the countries of the Union shall decide for itself what consequences shall follow the omission of the formalities prescribed by the present article, but such consequences shall in no case be more serious than the loss of the right of priority.*

(5) *Subsequently, further proof in support of the declaration may be required.*

E. (1) *Where an application for the registration of an industrial design or model is deposited in a country in virtue of a right of priority based on a previous deposit of an application for registration of a utility model, the period of priority shall only be that fixed for industrial designs or models.*

(2) *Further, it is permissible to deposit in a country an application for the registration of a utility model by virtue of a right of priority based on a patent application and vice versa.*

F. *No country of the Union may refuse an application for a patent on the ground that it contains multiple priority claims,*

*provided that the application relates to one invention only within the meaning of the law of that country.*

G. *If examination reveals that an application contains more than one invention, the applicant may divide the application into the requisite number of divisional applications and preserve as the date of each divisional application, the date of the initial application, and if necessary, the benefit of the right of priority.*

H. *Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear in the claims formulated in the application in the country of origin, provided that the application documents as a whole disclose such elements in a precise manner.*

*Art. 4 bis.*

1. *Patents applied for in the various countries of the Union by persons entitled to the benefits of the Union shall be independent of the Patents obtained for the same invention in the other countries, whether members of the Union or not.*

2. *This stipulation must be strictly interpreted, for example it shall be understood to mean that patents applied for during the period of priority are independent, in respect of the grounds for refusal and for revocation as well as in respect of their normal duration.*

3. *The stipulation applies to all patents existing at the time when it comes into effect.*

4. *Similarly, it shall apply, in the case of the accession of new countries, to patents in existence, either on one side or the other, at the time of accession.*

5. *Patents obtained with the benefit of priority shall enjoy in the various countries of the Union a duration equal to that which they would have enjoyed if they had been applied for or issued without the benefit or priority."*

**British India not a party to the International Convention.**

Since British India is not a party to this International Convention it follows that there are no reciprocal arrangements effective or in operation between British India and any other countries or states, except only those which have been here previously mentioned as specially created not under the International Convention but

under Section 78-A of the Indian Act of 1911 and under Section 91 of the English Acts of 1907-1932.<sup>32</sup>

**No reciprocal arrangements for example between India and America.**

It follows therefore, for example, that there is no period of immunity from publication for American Patents in British India : if an application be made in British India for a Patent for an invention one day after the American Specification for the American Patent has been published in India such application will be shut out for the reason of prior publication. An account of the American Patent contained in any scientific American or other journal published in British India will have a similar effect by affording such publication.<sup>33</sup> It may be noted that it is the practice in several Scientific American Journals to give full and complete descriptions of certain new American Patents as they are granted. These journals are occasionally freely circulated in Commercial and other libraries in various parts of India. The evils of the present system are then apparent. Also the difficulties confronting an American inventor and Patentee who may desire to obtain a Patent for his invention in British India : and *vice versa*.

**Applications for Patents of Addition.**

An advantage of a Patent of Addition is that, under Section 15A(2), no renewal fees are payable on it.

The proper form on which the application is to be made is the appropriate one of the following forms in the Second Schedule of the Indian Act : Forms No. 1C ; No. 1AC ; No. 1BC ; No. 1CC ; No. 2C ; or No. 2AC.<sup>34</sup>

It is not necessary here to make any further comment in regard to an application which may be made for a patent of addition. The general principles regarding the declarations which an applicant has to make are no different from those already discussed earlier in this chapter.

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<sup>32</sup> Cf. page 359 ante.

<sup>33</sup> For the question of prior publication further see p. 194.

<sup>34</sup> See Appendix No. 5 below.

### **Stages of procedure between application and grant in the absence of opposition.**

Reference has already briefly been made to the sequence of the procedure between the making of the application for a Patent and the receiving of the grant of the Patent. Where there is no opposition by third parties and there are consequently no opposition proceedings under Section 9, the various stages were mentioned under the following heads :—<sup>35</sup>

- (i) Application for grant.
- (ii) Examination of the application by the Controller.
- (iii) Notice of the decision of the Controller.
- (iv) Advertisement of the acceptance of the application.
- (v) Sealing and grant.

The only stage at which any objections to the application or any objections to the validity of the Patent asked for has to be met during this sequence of steps is at the second step during and in connection with the examination of the application by the Controller. It is accordingly proposed now briefly to consider the nature of the objections which may be raised by the Patent Office at this stage ; and by what means and to what extent the Applicant can meet such objections if raised.

### **Objections may be raised by the Patent Office even though there are no opposition proceedings by third parties.**

Objections may arise in the examination by the Patent Office even in the cases now under consideration where there are no opposition proceedings under Section 9. This occurs as a result of the examination and search which it is obligatory for the Patent Office to make under Section 5 of the Indian Patents & Designs Act of 1911.

### **Extent of investigation and search necessary to be made by the Controller in British India.**

The sole provisions under the Act regulating the investigation and search to be made by the Controller are contained in Section 5 and nowhere else. From a perusal of that section it will be seen

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<sup>35</sup> See Chapter V at page 71 above.

that the investigation is limited to the following field : *viz.* cases where :—

- (a) the nature of the invention is not fairly described, or
- (b) the application, specification and drawings have not been prepared in the prescribed manner \* \* \* or
- (c) the title does not sufficiently indicate the subject-matter of the invention, or
- (d) the statement of claim does not sufficiently define the invention, or
- (e) the invention as described and claimed is *prima facie* not a new manufacture or improvement, or
- (f) the specification relates to more than one invention.

These six points which are to be investigated are not altogether happily or logically worded in the section. Point (c) is clear and is confined to the choice of the title of the invention. Point (b) may be taken to cover an investigation to ensure that the relative regulations and rules have been complied with, and is also thus far clear. Point (a) appears to be ambiguous : as to whether it means insufficiency in describing the ambit of the invention or insufficiency in describing the manner in which the invention is to be carried out, or both. However the combined effect of (a) and (d) may be taken together to cover the field of insufficiency in both respects. Point (e) on an ordinary reading of the words covers merely the general ground of invalidity for *prima facie* want of subject matter that the alleged invention is not a “manner of new manufacture” or an “invention” under the Statute of Monopolies. Point (f), is self explanatory.

The six points may thus be dealt with more conveniently as five ; *viz.* :—

- (i) As to the title of the invention.
- (ii) As to the application and specification (including drawings) not being prepared in a prescribed manner.
- (iii) As to insufficiency.
- (iv) As to *prima facie* want of subject matter : no manner of new manufacture : no invention.



(v) As to multiplicity of inventions.

Now it is to be observed that these five points do not correspond with the field for investigation which is laid down under the current English Patents & Designs Act, 1907-1932 ; nor are they worded so as to correspond precisely with the previous English Act. A comparison of Section 5 of the Indian Act of 1911 with the relative corresponding provisions which are to be found in Section 3, Section 6, Section 7 and Section 8 of the current English Patents & Designs Act of 1907-1932 will show that :—

As to points (a) plus (d) of the Indian Section (*i.e.* insufficiency) this is correspondingly made a part of the field of the investigation required under the English Act : see Section 3(2) & Section 6(2). As to point (b) of the Indian Section, this corresponds word for word to similar provisions in Section 3(2) and Section 6(2) of the English Act ; under which this point is also made a part of the field to be similarly investigated by the Patent Office in England. As to point (c) (*i. e.* title of the invention) this in the same way has a precisely corresponding provision in the English Act : See section 3(2). As to points (e) and (f) of the Indian Section (*i.e.* *prima facie* want of subject matter : not a “manner of manufacture” or not an “invention”) there are no corresponding provisions in the English Act. On the other hand, and this is the most important result of this comparison, it will be found that those features which in practice usually amount to the most important part of the field of the investigation made by the Patent Office in England, which are those directly provided for under the four English sections already mentioned (*i. e.* the investigation as to novelty or prior grant in certain well defined and limited respects) are entirely absent from the provisions of Section 5 of the Indian Act.

As the whole matter is important, it may be worth while to note here, on an analysis of the four sections in question of the English Statute (and taking into account also the general provisions both of the English Statute and of the Statute of Monopolies), what are the several points which the investigation of the Patent Office in England is directed to cover at this stage. These are :—

(i) (As to the title) “the title does not sufficiently indicate the subject matter of the invention” : under Section 3(2).

(ii) (As to not being prepared in the prescribed manner.) “the

application, specification, or drawings have not been prepared in the prescribed manner" : under Section 3(2) and Section 6(2).

(iii) (As to insufficiency of description) :—"the nature of the invention is not fairly described : or that the nature of the invention or the manner in which it is to be performed is not therein particularly described and ascertained" : under Section 3(2) and Section 6(2).

(iv) (As to want of novelty by publication in a prior specification) :—"the invention claimed has been wholly or in part claimed or described in any specification.....published before the date which the patent applied for would bear if granted and left pursuant to any application for a patent made in the United Kingdom and dated within fifty years next before such date" : under Section 7(1).

(v) (As to want of novelty by publication in documents (other than specifications) if within the knowledge of the Patent Office) :—"if within the knowledge of the Comptroller.....the invention claimed has been made available to the public by publication.....before the date which the patent applied for would bear if granted in any document (other than a specification.....)" : under Section 7(5).

(vi) Also (as to prior grant) :—that "the invention claimed has been wholly or in part claimed in any specification published on or after the date which the patent applied for would bear if granted and deposited pursuant to an application made in the United Kingdom for a patent which if granted would bear prior date to the date which the patent applied for would bear if granted" : under Section 8(1).

It may be added that by virtue of general principles it appears to be established in the United Kingdom the Comptroller has power to include in his investigation in spite of the absence of any specific directions to this effect, a consideration also of the following points :—<sup>36</sup>

(vii) (As to subject matter) :—whether the purported invention is obviously not a manner of new manufacture or obviously not in invention within the meaning of Statute of Monopolies and of the English Patents & Designs Act. In this respect reference may now

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<sup>36</sup> See Terrell (8th edn.) pages 37, 215. Also 41 R.P.C. 530, 45 R.P.C. 411.

be made also since 1932 to the general provisions of Section 75 of the English Act of 1907-1932.

(viii) (As the multiplicity):—whether the specification in question relates to more than one invention: in this respect reference may be made also to Section 14(2) of the English Act.

(N. B. Additional Points to be investigated under the English Act, which refer only to matters connected with the existence in England of a provisional specification, since there are no provisional specifications in India, have been excluded from the eight points mentioned.)

Points (iv), (v) and (vi) of the above analysis are those which constitute the most important matters covered by the investigation and search which is required to be made in the United Kingdom under the English Act. These points (iv) & (v) & (vi) are not under the Indian Patents & Designs Act expressed as being required to be covered by any search or investigation on the part of the Indian Patents Office.

#### **As to the construction of Section 5 of the Indian Act.**

A question which then arises is, as to the matters covered by points (iv), (v) and (vi) last mentioned, being matters for which an investigation by the Patent Office in the United Kingdom is expressly directed and authorised under the English Act, whether the Indian Act, is to be construed in any way so as to be taken to include similar directions and authority to the Indian Patent Office to make a similar investigation.

In order more clearly to appreciate the nature of the question now under consideration, it will be advisable to recollect what normally occurs in practice under the English procedure under the English Act. In England at this stage, as is well known, a most thorough search is first made by the Examiners of the Patent Office for the purpose of ascertaining what if any anticipations there may be in the form of other specifications which have been published prior to the date of the application in question. Such search goes back over a period of 50 years. If any such anticipating specifications are found, the applicant is notified by the Patent Office thereof. In England also at this stage if the purported invention applied for is known by the English Patent Office to have been covered by some

prior publication in some document independently of any prior English Specification, this fact is similarly notified to the applicant and his attention drawn to the document in question. In England an investigation is also made by the Patent Office in regard to Specifications which, though not published prior to the Applicant's application and though not therefore constituting any anticipation by want of novelty, yet have been filed prior to the date of the investigation ; and if any such Specification is found which coincides with the invention of the Applicant and is of such a date (for reasons of reciprocal priority or any other reason) that it will, if a Patent be granted for it, constitute a grant prior to the grant to the Applicant, the Patent Office will in the same way notify the Applicant of the existence of such Specification. On receipt of such notice from the Patent Office of the existence of the relative other Specification or of the relative other document as the case may be, the Applicant may then either amend his own Specification, if he can do so in such a way as to avoid the evil effects of the other specifications ; or he may amend it by inserting general disclaimers as to the stage of the prior art and thus elucidating the ambit of his claimed invention and its nature so as to show that he is not claiming what has been claimed in the other specifications ; or if necessary he may amend it by inserting by way of disclaimer a specific reference by number and date to the other specification.

Any objections on the points (iv), (v) or (vi) now being considered may be described principally as objections for want of novelty (*i. e.* for want of novelty for prior publication in a prior Patent Specification or for want of novelty for prior publication in some other document (not a Patent specification) which is within the knowledge of the Comptroller) ; or as objections for prior grant. In so far they are to be regarded as objections of that type, it is clear that they are not directly included in any of the terms of Section 5 of the Indian Act : which contains no reference in terms to any investigation for want of novelty or to any investigation regarding prior publication whether in the form of Patent Specifications or otherwise. Are they then indirectly included in any of the terms of Section 5 ? As to this the only clause which can on any possible construction be read as covering directions on the Patent Office to take an investigation affecting questions of want of novelty or prior grant would appear to be sub-clause (e). But on the whole

it would not seem that the words "*prima facie* not a new manufacture or improvement" can, without undue strain of language, be taken to be meant to cover an investigation for want of novelty in connection with other specifications or other documents. For the words "*prima facie*" in themselves would seem to limit the field of enquiry to matters appearing on the Applicant's specification itself.

Then it may be urged that any objections on the points (iv), (v) & (vi), in addition to being objections for want of novelty or prior grant, may also be viewed from another angle as objections for insufficiency: on the following reasoning. That it may be said that the invention of the Applicant will be all right if properly delimited and described, but in so far as it omits to disclaim matter contained in other specifications or other documents it suffers from insufficiency. If this were to be so, then it might be said that an investigation as to objections on the points (iv), (v) & (vi) might be directed and authorised by the wording of sub-clause (d) of Section 5. But here again it is submitted that it would entail too great a strain of language. For to read into the words "the statement of claim does not sufficiently define the invention," a direction and authority to the Indian Patent Office to carry out a search of other specifications and documents in the manner suggested, it is necessary to say that the Patent Office is first to search those other specifications or documents, secondly to come to a conclusion on questions of novelty, construction or identity, and only then to come to a decision on any question touching insufficiency: *viz.* a decision, which after first finding on a question of novelty that the Applicant's specification is anticipated by some other Specification or document, only then finds that the Applicant's Specification is bad for insufficiency because it does not contain a proper reference to that other Specification or document.

For the above reasons it is submitted that Section 5 does not contain any directions or any authority to the Controller in British India to make any investigation at all relating to the contents of other specifications or other documents at this stage of the proceedings.

**Objections which may be raised by the Patent Office at this stage apart from Section 5.**

The next question then is whether an investigation on the

points (iv), (v) & (vi) is authorised and justified apart from Section 5.

It appears to be established in the United Kingdom that in spite of no specific directions or authority being contained in the corresponding sections (7 & 8) of the English Act, yet the Comptroller has an inherent power to reject an application at this stage if it is obvious on the face of the Specifications that the application is merely frivolous, or that the purported invention is clearly not proper subject matter for a Patent, as in a case where it is obviously not a "manner of new manufacture", or obviously not an "invention" at all. It would seem that in the United Kingdom the Comptroller has similarly power to reject an application at this stage for obvious illegality or immorality.

It appears that the Comptroller in the United Kingdom has always had such inherent power even prior to the 1932 Act. Now under that Act such power is fortified by Section 75 of the English Act.

It is submitted that in British India, similarly, the Controller will have an inherent power, apart altogether from any powers given him under Section 5, to raise objections at this stage on similar grounds. *Viz.* :—in cases where it is obvious on the face of the Specification that the application is merely frivolous : or where it is clear on the face of the Specification that there is no manner of new manufacture : or that there is no invention at all : or for obvious illegality : or for obvious immorality. But all such objections arise on the face of the Applicant's Specification alone. They do not entail an investigation or search of any other documents.

There would seem to be therefore no inherent power existing in the Controller by which he is authorised to make any search as to want of novelty for anticipation of the Applicant's invention in other documents at this stage : either in other prior Patent Specifications or in other documents apart from Specifications. It is submitted for the reasons stated that the true position in law is that there are no such directions given to him or powers granted to him either within or outside Section 5.

If this is the true position, then the Controller in British India is nowhere given directions or authority to make an investigation at this stage on the points (iv), (v) or (vi) abovementioned.

**Benefits to an Applicant of a thorough search being made at this stage by the Patent Office : present position unsatisfactory.**

It is clear that if in every case of an application for a Patent being received by the Patent Office, an applicant can rely on a thorough search being made of all prior Indian Specifications by the trained staff of the Patent Office Examiners without additional expense to the applicant, this will be of considerable advantage to the applicant. By this means he will be saved the expense and difficulty of having to make a search of the records himself or through an agent. He will also be saved in many instances the subsequent danger of attacks being made at a later date on his Patent for anticipation in prior Patents entailing, it may be, infinite trouble, expense and loss to him thereafter. In short by being given an opportunity at this early stage of putting his Specification in proper order to meet such objections as are benevolently raised by the Patent Office before any attack is made on the Patent by other persons he will be enormously benefited.

So long as the search is thus benevolently made for his benefit by the Patent Office and the Patent Office does not refuse to accept his Patent or refuse to accept it except on terms entailing amendment which may be objectionable to him, no doubt any search which may be made is nothing but beneficial to the Applicant. And as the applicant is the only person directly affected at that stage, whatever search the Patent Office takes upon itself to make is not likely to be questioned (unless by the tax-payers), since it is solely for the benefit of the Applicant.

When the Patent Office as a result of such search goes further and refuses to accept the Applicant's Patent or refuses to accept it except on terms to which he objects, the position becomes different. It is possible then that the power or authority of the Patent Office to make such search and so to act, might be put in question ; since it would appear that the Controller is only given power to refuse to accept an application if he comes to a decision adverse to the applicant on the points expressly stated in Section 5, and none other.

In any event the present position is unsatisfactory : both from the point of view of the Applicant and from that of the Indian Patent

Office. The position will continue to be unsatisfactory until the Act is amended so as to make clear the extent and nature of the investigation which the Patent Office is empowered to make at this stage, if it so desires : as well as the extent and nature of such search as it is to be bound to make, on which the Applicant may in all cases rely.

### **Actual practice of the Patent Office in British India.**

In spite of what has been said above as to the very material points in which the Indian Act differs from the English Act, and in spite of the construction which it has been submitted should properly be put on the Indian Act, (that is to say that there is no direction or authority to make a search as to want of novelty), the fact remains that the Patent Office in India does in actual practice habitually, at the stage when an application for Patent is received, make an investigation for want of novelty. The field of such investigation ordinarily extends to cover a search of the contents of Indian Specifications published prior to the date of the Applicant's application ; such Indian Patents being habitually cited by the Indian Patent Office at this stage when considered to be anticipations. As a result of the investigation made at this stage the Indian Patent Office on occasions, also, cites prior Specifications of the United Kingdom when considered to amount to anticipation. On occasions it also cites even scientific text-books and catalogues and matters of general knowledge. So that the field of investigation in practice appears in some cases to cover the contents of other documents as well as Indian Specifications.

It does not appear to be the practice however of the Indian Patent Office usually to make any investigation as to the possibility of there having been any prior grant : that is to say any search in the contents of Indian Specifications such as have not been published until after the date of the Applicant's application but such as will bear a date of grant prior to the date of his Patent if granted.

### **Notice to the Applicant.**

Section 5 in the words empowering the Controller to "refuse to accept the application or require that the application, specification or drawings be amended before he proceeds with the application" entails the obligation on the Controller, if he raises any of the



objections covered by the sub-sections 5 (1) (a) to (f), to notify the applicant of these objections. The effect in this respect is the same as the effect of the corresponding sections (3, 6, 7 & 8) of the English Act and of the current Patent Office procedure in the United Kingdom.

**The extent of the grounds on which objections can be made at this stage by the Patent Office before acceptance of the application.**

Little remains necessary to be here stated in respect of the nature in detail of the grounds of objections which may be raised by the Patent Office in such notifications : since these grounds have already been discussed when discussing the field of the search required to be made. The objection as to the title (Sec. 5 (1) (c)), and as to the application, specification and drawings not having been prepared in the prescribed manner (Sec. 5 (1) (b) ), and as to the specification relating to more than one invention (Sec. 5 (1) (f)) need no further comment : as to the objection as to the alleged invention not being a manner of new manufacture (Sec. 5 (1) (e)), this objection has already been fully discussed in Chapter VI to which reference may be made for further details for the purpose of ascertaining in what cases the Controller will be and when he will not be justified in taking such an objection : similarly as to the objection as to insufficiency of description (Sec. 5 (1) (a) and Sec. 5 (1) (d)) reference may be made to an earlier discussion of this matter in Chapter VII.

It must be noted that in addition to the grounds of objection open to the Patent Office at this stage which have already been mentioned as arising in connection with Section 5, the Comptroller is also empowered to refuse the grant of a patent at this stage under Section 69 on the ground that the use thereof "would, in his opinion, be contrary to law or morality". As to what grounds might justify such refusal, reference may be made to Chapter VI, where these topics have also been already discussed.<sup>37</sup>

It is submitted also as already indicated that the Controller also has an inherent power to raise objections at this stage on the ground that the application is merely frivolous; (possibly on the same ground that there is no manner of new manufacture in the alleged

<sup>37</sup> See pages 119 and 165 (above).

connection); or that there is no invention at all : but that he can only raise objections on these grounds last mentioned where the position is obvious on the face of the Applicant's Specifications above. As to the ground that there is no mention at all, in the sense of no inventive step, reference may as to this also be made to Chapter VI where this topic has already been fully discussed.

It is submitted that an objection as to want of utility, or an objection that the applicant was not the true and first inventor, or an objection of fraud or an objection on the ground of obtaining cannot ordinarily be raised by the Indian Patent Office at this stage. Whether or not the Indian Patent Office is properly entitled to raise objections for want of novelty at this stage has already been discussed earlier in this Chapter. It is submitted that in any event the Indian Patent Office is not entitled at this stage to go into any question of want of novelty on any ground of prior user.

**As to cases when an amendment is called for by the Controller for the insertion of references.**

In practice objections at this stage are usually made by the Controller on the ground of anticipations which he considers exist in other specifications ; and it is in this respect that questions most frequently arise as to how far the applicant is bound to insert references either in a general form or by specific reference by number to such other specifications.

The various steps in the English procedure regarding this matter of the insertion of references are treated of in Rules Nos. 28 to 37 of the English Patents Rules 1932. There are no corresponding rules applicable in India either relating to the search and investigation to be made by the Patent Office or relating to this matter of the insertion of references as a result of such search : but see only Rule No. 14 of the Indian 1933 Rules.

**Various means of remedying the objections by amendment.**

The objections raised at this stage by the Patent Office may be met by amendment by the insertion in the Applicant's specification of a specific reference by number to some other particular Specification ; or by amendment by the insertion of some general disclaimer in the Applicant's specification in the form of a descriptive reference in the portion dealing with a description of the prior art

which will cover the effect of the invention comprised by the other specification or by amendment of the Applicant's specification by cancellation of certain parts of it or of certain of its claims, or both ; or by amendment by rearranging or by re-writing certain parts of it ; or by amendment by additions or improvements of the explanations or directions contained in it ; or by any combination of these means.

It may be a matter of considerable practical importance to the Applicant as already indicated when a reference to a prior Patent is called for, which of the various forms of reference has to be adopted.

It will be observed that on the view previously arrived at the majority of objections raised at this stage by the Indian Patent Office in the form of citations of prior Indian Patent specifications are made as a result of a search for want of novelty which is nowhere under the Act directed to be made or authorised (as a ground for the refusal to accept an application). This remark, on this view, would apply to the greater part of the work of the Examiners in fact employed at the Patent Office for the purpose of carrying out such searches. But since the attitude adopted by the Indian Patent Office is in point of fact (with the one exception that it does not make the English search as to prior grant) to make an investigation over a somewhat similar field as that made by the Patent Office in the United Kingdom, it becomes of interest for practical purposes to consider such principles as have been laid down in the United Kingdom ; *viz.* :—in regard to the making by the Patent Office in the United Kingdom of citations in respect of anticipating specifications or other documents, and the principles enunciated in the English cases regarding the proper method for meeting such citations by the insertion of general or specific references in the Applicant's Patent or otherwise.

#### **Observations as to the practice relating to references in the United Kingdom.**

In the United Kingdom for practical purposes there are three distinct forms of references which may be adopted by the applicant in his Specification.

(i) A statutory Reference :—This will be in the form stated in Rule 31 or Rule 35 worded as follows :—

"Reference has been directed, in pursuance of (Section 7, sub-section (4) or Section 8, sub-section (2) as the case may be) of the Patents & Designs Acts 1907-1932, to Specification No. (such & such of such & such date)."

This Statutory Reference as provided in the English Rules is to be inserted in the Specification after the Claims.

(ii) A Specific Reference :—The usual wording of such reference is :—

"I am aware of Specification No. (such & such) and make no claim to anything described (or claimed) therein, but that....."

This is usually inserted after the clause known as the "Having Now" clause and preceding the Claiming clauses.

(iii) A disclaimer in the form of a general reference :—This will be without any mention of the number of the other Specification referred to. A common form is such as that worded as follows :—

"It has been proposed hitherto to (then the effect of the other invention is here described)".

This is usually inserted in the early part of the Specification which describes the state of the prior art : for the purpose of showing that the whole of such prior art is disclaimed.

It is of interest to note certain effects of the use of these different forms of reference. The one most popularly favoured by Patentees or prospective Patentees is the disclaimer by general reference. For as the Specification will then not carry on the face of it any specific reference to any other Specification the tendency is for the Specification to be considered to have a higher commercial value, which is unimpaired. It is clear of course that what is disclaimed, by description, as in the description of the prior art, forms no part of the monopoly which is protected. But there is a notion, particularly strong among the commercial world, that in such a case at least the Specification does no more than mean what it says ; and that it can have no sinister or unknown danger or be given any unexpected construction outside that to be placed on the words borne on its face.

The next favoured among the commercial world is the specific reference with its disclaimer : the least favoured commonly being considered to be the statutory reference. For it is considered, or

was so considered at least until recently, that a reference in the Statutory Form carried with it some taint that was derogatory. In fact among foreign patentees, especially, it seems that an idea was largely current that the mere existence in one Specification of a Statutory reference to a second Specification meant that the owner of the first patent would of necessity be under an obligation to pay royalties or something of the sort to the owner of the second. For such reasons applicants have frequently expressed a preference wherever possible to the second rather than the first of the three forms of reference abovementioned.

In actual results such popular view, certainly in regard to the first and second forms, is incorrect. It is to be noted that in the form of Specific Reference, there is an actual disclaimer of all that is claimed in the other Specification; and that such disclaimer is effective as a disclaimer whether it turns out that the other patent is in truth valid or invalid. Its effect is that something is to a certain extent in any event subtracted from the field of the monopoly claimed. It is to be noted on the other hand that in the form of Statutory Reference there is no actual disclaimer as such. The clause has been inserted because in the Comptroller's opinion it is necessary that the applicant should disclaim to some extent (or in part) the other specification. The clause may be treated accordingly as being inserted merely to show the Comptroller's opinion of the position. In the final result, if it can be shown that the Comptroller was incorrect and that the other specification in no way affects the applicant's specification, then the statutory reference may actually be treated as ineffective. For if there is nothing which need be disclaimed, the Statutory Reference is so worded that it disclaims nothing. In that event the Patentee keeps the whole monopoly mentioned as it stands without any subtraction. On the other hand if it is decided that the Comptroller was correct in his view, then when the applicant's specification comes to be construed, the Statutory Reference in it will be treated as an effective disclaimer disclaiming all of the other specification which requires to be disclaimed. There can be no danger therefore of the Specification being held bad for want of novelty or insufficiency in relation to the other Specification. Among patent agents therefore and other discerning people the Statutory Reference has recently acquired more favour than pre-

vously. It is in most cases found preferable to a Specific Reference and in some cases may even be preferred to a disclaimer by way of a general reference by description.

It may be noted that by adopting a general disclaimer in general words for the purpose of disclaiming what has been monopolised or described only in some other particular Specification, there is a danger that in the result actually more may be disclaimed than what has been disclosed in the prior Specification. Sometimes a mere condensed extract in general terms or a quotation of a small part only of such prior Specification, given without any specific reference to that Specification and taken out of its context may in the result have the effect of disclaiming too much.

There is an alternative form of the Specific Reference, occasionally used, worded as that which was directed to be used in the case of *Société des Usines Chimiques Rhone-Poulenc*<sup>38</sup> thus :—

“A process has been described in and claimed by Specification No. (such & such) for uniting (etc.) (here the effect of the other invention is described).” This was directed to be used in a case where the other specification to which the reference was to relate had not been published at the date when the Applicant’s specification had been filed ; and therefore the Applicants objected to using the words “I am aware of” in connection with the other specification. It was also suggested by the Court that this variant form of Specific Reference had an advantage in that it resulted in less ambiguity in its description of what was disclaimed.

As to this suggested advantage, it is submitted that while it may well be considered to be of some advantage that the description of what is disclaimed is to be contained in the Specification itself without the necessity for a reference to a second document (*i. e.* the other specification) yet this slight benefit is probably in most cases outweighed by the disadvantage of the ambiguity and source of danger which may arise at a later stage from an incorrect paraphrase of the effect of the other specification in the Applicant’s specification.

On the other hand this variant form of specific reference may be found to have an advantage which does not appear to have been

considered in the judgment in that case ; in that it uses no disclaiming words and may if construed, possibly, be held to have advantages similar to those already referred to in connection with a Statutory Reference : unless on the contrary view, it is held that by mentioning and describing the other invention this must be taken like an ordinary disclaimer to be a reference to the prior art so as to amount in any event to a disclaimer thereof.

The comments noted above are made somewhat tentatively and are not intended to be dogmatic : they will serve to indicate certain of the questions of practical importance which arise in connection with this matter of the insertion of references. This matter has recently assumed a greater degree of practical importance than formerly. It is to be hopefully anticipated therefore that any remaining doubts as to the effect of the various forms of reference in use or as to the form of those which should be used will speedily be cleared up in forthcoming decisions.

It is to be noted that it is now the English practice, as directed by Section 7 (5) of the English Acts 1907-1932 by virtue of the 1932 amendment, for the Examiner's report to include, besides United Kingdom Specifications, also any document which is within the knowledge of the Comptroller (or Examiner) as mentioned in that sub-section which contains a claim or a description wholly or in part of the Applicant's invention. It is to be noted that the Act does not make it obligatory on the Patent Office to make a search for these documents as for United Kingdom Specifications, but only provides for mention thereof to be included in the Examiner's report if within his knowledge. In practice however it appears that an investigation which is by no means perfunctory is usually made. Specifications of Indian Patents and of American and other foreign patents which have been published in the United Kingdom will fall under these provisions.

It appears to be the practice in the United Kingdom in cases where another specification is discovered by the Patent Office which is considered to be one in which the Applicant's invention is wholly claimed, to stop making any further search ; and to notify the applicant in the form of a Provisional Report. For if the difficulty which appears on the face of it to be insuperable cannot be got over, it will be mere waste of time for the Patent Office to continue

and complete the search. If however the Applicant by amendment can get over the difficulty raised at that stage, then the search will be proceeded with. This is provided for under Rule 28 of the English Rules which reads as follows :—

“28. When the Examiner in prosecution of the investigation prescribed by sub-section (1) of section 7 of the Acts finds that the invention claimed in the specification under examination has been *wholly claimed* or described in one or more specifications referred to in the sub-section, he shall, without any further prosecution of the investigation, make a provisional report to that effect.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-section (4) of the said section. If however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made, and the specification shall be dealt with as provided in sub-section (3) or sub-section (4) of the said section, as the case may require.”

For present purposes it is not necessary here further to discuss the English Rules : these will be found in full in Appendix No. 3 below.

It appears to be the practice in the United Kingdom not to order a Statutory Reference to a specification of a prior patent which has been revoked.<sup>39</sup>

### **Decided cases in connection with the English practice.**

It may be of use here to note the result of the decisions in certain recent cases decided under the English Patent Law. As has been stated a search and procedure is in practice adopted by the Patent Office in British India which is similar in many respects to that conducted in the United Kingdom under Sections 7 and 8 of the English Act. The principles of these cases may it is submitted therefore be considered as applicable under Indian Patent Law

<sup>39</sup> See *British Celanese etc. : Application* (1932) 49. R.P.C. 283.



except in so far as they refer to a "Statutory Reference" which is a thing non-existent under Indian Patent Law.

(i) A recent decision is that in *George Baker's Application*<sup>40</sup>. The question arose in relation to certain opposition proceedings. In that case the Patent Office had decided to allow the grant of the Patent subject to an amendment of the applicant's specification which would make the acknowledgment of the other invention more precise, but without requiring a specific reference by number to the opponent's specification. The opponents appealed. Luxmoore J. in deciding the appeal held that that was a case where a reference stating the number of the opponent's specification was necessary. The case however turns on its own facts and does not, it is submitted lay down any generally useful principles as to when a reference should be by number and when it should not.

(ii) See : *Ruth Aldo Co. (Inc.): Application*.<sup>41</sup> In that case the Comptroller had ordered a statutory reference to another specification to be inserted in the applicant's specification. This was so ordered before the application was accepted by the Patent Office: and the particular statutory reference was duly inserted by amendment in the applicant's specification; and the application was then accepted. Opposition proceedings followed. In these the opponent, being the owner of the Patent to which the statutory reference related, claimed that the statutory reference was insufficient and in effect that the Patent was invalid unless it contained a specific reference to his specification with an express disclaimer thereof. The Controller refused to order any such specific reference and allowed the grant of the Patent with the Specification containing the statutory reference to the opponent's specification. Both parties appealed: the opponent on the ground that the grant should be refused unless the specification contained a specific reference (with an express disclaimer); the applicant for patent on the ground that the Comptroller was wrong in demanding any reference at all. It was held that the applicant's appeal succeeded; and the statutory reference was struck out. The question being raised whether it was possible to delete a statutory reference, it was held that it was possible.

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<sup>40</sup> (1934) 51. R.P.C. 144.

<sup>41</sup> (1933) 50. R.P.C. 253.

(iii) See : *British Celanese Ltd.'s Application*<sup>42</sup>. In that case the Comptroller had ordered a statutory reference. On appeal it was decided by Luxmoore J. that in that case no statutory reference was called for. The conditions requiring a specific reference were also referred to in regard to the conditions laid down in *Hopkin's Patent*<sup>43</sup> which were mentioned with approval. The following passage from the judgment of Luxmoore J. for convenience of reference may here be noted :—

“I gather that the learned Comptroller has directed the insertion of the reference to the Opponents' Specification by number because in his opinion notice of this Specification should be given to the public. I am unable to follow his reasoning in this respect. The learned Comptroller has himself decided (and I agree with him that the case does not fall within any of the grounds which would justify him in making an order for a specific reference ; yet he in fact directs a reference by number. So far as I understand the position, a reference by number to a particular specification is a specific reference to that specification no matter in what part of the specification that reference appears. To meet any possible criticism as to the proper description of the prior art, Sir Arthur Colefax on behalf of the applicants offered to amend his Specification in the following respects (These were then stated). He also suggested, as part of this proffered amendment, that all reference to Peytral's process should be struck out. In my judgment, the proposed further amendments in conjunction with the description of Peytral's process as amended by the Comptroller-General make the reference to the state of the prior art accurate and free from all ambiguity, and this being the case I can see no adequate reason for any mention of the Opponents' Specification by number. The conclusion to which I have come is that the Applicants are right in objecting to the insertion of any reference by number to the Opponents' Specification in their own Specification”.

(iv) See : *Société des Usines Chimiques Rhone-Poulenc*.<sup>44</sup> In that case the Comptroller had ordered a specific reference to another specification to be inserted in the Applicant's Specification. The

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<sup>42</sup> (1933) 50. R.P.C. 247.

<sup>43</sup> (1910) 27. R. P. C. page 72.

<sup>44</sup> (1933) 50. R.P.C. 230.

case was one where the other specification was not published at the time the Applicant's specification was filed but would obtain a prior date by virtue of the reciprocal arrangements under Section 91 of the English Act. On appeal Luxmoore J. upheld the decision of the Comptroller, is so far as it directed a reference by number but dismissed and varied the form in which such specific reference in such a case was to be worded. The following extract of the judgment is of interest :—

“The chief object of a specific reference is not to advertise a particular patent, but to give the public notice that there is danger of infringement of an earlier patent if the invention covered by the later patent is put into practice. Considering and comparing the two material Specifications, I am satisfied that the invention described in and claimed by Specification No. 328,919 is involved in that described and claimed by Specification No. 340,445 I agree with the Comptroller-General that it is essential in the interests of the public that there should be a specific reference to the earlier Specification in the later Specification.

The question next to be considered is the form such specific reference should take. The Comptroller-General has decided that it should be effected by amending the Applicant's Specification by the insertion at line 79 on page 2 after the word “that” the words “we are aware of specification No. 328,919 and make no claim to anything claimed therein but that”. Mr. Shelley objects to these words on the ground, first, that the Specification No. 328,919 was not published at the date of the application for No. 340,445 and it is therefore untrue to state that the Applicants are aware of the earlier Specification, and, secondly, that the words directed to be inserted import ambiguity into the later Specification. I am of opinion his objection is justified on both heads. If a specific reference is inserted in a specification followed by a disclaimer, the disclaimer should state as clearly as possible the precise matter disclaimed, and it is, I think, wrong to put the disclaimer in general terms, leaving it to the reader to make up his mind after reading the two material specifications what it is intended to disclaim.

In my judgment the reference in this case should be in the following words “A process has been described in and claimed by Specification No. 328,919 for uniting two or more sheets of glass

with one or more interposed layers of strengthening material consisting of bringing together the surfaces to be united to effect preliminary cohesion and compressing the united sheets in a closed vessel by means of a fluid introduced under pressure while the contacting surfaces are softened, the assembled sheets being directly exposed to such fluid." I think that these words should be inserted as a new paragraph on page 1 of Specification No. 340,445. The order of the Comptroller-General will be varied accordingly by directing this insertion and by omitting the amendment directed to be made on page 2 at line 79".

The question of what constituted a master patent was also discussed with reference to the judgment in *Hopkin's Patent* (1910) 27. R.P.C. at page 72.

(v) See Application for a Patent by *Daniel Adamson & Co. Ltd.*<sup>45</sup> In that case the Assistant Comptroller had refused to order any amendment of the applicant's specification by a reference to the opponent's specification; and this decision was upheld on appeal by Luxmoore J. The question was whether the opponent's specification constituted a master patent on which the applicant's patent was a derivative and it was held not to be a master patent. The following extracts from the decision of the Assistant Comptroller in discussing the point in issue may be of interest:—

"It is claimed by Mr. Moritz that Specification No. 270,250 has the attributes of a pioneer or master patent, and that the heat exchangers claimed by the Applicant fall within the claims made in the said prior Specification.

The expression "master patent" is incapable of any precise definition. In the well known case of *Hopkins' Patent*<sup>46</sup> it was said by the late Comptroller-General, Mr. Temple Franks, that there should be some wide and governing principle not hitherto claimed or described, to bring an invention within the meaning of the term master patent. But the term is, I think, a relative one, and where a series of inventions may be regarded as derivatives of an earlier invention which discloses for the first time an idea which is common to them all, the said earlier invention may have

<sup>45</sup> (1933) 50. R.P.C. 171.

<sup>46</sup> (1910) 27. R.P.C. 72.

the character of a master patent in relation to the series in question, even though it itself may be one of a series occupying a similarly derivative position in relation to some still earlier and wider patent. Smaller branches of a tree have the same sort of relation to a main branch that the main branches bear to the parent stem. The first patent for a triple heat-exchanger in which flue gases heat both feed-water and air must have been in the fullest sense of the words a master patent, but that fact does not exclude the possibility of a later master patent for some particular kind of triple heat-exchanger having distinctive characteristics and capable of assuming various inventive forms or varieties. I should therefore define a master patent, if it must be defined, as being a patent for an invention involving some novel idea or conception which is capable of assuming various forms, each of which necessitates some definite but secondary inventive step." (Then followed a comparison of the two inventions). "I do not think that I ought to resolve a doubt of this kind in the Opponent's favour if the result is to be an amendment of the Applicant's Specification of a kind which would be publicly regarded as indicating that the Applicant's Patent is a derivative or tributary patent. The effect of a specific disclaiming reference to an opponent's Specification, introduced in proceedings of the present kind, is well-known, and it may detract gravely from the commercial value of the Applicant's Patent. I have come to the conclusion that the conditions laid down in the case of Hopkins' Patent (*loc. cit*) as necessary conditions for the insertion of a specific reference are not fulfilled in the present case and I refuse to order the insertion of such a reference."

It will be useful also here to note the following extract from the judgment of Luxmoor J. :—

"Before dealing with the particular features of the present case, it will I think be convenient to state what the law is with regard to the insertion into Letters Patent of what is termed a "reference." A reference may be either general or specific. A general reference is inserted for the purpose of preventing the later patentee from alleging his invention is wider than that which he is entitled to claim, both in his own interests in order that his specification may not be invalidated by excessive width of claim

and in the interests of the public, on the ground that the public are entitled to know what the patentee is entitled to claim and to have a fair description of the existing state of knowledge (see *Guest & Barrow's Patent*, 1888) 5 R.P.C. page 312 at page 315.

A specific reference is inserted in order to warn the public and to call attention to a relationship existing between the invention described and claimed in the specification in which such reference appears and the invention described and claimed in the Letters Patent the subject of such specific reference. Lord Buckmaster when Solicitor-General laid it down in the case of *Wakfer and Peek's Application*, (1913) 32. R.P.C. page 199, that a specific reference is not intended for the protection of an opponent who desires to have his patent referred to in the applicant's specification, but is introduced in order that the specification may be clear and definite and that a member of the public who desires to use the invention for which the applicant is seeking Letters Patent may not be misled into thinking that an invention is involved or included in the specification which is in fact the subject of protection of prior Letters Patent of which no warning has been given. Lord Buckmaster said at page 202: "The idea that any patent which protects what is called a principle is therefore a patent to which reference" (and here I think it is plain he is speaking of specific reference) "must be made in the Specification of any subsequent patent that affects similar matters is one to which I cannot accede.

My view of the matter is and has always been that a specific reference should only be inserted when its absence would lead to confusion or to misunderstanding of the real nature of the invention, and to the risk that a person reading the specification might think that the discovery it described included or involved the discovery already protected by an undisclosed patent." I respectfully agree with this statement of law. In my judgment it accords with the decision in *Hopkins' Patent* (1910) 27. R.P.C. page 72, with which I also respectfully agree. I should point out that there is a wide difference between the case where the existence of an earlier patent may imperil or prevent the user of the invention described in the later specification and the case where the existence of the earlier patent might be and is a ground for opposing the grant of a patent in respect of the invention described in the later specification. As

Mr. Justice Sargant pointed out in *Re Ucar's Patent* (1922) 39. R. P. C. page 269 at page 276, "the question of warning the public that the patent before them is a patent which may not be available to be used at all except with the consent of some other person is not the same as the question of warning them that there is a possibility that the patent in question may not be a patent which confers monopoly rights. It is a very different thing. Everyone dealing with the subject-matter of patents must know that the question of the monopoly rights of a patentee are always somewhat doubtful and anyone attempting to take an assignment of the monopoly rights is in a different position from a person who is merely attempting to use the invention, and it is more necessary that a person should be warned that it is not safe to use the invention than that a person should be warned that the monopoly rights are liable to some particular defect. I do not think therefore that specific reference ought generally to be indulged in so much in the case merely of there being danger to the monopoly as there being danger with regard to the safe user of the patent." Let me apply these tests to the present case. (A comparison is then made between the two inventions described in the two specifications). "In my judgment.....in view of the express preference in the Applicant's Specification to the difference between the apparatus claimed and other heat exchanger apparatus with tubes enclosed in concentric tubes, I think this is not a case where any specific reference to the Opponent's Specification ought, having regard to the principles I have stated, to be allowed. I think that the Assistant-Comptroller's decision was correct and ought to be affirmed."

This decision is both important and clear : as an authority for the principle that specific references (*i. e.* by number) should only be required in cases where the owner of the patent applied for would be unable to use the invention to which it relates without the consent of some other person who is the owner of another patent.

(vi) See : *N. V. Philips' Gloeilampenfabriken: Applications*.<sup>47</sup>

This case is of interest in the clear light that it throws on the procedure adopted in the United Kingdom under the English Patents & Designs Acts 1907-1932 at the stage after the Application is made and before it is either accepted or refused or directed to be amended

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<sup>47</sup> (1933) 50. R. P. C. 167.

by the Patent Office. In this case the application for Patent had been submitted, but the Examiner in connection with his investigation under Section 8, of the English Acts had taken objection to the Application on the ground that the invention claimed had been in part claimed by another specification, and that specific Reference with a disclaimer was required to be inserted in the Applicant's specification. The other specification in this case was one which had not been published until after the date which the Patent applied for would bear if granted: it was however deposited pursuant to an application which if granted would (*i. e.* by reason of the reciprocal arrangements) bear a date earlier than the date of the Patent applied for. The Patent Office were willing to accept the application if the reference and disclaimer were worded as follows:—"I am aware of Specification No. (so & so) and do not claim anything claimed therein." The Agents for the Applicant were willing to insert a reference and disclaimer only in the words which would acknowledge the other Specification by number but only disclaim "anything protected therein." The reason for their contention is fully explained in the report of the case. The decision on the point was given by the Comptroller who upheld the view of the Examiner; and held that the form of disclaimer offered by the Agents could not be accepted as sufficient to avoid the citation made by the Examiner under Section 8; and that in the circumstances it was for the Applicants to put the Specification into a form which would delimit the invention to which they considered themselves entitled and then for the Patent Office to consider whether the citations under Section 8 had been avoided, or whether the insertion of Statutory References to the other Specification under Rule 35 was called for.

(vii) See: *E. I du Pont de Nemours & Co: Application*.<sup>48</sup> This was a case heard in 1931 reported in the 1933 volume as it had then recently been decided to report the case. In this case the Examiner had reported in pursuance of Section 8(1) of the English Acts and had in such report cited another specification. The Applicants offered certain amendments of their claims in their specification which, they contended, avoided all necessity for any reference to the other specification. The acting Comptroller held that the insertion of the claims according to the proposed amendment was



not sufficient amendment by way of disclaimer and refused to allow such amendment. The Solicitor-General (Sir R. Stafford Criffs) upheld the decision of the Comptroller and accordingly dismissed the appeal and ordered the insertion of the reference (by number) in question.

(viii) See : *Hopkin's Patent*<sup>49</sup> : *Application for Revocation under Section 26*. The decision of the Comptroller-General in that leading case is so important that it will be useful and convenient if it is here set out in full :—

“With regard to the whole question of specific references including in the term all references by name and number, whether inserted in the more formal way before the Claims or in the less formal description of the invention at the beginning of the Specification—I have carefully considered the various decisions and reported cases upon the subject. As a result of such consideration I do not find it easy to formulate any very clear or definite principle from the various decisions referred to, and in my opinion much of the reasoning and many of the principles enunciated have become less relevant or less applicable at the present time for the following reasons. Before the powers of search and the extensive powers of amendment in regard to the description and Claims were conferred on the Comptroller, it was not the practice to call on a patentee to alter his description or his Claims to any considerable extent. The Specification was left, as far as possible, in its original form, and, as a consequence, a specific reference often became a necessity both in the interests of the public and of a prior patentee. There was no other way of attaining the desired object of distinguishing, as far as possible, between new and old. But where a Specification is properly and scientifically drawn there would appear to be, as a general rule, little or no need for specific references or disclaimers. The ideal Specification would claim, and claim only, in clear and succinct language the patentee's invention, and distinguish it in the description from what had gone before, or show its relation to previous inventions. Matter which was irrelevant would be excluded, and only such matter inserted as would be reasonably necessary for showing the best form of, or the best method of carrying out, the invention sought to be protected. In a Specification so framed

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<sup>49</sup> (1910) 27. R. P. C. 72.

there could be no ambiguity, and no need, as a rule, for further protection of the public or prior patentees. Under existing circumstances it ought, I think, to be the aim of the Office to secure, as far as possible, that Specifications shall be so framed, and thus obviate the necessity for inserting references and disclaimers, which, in many instances are only inserted as a rough and unscientific method of defining the real scope of the invention, and its relation to former invention and discovery.

After careful consideration of the whole subject, I think it will be for the general convenience, if I attempt to formulate the principles which, in my view, ought to regulate the practice of this Office in the future, in directing specific references or disclaimers by name and number, and which as at present advised, I desire to apply in all cases which come before me. Such principles can of course be only very generally suggested, and must be open to exception in special cases, but I think some definite practice may tend to prevent disputes and disagreements in the future. It is generally conceded that the real object of such references is not to advertise a prior patentee, but to guide the public, to define the true scope of an invention, and to bring into clear light the relationship and importance of the Patent to another. What is requisite is to ascertain the true value of the invention involved: and I think the real underlying principles, which should govern the insertion of specific references, is this—"Is the governing idea, or basic principle of an invention sought to be protected, claimed or protected by a specific earlier Patent?" In other words the condition necessary is, that the new invention should be based on a definite invention already protected, and the earlier invention should be clearly and unequivocally repeated or involved in the new Specification.

Applying this general principle to more specific instances, it would seem that there are two classes of cases to be considered (1) where what is called a "master Patent" is involved (2) where there is no claim to a "master Patent" as such. Assuming that the Specification is clear and unambiguous and otherwise free from objection, I think the principle which calls for a specific reference in either of these cases is substantially the same, although the method of applying it may differ in the two cases.

(1) To take first the case of a "master Patent". I think that

in all discussions in regard to specific references this term should be strictly construed, and confined to cases where there has been the discovery of a new and important pioneer principle—so to speak—which has been embodied in practical form or shape and claimed in general terms. There should be some wide and governing principle not hitherto claimed or described to bring the invention within the meaning of the term “master Patent.” Used in this sense a specific reference is rightly inserted if the new invention is merely an improvement or amendment on the “master Patent”, and for this reason. The “master Patent”, *ex concessis*, stands alone; it has broad claims, which in view of the importance of the principle involved are allowed a wide construction. It may be said to comprehend and foreshadow any construction embodying the principle or providing any similar means for carrying it into effect. Thus any later Patent which amends or improves may be rightly looked upon as merely defining or shaping an invention already specifically or generally claimed in the “master Patent”. The governing principle of the later Patent is found in the former, and the reference is rightly inserted in accordance with the principle stated above, because the earlier invention is, in effect, taken and appropriated as the basis of the latter.

It is not indeed every case, where a “master Patent” is concerned that will call for such references, but only when a wide and generous construction of the “master Patent” claimed appears to involve or foreshadow the later invention. The mere connection of an invention with a “master Patent” will not necessarily be sufficient. The later invention must be formed directly or by implication on the former Patent. Further, there may possibly be cases where time and notoriety have made the “master Patent” so well known that a specific reference may become superfluous and unnecessary. Where a “master Patent” in this sense is claimed, the proper notices should be given under the Rule, so that an adequate search may be made both by the Office and the applicant. The Office search at the examination stage must not be relied on as conclusive on this point.

(2) In the cases where there is no proper “master Patent” involved, I think the same general principle in regard to specific references, applies; but the conditions are stricter and more severe.

I think that in such cases a specific reference should only be allowed where the following conditions are present *viz.*:—(a) The patent to which reference is asked should be clear and distinct in its own field and, as far as can be gathered, free from anticipation. (b) The invention claimed therein must be clearly and unequivocally claimed or included in the later Specification. (c) It must be claimed or included substantially as a whole and not merely in part. (d) The improvement or addition claimed by the applicant must be small and the governing principle, so to speak, must come from the prior Patent.

The danger to be guarded against in these cases is, the undue preference which may be given by the naming of one Patent which is not alone in the field, and I think the practice should, therefore, be confined generally within the limits indicated above. In such cases a specific reference is necessary, because the prior invention is distinct, and is re-claimed in *toto* in the later Patent; it is the principal or governing factor, and there is little or no advance in inventive power. In many such cases such a reference would be an alternative to the refusal of the Patent or of a specific claim. In these cases I think, that, generally speaking, the Office search will be sufficient to raise a *prima facie* case under (a) as to absence of anticipation &c.

In my opinion specific references ought in general to be confined to the two classes of case indicated above; and that in all other cases general disclaimers only should be inserted in the later Specification, embodying, if need be, the substance of any prior Patent which appears involved, but without name or number. In this connection I think it is clearly important in the interests of the public that what is the subject of a recent and existing Patent should not be stated as if it was matter of common knowledge, and I think protection should be given to prior patentees when this is the case by suitable amendment or disclaimer. I do not indeed think that it is any part of the Comptroller's duty to consider the question of infringement; or that the public can ask this Office to protect it by special reference or otherwise where infringement is likely or possible. This has been clearly laid down in many reported cases. I think, however, the public have a right to be warned, as far as possible, of what is special, and what is matter

of common knowledge. In certain cases also it may amount to a disparagement of the invention of a prior patentee to state it in terms of common knowledge, and the practice is thus rightly open to objection.

(3) So far I have dealt with Specifications which are clear and unambiguous or can be made so by proper amendment; there remains the class of cases where the Specification is ambiguous and it is difficult or impossible to introduce amendments or disclaimers or to rewrite it so as to disclose the true scope of the invention and distinguish it from what has gone before. In these cases it may still be necessary to protect the public, and to do justice to prior patentees by the rough and ready means of inserting specific references in certain special cases. It should, however, I think, be borne in mind that this is not the best or most scientific method, and that it is merely employed to save time and trouble in cases where other amendment seems impracticable.

It should further be added that in the early examination stages specific references must of course, still be inserted, where necessary, to penalise a patentee who cannot or will not meet the objections of the Office. Finally, in all that has been said above on the question of specific references it has been assumed that there is some patentable invention involved in the proposed Patent, and that it has escaped rejection on the ground of complete anticipation."

The observations in that decision have been continuously and entirely upheld in later cases : save only for the minor point that it has been observed by Luxmoore J. that there is really no necessity to make any practical distinction between the case where the other Specification to which a reference is to be made is a "Master Patent" and the case where it is not.

#### **Further observations as to the practice in British India :**

The Controller cannot, of course, order any "Statutory Reference" in British India ; for there is no provision in any Act or Rule providing for such a thing, and he is not empowered to do so. He does however in practice give directions for Specific References by number to be inserted by amendment in the Applicant's Specification in cases where he considers this to be necessary. This he can do in a precisely similar manner to that customarily adopted by the

Comptroller in the United Kingdom ; by refusing to accept the application without such an amendment as may be suggested by him. He can and does also in other cases give directions on similar terms for the insertion of ordinary disclaimers in the form of a general reference by description precisely as is done in practice in the United Kingdom.

After an objection has been raised by the Patent Office to the acceptance of an application, if the Applicant cannot satisfy the Controller by any form of amendment that the objection has been removed, then the Controller in British India, having no power to order a Statutory Reference, has no intermediate choice of action ; but he must either accept the application with such faults as it has or refuse to accept it altogether.

It is the practice of the Indian Patent Office not to give disclosure to any person of the result of any search which has been made by it. The application, which may be made by any person in the United Kingdom for such disclosure under the English Rule 37<sup>50</sup> is directly provided for by the proviso to the English Section 68. The English Section 68 and its proviso reads as follows :—

“68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed :

Provided that, on application being made by any person in the prescribed form, the Comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent where either—

- (a) the complete specification has been accepted ; or
- (b) the complete specification has been published and the application has become void.”

Provision is expressly made under the English Act, by Section 68 and Rule 37, enabling any person, whether he was a party to the original application or not, to obtain disclosure from the Patent

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<sup>50</sup> See Appendix No. 3 below.

Office of the result of a search made under Sections 7 and 8 of the English Act<sup>51</sup>.

There is no corresponding proviso in the Indian Section 60 : which reads merely as follows :—

“Reports of or to the Controller made under this Act shall not in any case be published or be open to public inspection.”

### **Time for the raising of objections by the Patent Office.**

Ordinarily all objections emanating from the Patent Office will be notified to the Applicant for Patent at the stage before the acceptance or the refusal, as the case may be, of his application. It has however been held in England that it is allowable to the Patent Office to reopen the matter if necessary later and that “there is jurisdiction in the Comptroller to take notice of any reason for not granting a patent at any time before the grant is made”: even though “such reason might properly have been taken and considered at some earlier stage in the proceedings.” The reason for this decision is, in the words used by Luxmoore J. that “the duty of the Comptroller subject to the provisions of the Consolidated Acts (*i.e.* the English Patents and Designs Acts 1907-1932) is twofold, to protect the public and to see that the Crown grant is not improperly given.” In the case in question an objection in connection with Section 38A of the English Act arose during opposition proceedings : it was held that it was not open to the opposer to take the objection but that it was open to the Comptroller to do so.<sup>52</sup>

### **Right of appeal.**

The effect of Section 5(2) of the Indian Act is that the applicant will have a right of appeal from a decision of the Controller both in a case where the Controller refuses to accept an application for any one of the objections indicated in this chapter and in a case where for any one of such objections he refuses to accept the application except on an amendment from the Applicant. Such appeal is however to the Governor-General in Council only.

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<sup>51</sup> See *T's application* (1925) 42. R. P. C. 505.

<sup>52</sup> *i.e.* see *H. A. Metx Laboratories Inc. Application* (1933) 50 R. P. C. 355 at p. 358.

## **CHAPTER X**

### **STAGES OF PROCEDURE BETWEEN APPLICATION AND GRANT WHEN OPPOSED—OBJECTIONS AFTER ACCEPTANCE OF THE APPLICATION BUT PRIOR TO THE GRANT—OPPOSITION PROCEEDINGS BEFORE THE CONTROLLER.**

**As to who may oppose.**

By Section 9(1) of the Indian Act of 1911 it is provided as follows :—

“Any person may on payment of the prescribed fee, at any time within four months from the date of the advertisement of the acceptance of an application, give notice at the Patent Office of opposition to the grant of the Patent on any of the following grounds, namely (then the grounds are stated): but on no other ground”.

The words “any person” are the same as the words used in the corresponding Section 11 of the English Act: these words in practice have acquired a restricted meaning.<sup>1</sup>

<sup>1</sup> The following observations may be of interest as to the history of this matter in England: that is to say as to the question whether any particular degree of interest was required to be shown by an opponent in proceedings in opposition to grant, or whether any member of the public with no special interest was entitled to oppose the grant. Before 1852 a procedure totally different to the present procedure was in force. Under that procedure opposition to a grant of patent was only open to such persons as had, previously to the filing of the application for the Patent to be opposed, filed documents known as caveats. (See Edmunds at p. 650.) Such documents were in the nature of caveats relating to certain general classes of product or manufacture and might be in force for one year. They did not refer specifically to opposition to any one Patent. It is not necessary for the present purpose therefore to go back earlier than 1852.

In 1852 was passed the Act known as the Patent Law Amendment Act of 1852 (15 & 16 Vict. c 83). It was this statute which discontinued the caveat procedure. This statute, while making available the right of opposition to persons who had not had such right before, imposed a certain limitation on the



### Who may oppose.

In addition to Section 9 abovementioned of the Act itself the Rule affecting this matter and made under the Act is Rule 21(1) of the Indian Patent and Designs Rules, 1933 which is as follows :—  
 “Within 14 days of giving notice of opposition, the opponent shall leave at the Office a full written statement in duplicate, setting out fully the nature of the opponent’s interests, the facts upon which he bases his case and the relief which he seeks.”

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class of persons who could oppose a grant of patent, such as may be compared to the limitations still held to be in force under the present English law, by stipulating that only such persons could oppose who had an interest in the matter. Thus in Section 12 of the Statute of 1852 the wording relating to oppositions was as follows :—“and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at such place and within such time and subject to such regulations as the Commissioners shall direct”.

The Act of 1852 held the field till it was repealed in 1883 by the Act of 1883.

The Act of 1883 which was in 1888 consolidated and known as the Consolidated Acts of 1883-1888 was differently worded from the Act of 1852. Curiously enough no specific reference was made in the Act of 1883 to any interest (such as had been specifically mentioned in the Act of 1852) as being required to be possessed by an opponent in proceedings of opposition to grant at the first stage of such proceedings before the Controller : a qualifying limitation was however made in regard to such proceedings at the stage of appeal before the Law Officer. By Section 11(3) of the Act of 1883 the words used in referring to the opponent before the Law Officer were :—“any person.....being in the opinion of the Law Officer entitled to be heard in opposition to the grant”. It may be remarked that even in this passage of the section no specific reference is made to the degree of interest required to be shown by the opponent ; nor is the word “interest” which was previously used in the Act of 1852 used at all in Section 11 of the Act of 1883. In regard to the proceedings in the first instance before the Controller the wording of the Act of 1883 (by reason of its omission of all reference to any interest required), appears to have been at first understood to mean that any member of the public could constitute himself an opponent and be heard in opposition to the grant before the Controller. This appears from a passage in an 1890 edition of Edmunds on Patents for Inventions in which, in the body of the text of the book, the following statements of the law as it was then supposed by him to exist is to be found at page 175 :—  
 “Any person may oppose the grant of a patent before the Controller but on appeal to the Law Officer only such persons as in his opinion are entitled to be heard will be granted a hearing”. In regard to the proceedings on appeal before

From the fact that the rule expressly stipulates that the opponent shall in his full written statement set out fully the nature of his interests, it must be understood that the Indian practice is intended to follow the English practice in allowing not the public in general to oppose a grant but only those persons who have a

the Law Officer it was very soon that the words of Section 11 of the Act of 1883 were interpreted in decisions to mean that before the Law Officer in any event only an opponent would be heard who showed that he had a substantial personal interest in opposing the grant.

The next stage in the decisions construing the Section was that it came to be decided that the view, of which the statement of the Law by Edmunds as above is an example, was incorrect. It came to be decided that the proceedings before the Law Officer were only in the nature of an appeal proper from the proceedings before the Comptroller; and that the same degree of interest was required to be shown by an opponent before he could be heard in opposition before the Comptroller also in the first instance as before the Law Officer at the later stage on Appeal. The following English cases may be referred to on this point: *In re Glossop* (1884) Griffin P. C. 285 (Herschall S. G.) *Re Heath & Frost* (1886) Griffin P. C. 288 (Clarke S. G.) *Re Hookham* (1886) (Griffin A. P. C. 32 (Webster A-G.) *Re Lancaster* (1884) Griffin P. C. 293 (Gorst S-G.) *Re Hill* (1888) 5. P. O. R. 599. *Re Macevoy* (1888) 5. P. O. R. 285. *Re Baristow* (1888) 5. P. O. R. 286. *Re L'Oiseau and Pierrard* (1887) Griffin A. P. C. 36. (See Edmunds 1890 Edn. p. 175). *Brownhill's Patent* (1889) 6. P. O. R. 136.

If the Act of 1883 had not been preceded by the Act of 1852 containing as it did so exclusive a limitation of the class of persons who would be allowed to oppose a grant to the class of interested persons only, or, if the Act of 1883 had not been preceded in England before 1852 also by the system, older still, under which none could oppose a grant except the few persons who had previously lodged Caveats, it may well be doubtful whether the wording of the Act of 1883 taken alone would have been construed as it was. On the wording of the Act of 1883 taken by itself there would seem little to prevent any member of the public from opposing a grant of Patent. It is due no doubt to the history of Patent administration in England which preceded the Act of 1883, that in the result the words "any person" or "any person entitled to be heard" used in the Act of 1883 have come to carry the limited meaning of "any interested person".

In any event the Courts had long before the subsequent recent legislation in England clearly defined the law to be, that a certain degree of personal interest was required to be shown by an opponent in proceedings in opposition to the grant of a patent before he could be heard either before the Comptroller in the first instance or on appeal before the Law Officer.

The Act of 1907 both in its original form and in its form as amended by the Act of 1932 has precisely followed the exact wording on the point now under consideration which was used in the Act of 1883: the only difference being

certain quantum of interest in the Patent under consideration. This Indian Rule of 1933 follows in its wording precisely the corresponding English Rule which is Rule No. 43 of the Rules framed under the English 1932 Act.<sup>2</sup>

Since the new rule is both explicit in itself and follows the wording of the English rule now in force, and, since, as has been already mentioned, the English practice is settled in requiring that

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that by the Act of 1932 an Appeal Tribunal which was created under that Act took the place of the Law Officer to whom appeals had lain under the previous acts. The similar material words still appear in Section 11(3) of the 1932 Act in the following form :—"the opponent, if the opponent is, in the opinion of the Tribunal, a person entitled to be heard in opposition to the grant of the patent .....". Moreover just as was the case under the Act of 1883 there is still, curiously enough, no similar proviso inserted in Section 11(2) which refers to the hearing in the first instance before the Comptroller. Neither is there in this section any specific reference to any precise degree of interest required nor is the word "interest" itself used at all in the section ; and the bare words "any person" are retained, unqualified, so that on the face of the section alone, apart from the manner in which it has been construed in the cases, there is no indication that it is not open to any member of the public to oppose.

But since the material wording of the new Statutes is the same as that of the Act of 1883, the decisions in the cases throughout continue to be as effective as ever. By these decisions it has become a settled rule of law that none but a person interested can oppose. The 1932 English Rules also postulate that the opponent must have a certain degree of interest in opposing the grant : by expressly demanding that an opponent in proceedings of opposition to grant shall in his Notice of Opposition set out fully the nature of his interest. See Rule 43. Thus at the present day there is no doubt as to what the Law is on this point in England and it has long been settled that an opponent must have a certain quantum of interest both before the Comptroller and before the Appeal Tribunal. The only matter on which doubt can arise in cases at the present day in England is whether in a particular case a particular opponent has sufficient interest to entitle him to oppose or not.

<sup>2</sup> In the previous Indian Rules of 1912 the corresponding Rule was Rule No. 15(1) which was worded as follows :—

"Within 14 days of giving notice of opposition the opponent may, and shall, if at any time so required by the Controller, leave at the Office a full written statement in duplicate of the reasons for, and extent of, his opposition, and of the grounds upon which he relies in support of his opposition". In that rule there was no such express mention of the interests of the opponent : though the general words "the reasons for and extent of his opposition" might have been said to include a statement of the nature of his interests.

only interested persons may oppose, it must, it is submitted, now (in any case since 1933 whatever the position was before), be clear that in India also the practice is to be that only those persons may oppose who have a certain quantum of interest in the Patent which they are opposing. If this is so, the words "any person" in Section 9 of the 1911 Indian Act must be construed not to mean any person in the sense of the public at large, but to mean only "any interested person".

It is submitted that this is the meaning which the words have acquired in India just as they have in England: in spite of the difference that in India the precise reasons which may have influenced the construction of the words in England never existed. It may well be that the peculiar reasons<sup>3</sup> for the peculiar construction which the words acquired under the 1883 Act in England were attributable to the peculiar history of earlier patent administration in England and to the caveat system before 1852 and to the wording of the Act of 1852 thereafter up till 1883. It may well be that those peculiar reasons never existed at all in India; since the caveat system never existed and there was no act of which the wording corresponded to the English Act of 1852. It may well be that it might therefore be said that since the wording of the present act of 1911 has it that "any person" may oppose, therefore the words should carry their face value. This may be a matter for discussion in some future case. Until however there is definite authority for the view that the Rule (*i.e.* Rule 21(1) is either *ultra vires* or at least unnecessary and that the system in India is to differ in this important respect from the system in force under the precisely similar wording of the Act and Rule now in force in England, it must be assumed that the two systems are intended to be the same in this matter.

As to the nature of the interest which it is necessary that the opponent shall have.

The interest need not be a manufacturing interest but it must be a real definite and substantial interest. In one case it has been held that a mere agent's interest would not be sufficient to entitle him to oppose the grant. It has also been held that the mere possession and use of a particular article said to be covered by the Patent

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<sup>3</sup> See page 399 above Note (1).

applied for is not sufficient. The material time at which the opponent must show that he has a sufficient interest is the time when the opposition is heard. These principles have been enunciated in the following cases.

(i) See *Rene Clavel's Application*.<sup>4</sup> The Patent applied for related to improvements in dyeing and printing products made from Cellulose acetate. The opponents had set out their interest (under the English Rule 43) in effect as large manufacturers exporting large quantities of acetate silk from France to England and as patentees of numerous British Letters Patents for the manufacture and treatment of acetate silk". The question whether the opponent had sufficient interest had come up before the Comptroller-General as a preliminary point. He had decided the opponent had sufficient interest; and that the opposition should be allowed to proceed. The applicant appealed to the Law Officer. On such appeal the Solicitor-General (Sir Thomas Inskip) made in the course of his decision the following observations:—"There is no dispute that they do manufacture acetate silk, and I should infer from that fact that they are interested in ordinary commercial processes, including dyeing, for making their wares marketable. By the expression interested in" I do not necessarily mean that they own such processes: I merely infer that the treatment including the dyeing of acetate silk is a matter of business concern to them as a commercial firm. Sir Duncan Kerly enunciated certain rules which he asked me to adopt and apply in this case. He admitted that a trading interest as well as a manufacturing interest is enough to confer a locus standi to oppose, but he said that it must be an interest in this country and an existing interest and such an interest as will be interfered with if the Applicant receives a grant. Assuming these to be the right tests of an interest for the present purpose, Sir Duncan Kerly said that the Opponents neither allege an actually existing interest in this country, either as traders or manufacturers, nor do they say that their interest will be interfered with if the Patent is granted.

Three cases were cited on behalf of the Applicant. In a *Ruling of the Comptroller-General*, 1911 (B) reported in 28. R. P. C. Appendix No. 1, page iii, the broad principle is asserted that a bona-

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<sup>4</sup> (1928) 45. R.P.C. 222.

*vide* manufacturing interest is a sufficient interest, subject, however, to certain qualifications. It must be an existing interest and it must be shown to exist in an actual field of manufacture of sufficient similarity to the applicant's to justify an inference of damage to him if the applicant receives a grant. In a later case, *In the matter of an Application by New Things, Ltd.*,<sup>5</sup> Sir Stanley Buckmaster, having held that it was not necessary to have what is called a manufacturing interest said: "A trading interest would also be sufficient, but the interest must be a real definite and substantial interest and must not arise from something that the opponent proposes to do." The qualification contained in the last sentence was introduced in that case with reference to the facts of that case. It seems to me to be only one particular way of stating the converse of the rule expressed in the first half of the passage that I have cited. I accept Sir Stanley Buckmaster's statement as meaning that a person who merely proposes or intends to manufacture or trade in the article in question has not a real definite and substantial interest. The third case cited by Sir Duncan Kerly was *In re Wheeler*<sup>6</sup> in which I applied to the facts of that case the rule as laid down by Sir Stanley Buckmaster, and I added that the question whether there is a real substantial and definite interest must be decided on the facts of each case.

On the facts as they admittedly are, and in view of the inference which I draw from those facts, I have come to the conclusion that the Opponents have a real definite and substantial interest to entitle them to oppose. As I have come to this conclusion on the facts of this case as I view them, it is not necessary for me to consider other hypothetical cases. My conclusion is, I think, consonant with the case reported in 29 R. P. C. as *Ruling* 1912 (B), cited by Sir Arthur Colefax, but I do not accept the proposition submitted by Sir Arthur that every opposition which is not frivolous, vexatious or blackmailing ought to be admitted. I think that is much too wide. I therefore dismiss the appeal".....

(ii) See *Wheeler's Application*<sup>7</sup> in which case the Solicitor-General (Sir Thomas Inskip) held that "a trading interest would be

<sup>5</sup> (1914) 31. R. P. C. 45.

<sup>6</sup> (1925) 42. R. P. C. 509.

<sup>7</sup> (1925) 42. R. P. C. 509.

sufficient, provided the interest is real, definite and substantial." In commenting on Sir Stanley Buckmaster's dictum in *New Things Limited*<sup>8</sup> which was to the effect that "a trading interest would be sufficient, but the interest must be a real definite and substantial interest and must not arise from something the opponent proposes to do", he said :—"If the agreement in question was before me, I could form my opinion as to it, and if it had been an agreement by which the Opponent's firm had the sole right to purchase the whole of the output of these manufacturers in the United States so that they became the owners of the goods, then I should probably have been inclined to think that the Opponent has sufficient interest. I think for this purpose it is unnecessary for me to say whether Sir Stanley Buckmaster's dictum is a complete or accurate statement of what is sufficient interest, but I am bound to say I think it is a very reasonable view to take that a trading interest would be sufficient, provided the interest is real, definite and substantial. The question as to whether there is a real, substantial and definite interest must be decided on the facts of each case. In this case I do not know and I very much doubt whether the Assistant Comptroller knew the precise facts, and I am not prepared to say that the Opponent has shown that he has a real, substantial and definite interest. It may be that the position of the Opponent is merely that of an agent in the ordinary sense of the word, or perhaps a del credere agent, for the purpose of putting these things upon the market in this country, in which case the interest would really be the interest of the principals from whom he gets the goods and not his interest. I am, therefore, not satisfied that he has an interest which entitles him to oppose, and I dismiss the appeal."

(iii) See *New Things Ltd : Application*.<sup>9</sup> In that case the Comptroller-General on the reasoning that any person who is *bona fide* and honestly in possession of an article which may reasonably be held to fall within the scope or claims of the Patent applied for, has a sufficient interest to oppose the grant, and relying on the broad principle which was laid down in the Rulings 1912(B) and 1912(C), had held that the opponent had sufficient interest. The Applicants for patent appealed. On such appeal the Solicitor

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\* (1914) 31. R. P. C. 45.

\* (1914) 31. R. P. C. 45.

General (Sir Stanley C. Buckmaster) allowed the appeal ; holding that the opponent had not sufficient interest. His decision which is of interest, may be cited here in full :

"The question is whether such possession and use of the screen confer on him an interest sufficient to support an Opposition to the grant. I may say at once that having considered all the cases to which my attention has been called, I am not prepared to limit the interest which an Opponent must show in order to bring himself within the class of persons qualified to give Notice of Opposition under Section 11, to what is called a manufacturing interest. I think that is a mistake. A trading interest would also be sufficient, but the interest must be a real definite, and substantial interest, and must not arise from something that the Opponent proposes to do. So far as the present interest of the present Opponent is concerned it is nothing but the possession and use in the manner which I have mentioned of this particular screen. The rest of his interest arises from something that he intends to do in the future, and which he may or may not accomplish, it appears to me that intention gives him no more right to oppose than a man saying that he intended in the future to make a patented article would give him the right to be heard. I have, therefore, to consider whether the use of the screen, as he at present possesses and uses it, is a definite and substantial interest entitling him to oppose. I am unable to find that it is. It appears to me that it is no more than the ordinary possession and use of a particular article said to be covered by the Patent applied for, and I do not think that the mere fact that a man is in possession of such an article gives him the right to appear and oppose under Section 11. For example, if a man were using a golf ball which it was said would infringe a Patent for which an application was made in respect of golf balls, I do not think that would entitle him to come in and oppose, because it is obvious that when once the area of the class within which Opposition is permitted is extended so as to include all people who use—as opposed to those who make or trade in—a particular article, there would be no check on Oppositions which might be of a fictitious and an unreal character. For the present, it is sufficient for me to say that nobody suggests that the Opposition here is of that character, but, on the other hand, it would be impossible for me to permit this Opposition without at the same time, letting in such a class of Opposition as that to which I have



referred. Therefore, I am of opinion that the present Opponent has not got sufficient interest to enable him to oppose the grant of this Patent. I must overrule the decision of the Comptroller and decide that this Opponent has no locus standi. I think this is a new case, and a case which it was quite right should be dealt with before me, and, in the exercise of the discretion which I possess, I make no order as to the costs.”<sup>10</sup>

(iv) See *Comptroller-General's Ruling 1912 (B)*.<sup>11</sup> In that case the opponent was a person who had applied (at a date subsequent to the Applicant's application) for a Patent on similar lines to that of the Applicant. The material part of the decision of the Comptroller General who held that the opponent had sufficient interest was as follows :—

“Having regard to these various considerations, I have come to the conclusion that while some restriction ought to be placed on the right to oppose upon the new ground of opposition, in order to prevent vexatious or blackmailing proceedings being commenced by the mere “man in the street”, it is on the other hand desirable that the right should at any rate be extended so as to include all those who can show *bona fide* and satisfactory reasons for wishing to oppose. The reasons should, in my opinion, show a personal and practical interest in the opponent and give reasonable grounds for apprehending that the grant of patent rights in their present form to an applicant would be immediately or directly prejudicial to the interests of the opponent. The claim by an opponent that his interests are directly affected or prejudiced will, of course, have to be scrutinised in each case. I think it is enough for the present decision to say that it would be sufficient to show that some existing right or interest might be prejudicially affected. If this is the right principle, I think it is clear that the Opponent in this case has a good locus standi to oppose. He is admittedly applying for Patent rights for a somewhat similar invention upon the same lines, and the Applicant's Specification has already been cited against him under Section 8. His right to obtain a Patent is therefore directly and immediately affected ; and he has a clear interest in obtaining if possible, the removal of any doubt or verbal ambiguities from the

<sup>10</sup> See also *Comptroller's Rulings* 31 R. P. C. (A) ; and 30 R. P. C. (B).

<sup>11</sup> (1912) 29. R. P. C. (Appendix) p. (v).

Applicant's Specification. I hold therefore that he has a sufficient interest to raise the ground of opposition under Section 11 (1) (c) in this case."

(v) See : *Comptroller-General's Ruling 1912 (C)*.<sup>12</sup> In that case the opponent was an applicant for Letters Patent in the United Kingdom of which the Application had been filed after the opposition had been entered. Under the International Convention the opponent claimed for his patent if granted a date one day earlier than that of the filing of the second of the two Provisional Specifications of the Applicant. The material portion of the decision is in the following words :—

"With regard to the point that the interest was not present at the time the Opposition was entered, I think it is sufficient for the Opponent to be able to show a *bona fide* and existing interest at the time when the Opposition is heard. In any case, in the present instance the Opponent had applied for and obtained Patent rights abroad, and therefore had valid and existing rights under the Convention to make an Application here at the time when Opposition proceedings were begun."

"It is clear that where the subject-matter of the invention is similar, a subsequent applicant for Patent rights has a definite interest, not only in clearing up any ambiguity in the language of a prior Specification, but also in limiting its scope and Claims, if it is possible to do so, whether by amendment, disclaimer or otherwise. He falls therefore within the general principle, that where *bona fide* and existing rights are imperilled, any person should be allowed a locus standi to oppose. Although therefore a decision is not directly necessary in the present case, as the case of prior patenting was not in fact pressed by the Opponent, I think it right to state my opinion that the Opponent has made out a sufficient interest in this case to raise an opposition on the ground defined by Section 11(1)(b)."<sup>13</sup>

<sup>12</sup> (1912) 29. R. P. C. (Appendix) p. vii.

<sup>13</sup> See also *Comptroller's Ruling (B)* reported in 28 R. P. C. (Appendix) p. iii. For the present purposes it is unnecessary here to discuss further the decisions in earlier cases such as : *Ex parte Tomlinson* (1899) 16 R. P. C. 233 ; *Meyer's Application* (1899) 16 R. P. C. 526 ; *Stewart's Application* (1896) 13 R. P. C. 627 (in which it was held by the Attorney-General (Sir Richard Webster) that an interest in a similar patent which had lapsed was sufficient) : *Morgan's*

**The same degree of interest may qualify an opponent to oppose on all grounds.**

It is submitted that when once the opponent has established that he has sufficient interest to entitle him to oppose the grant of the Patent to the Applicant, the opponent then becomes entitled to oppose on all grounds which are in any circumstances open to an opponent in opposition proceedings. So that it will then be immaterial whether or not the opponent has any direct interest in the matters involved in any particular ground on which he wishes to rely.

**Amendment to change the identity of the opponent not allowed.**

In a case where the opposition proceedings were instituted in the name of one person who was found to have no sufficient interest and an application was made to the Comptroller to amend the Notice of Opposition by substituting another person as opponent, it has been held that such amendment was not permissible.<sup>14</sup>

**Not usually taken as preliminary point.**

While it would seem that if it is desirable in any particular case that the point that the opponent has no sufficient interest to entitle him to be heard may be decided as a preliminary point, yet in practice this course is not usually adopted.<sup>15</sup>

**Grounds under Section 9 now available in India in opposition proceedings.**

The grounds on which the grant of a Patent may at the present day be opposed in India before the Controller are stated in Section 9 of the Indian Patents & Designs Act of 1911 to be any of the following :—

“(a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative or assign ; or

(b) that the invention has been claimed in any specifica-

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*Patent* (1888) 5 R. P. C. 186 ; *Adolf Spiel's Patent* (1888) 5 R. P. C. 281. *Bairstow's Patent* (1888) 5 R. P. C. 286 ; and the cases reported in *Glossop's Patent Cases* at page 285 and at page 288.

<sup>14</sup> See *Heath & Frost's Patent* Griff. P. C. 288 at page 290 cited in Terrell (8th edn.) at p. 189.

<sup>15</sup> See *Rens Clavel's Application* 45 R. P. C. 222 at 223.

tion filed in British India which is or will be of prior date to the patent, the grant of which is opposed ; or

- (c) that the nature of the invention or the manner in which it is to be performed is not sufficiently of fairly described and ascertained in the specification ; or
- (d) that the invention has been publicly used in any part of British India or has been made publicly known in any part of British India ; but on no other ground."

The grounds therefore *directly* within the Section which it is open to an opponent to take in opposition proceedings are simply these :—

(i) Want of novelty : in any category. For the wording of Section 9(d) appears to be wide enough to cover want of novelty both for common knowledge as well as for public knowledge. It appears also to be wide enough to cover want of novelty by public knowledge whether this is shown to be due to documentary publication of any sort and in any form of document, or to oral publication, or to prior user. This being so, no further grounds are added at all, in respect of want of novelty, by Section 9(b). For a consideration of what is required to be shown in order to establish want of novelty under Section 9(d), reference may be made to Chapter VI, Part III where this topic has already been fully discussed.<sup>16</sup>

(ii) Prior grant : The wording of Section 9(b) may be treated as affording a ground of opposition on an objection on the ground of prior grant. For a consideration of the circumstances in which such an objection will lie, reference may be made to Chapter VI, Part III.<sup>17</sup>

(iii) Insufficiency : in any category. For the wording of Section 9(c) is wide enough to cover both insufficiency of description in all requisite respects as to how the invention is to be performed and insufficiency in the delimitation of the ambit of the monopoly. For a consideration of what is required to be shown in order to establish insufficiency under Section 9(c) reference may be made to Chapter VII, Part I where this topic has already been fully discussed.<sup>18</sup>

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<sup>16</sup> See pages 169 & 216.

<sup>17</sup> See page 217.

<sup>18</sup> See page 296.

(iv) "Obtaining": that is to that the Applicant for Patent obtained the invention from the opponent or from a person of whom the opponent is the legal representative or assign: under Section 9(1) (a). For a further consideration of the circumstances in which such an objection will lie, reference may be made to Chapter VII, Part III.<sup>19</sup>

It will be seen hereafter that in spite of the words "but on no other ground" with which Section 9(1) ends, nevertheless certain other grounds, which are important, are actually in practice open at this state: such additional grounds being available by virtue of certain general principles of Patent Law; either altogether independently of the provisions contained in the Section, or because, through the existence of such general principles it has been held to be necessary to read an enlarged meaning into the wording of Clause (c) of Section 9(1).

**Construction of Section 9(1) (c):** An objection of "no manner of new manufacture" is by implication also included.

The ground of objection contained in Section 9(1)(c) of the Indian Act, as it is worded, certainly appears on the face of it merely to refer to an objection of insufficiency of description. It is certainly not worded on the face of it so as to include an objection that "the alleged invention is not a manner of manufacture."

If the question of the construction of this sub-section were at large and free from any previous decision a reasonable view at first sight for the man in the street to take of it would be that it is intended to refer to an objection of insufficiency of description only: such objection to be advanced for reasons which could be urged only on the assumption that there was otherwise a patentable invention. That is to say that it is an objection solely that the invention is insufficiently described, independently of any objection as to the subject-matter of the invention: independently of any question whether or not the alleged invention does or does not comprise a manner of new manufacture. But as soon as the question of insufficiency of description is gone into in any detail it is found that it is very difficult, if not impossible, to come to any decision on the question whether or not the alleged invention is sufficiently described without first deciding the preliminary point whether the

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<sup>19</sup> See pages 263 to 267.

alleged invention is a manner of new manufacture or not. For the description to be sufficient the description must properly describe and delimit the ambit of the invention showing that not more than what is properly claimable as a monopoly is described. But if nothing is properly claimable as a monopoly, as will be the case if the alleged invention is for something which is not a manner of new manufacture, then it becomes difficult to decide whether any ambit is properly delimited. It is on such reasoning, it seems, that the judgment in *Ex parte Muntz* (cited below) and the subsequent cases following that decision rest. Section 9(1) of the Indian Act (quoted above) is substantially indistinguishable from Section 11(1)(c) of the English Act; which is worded as follows:—"that the nature of the invention or the manner in which it is to be performed is not sufficiently and fairly described and ascertained in the complete specification." The point has given rise to much discussion in the English cases: but the construction to be put upon Section 11(1)(c) of the English Statute may now be taken, it seems, as well settled.

This being so, it is submitted that it must be taken as equally well settled in law that Section 9(1)(c) of the Indian Act embraces within its language an objection that the alleged invention was not a manner of new manufacture.

See *I. G. Farbenindustrie Aktiengesellschaft: Application*.<sup>20</sup> The application was for a Patent in respect of "Improvements relating to the manufacture of Artificial Threads Bands, Films or the like." The opposition was argued on the ground that there was "no manner of new manufacture" in the patent applied for. It was contended on behalf of the Applicants for the patent that an objection that there was no manner of new manufacture was distinct from the objection which might be taken under Section 11(1)(c) and was not open to the opponents. The matter came before Luxmoore J. on appeal; the following extracts of his judgment on this point may be noted:—

"The grant was opposed before the Comptroller by the British Enka Artificial Silk Company Limited and by the British Celanese Limited. The British Enka Artificial Silk Company Limited having succeeded in obtaining the deletion of the comma were satisfied with the decision, but the British Celanese Limited appeal from it and

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<sup>20</sup> (1933) 50. R. P. C. 249.

ask that the grant of a patent be refused on two grounds, first because the Specification discloses no new method of manufacture, and secondly because there is no novelty in the invention described in and claimed by the Specification, and in this connection they rely on Letters Patent Nos. 149,296 and 241,948.

The Applicant-Respondents contend that the first ground is not open to the Appellants in these proceedings, because it does not fall within any of the grounds of opposition specified in Section 11(1) of the Consolidated Acts. If the Appellants are entitled to raise and rely on this contention and such contention is well founded the second point is immaterial. The proceedings are opposition proceedings. The grounds available to an opponent are those limited by Section 11, sub-section 1 of the Consolidated Acts. This sub-section provides that any person may on the terms stated give notice of opposition to the grant of a patent on any one or more of six specified grounds which are set out in the sub-section under the headings (a), (b), (bb), (c), (d) and (e) respectively.

The sub-section ends with the words "and on no other ground". It is plain that, so far as an opponent is concerned unless his opposition can be brought within one of the six specified grounds, he has no locus standi under Section 11. It was admitted by Sir Arthur-Colefax, and I think quite properly, that it was not possible to bring this case within any of six specified grounds other than that comprised in sub-heading (c). Sub-heading (c) is in these words :—"that the nature of the invention or the manner in which it is to be performed is not sufficiently and fairly described and ascertained in the complete specification". He argued that there can be no sufficient or fair description or ascertainment of an invention if there is in fact no new method of manufacture, and he relied on the definition of "invention" contained in Section 93 as meaning "any manner of new manufacture the subject of letters patent and grant of privilege within Section 6 of the Statute of Monopolies and including an alleged invention".

"In my judgment this argument is well founded, and I accordingly hold that it is open to an opponent under Section 11(1)(c) to oppose the grant of a patent on the ground that the specification discloses no new method of manufacture. I respectfully accept and rely upon the decision of the Divisional Court in *The King*

v. *The Comptroller General of Patents (ex parte Muntz)*<sup>21</sup> in support of this view. In that case the Comptroller-General had refused an application for a patent on the ground that no patentable invention was claimed by it. The applicant for Patent had obtained a rule nisi for mandamus addressed to the Comptroller General to hear and determine according to law his application for a patent. The ground of the application was that the Comptroller General had exceeded the jurisdiction conferred on him by the Patents and Designs Acts, 1907 to 1919, by refusing to grant the patent on the ground stated above. Lord Chief Justice Hewart in his judgment discharging the rule called attention to the definition of invention in Section 93 referred to above and to Section 6 of the Statute of Monopolies which makes it plain that what is referred to as an invention is "some manner of new manufacture." He also referred to Section 3, sub-section (2) of the Patents & Designs Act, 1907. This sub-section provides for the refusal of an application for a patent if the examiner to whom the application is referred reports that "the nature of the invention is not fairly described or the manner in which it is to be performed is not therein particularly described and ascertained." These words are in substance indistinguishable from the words of Section 11(1)(c). The Lord Chief Justice said "the whole matter starts with an application which contains a declaration to the effect that the applicant is in possession of an invention and the argument of the prosecutor here involves this proposition, that although it may well be the duty of the examiner to report whether the nature of the invention is or is not fairly described, it is not open to him to say that what is put forward as an invention is not an invention at all. In my opinion the question whether the alleged invention is an invention in the sense of being some manner of new manufacture is clearly a question which may be reported upon within Section 3." Mr. Justice Avory expressed his entire agreement with this construction placed by the Lord Chief Justice on Section 3 and added these words:—"It seems to me almost an absurdity to say that, if an Examiner may report that the nature of the invention is not fairly described, he may not report that that which is put before him is not an invention at all. If it is not an invention at all, it is impossible that the nature of the inven-



tion can be fairly described." I can see no ground for saying that any different consideration should apply to the construction to be put upon what are in substance the same words found in Section 11(1)(c). The question therefore arises whether the Specification in fact discloses a new manner of manufacture."

See *James Yate Johnson's Application*.<sup>22</sup> In that case on appeal from a decision of the Comptroller refusing the grant, the Solicitor-General ( Sir James Melville ) upheld his decision. During the hearing of the appeal the question was specifically raised whether it was open in such opposition proceedings for such an objection to be taken as was outside the grounds mentioned in Section 11. The decision of Sir James Melville is of considerable interest : the purport of which will be sufficiently apparent from the following extracts bearing on the point now under consideration :—

"This is an appeal by the Applicant from the Decision of the Assistant-Comptroller whereby he refused the Application for a Patent. The invention relates to the manufacture of rubber products by a process of synthesis starting with acetylene and subjecting it to successive chemical operations which gradually build it up by adding carbon or hydrogen to the original substance, there being actually five steps in the process. The Opposition was on the grounds of prior publication in British Specifications Nos. 17193 of 1913 and 211,125 and of insufficient or unfair description. The application was refused by the Assistant-Comptroller on the ground that there is no patentable invention in selecting a material derived from a particular source as an ingredient in a known process, the material here being acetylene derived from methane and the process being that described in Dreyfus' Specification No. 17193 of 1913. The process described in Dreyfus' Specification is open to use by the public, as no Patent was sealed thereon. Even if a Patent had been sealed, it would now have expired by lapse of time.

It has been known for many years that acetylene can be obtained from methane, one method being described in the cited Specification No. 211,125. The Assistant-Comptroller considered that to grant the Applicant a monopoly forbidding the public,

when using the process prescribed by Dreyfus, to employ acetylene obtained in any known manner from methane or from gases containing methane would be contrary to the provisions of Section 6 of the Statute of Monopolies as being hurtful of trade or generally inconvenient. Mr. Swan, who appeared for the Applicant, did not dispute the Opponents' contention that the five-step process is disclosed in Dreyfus' Specification, nor that it is known to obtain acetylene from methane. But Mr. Swan put forward this dual argument. He says in the first place that the grant of a Patent can only be opposed upon one or more of the six grounds that are specified in Sub-section (1) of Section 11 and that the Assistant-Comptroller has refused the Patent upon a ground that does not appear in Section 11 and the refusal is therefore *ultra vires*. He says, secondly, that this invention is in essence an invention by selection.....

As regards the objection raised by Mr. Swan that it was neither open to the Opponents to object to the grant on the ground that no manner of new manufacture is disclosed nor to the Comptroller to refuse a Patent upon that ground, I think that two observations must be made. First, I would point out that Opposition was entered on two grounds. The first ground was that of anticipation in the two prior Specifications to which I have already referred. The second ground was that "the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described in the Complete Specification." In considering the meaning of the words "that the nature of the invention is not fairly described," as used in Section 3(2) of the Acts, it is to be observed that it has been definitely laid down that those words involve a consideration of the question whether that which is described in the specification is some manner of new manufacture. The point was considered by the Divisional Court in the case of *The King v. Comptroller-General of Patents (Ex-parte Muntz)*<sup>23</sup> (Sir James Melville then proceeded to cite the passage in the judgment of Lord Hewart which has already been referred to at p. 415 above and proceeded). If the words used in Section 3(2) are to be so interpreted, I can see no reason why the same interpretation should not equally be applied to the same words, as used in Sub-section (1)(c)

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<sup>23</sup> (1922) 39. R. P. C. 335.

of Section 11, and, if so, an opponent is not precluded from raising this fundamental objection as to the non-patentability of an alleged invention.

But, quite apart from this question as to the right of an Opponent to raise this issue, there is another aspect of the subject, and it is one that in my opinion would of itself justify the Assistant-Comptroller in resting his Decision on the ground that the Specification discloses no invention within the meaning of the statutory definition. It was held by the Law Officer in the case of *S's Application*<sup>24</sup> that the words "manner of new manufacture" used in the definition of an invention contained in Section 93 of the Acts must be read as a whole. It is not legitimate to ask first: Is this a manufacture and to relegate to the limited enquiry made under Section 7 the further question: "Is it new?" Moreover, there is authority in the case of *Wadham's Application*,<sup>25</sup> and in *Hughes & Kennaugh's Application*,<sup>26</sup> for saying that when the Comptroller is dealing with a Specification in Opposition proceedings, the rights of the public must be considered, and the Comptroller has jurisdiction to act in the interests of the public even though the Opponent may fail as regards his own presentation of the case. In *Hughes & Kennaugh's* case Sir Samuel Evans used these words: "I see no reason why the Comptroller should be restricted to information given to him by an opponent or why he should not be entitled to avail himself for the public benefit of the information of the Patent Office. Whatever has taken place before the acceptance of a Specification under Section 7, I think the whole question of whether the patent ought to be granted and upon what terms, was open upon the hearing of the Opposition—just as it would be open upon the hearing of an appeal by the Law Officer under Sub-section 3 of Section 11."

In view of these authorities, I do not think that it can be contended that it is not within the inherent jurisdiction of the Comptroller or the Law Officer to refuse to grant a patent upon an Application which is clearly in contravention of the provisions of the Acts. To quote the Ruling by the Comptroller-General in *Wain-*

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<sup>24</sup> (1923) 40. R. P. C. 461.

<sup>25</sup> (1910) 27. R. P. C. 172 at page 174, lines 23 to 27.

<sup>26</sup> (1910) 27. R. P. C. 281.

wright's case :<sup>27</sup> "The Comptroller—like any other Judge or Court of Justice—must have the general and inherent powers of preventing a fraud being committed upon the public. In the case of a grant of a patent the Comptroller is administering a special prerogative of the Crown, and I cannot think that he is compelled to allow a grant of patent rights where under the special circumstances of the case the grant would be admittedly bad, or be in effect a fraud upon the public or the Crown." I accept and re-affirm that Ruling.

In the present case the use of acetylene obtained from methane may no doubt be advantageous, but there appears to me to be no invention involved, and I agree with the Assistant-Comptroller that the Application should be refused. In the result I dismiss the Appeal and I award the Opponent twelve guineas costs."

**Whether any other objections similarly may be indirectly included by similar implication in Section 9(1)(c).**

It being then settled law, as already observed that an objection for want of subject matter for "no manner of manufacture" may be included by implication under Section 9(1)(c) a question then arises what other objections, if any, there may be which may also be included within the enlarged meaning of the sub-section by similar implication.

**Whether an objection of "no inventive step" is also included within any enlarged meaning of Section 9(1)(c).**

It being settled law that for the reasons shown, an objection for want of subject matter (that the alleged invention does not constitute any manner of new manufacture) is thus included by implication under the terms of Clause (c) of Section 9(1), a question then arises whether other objections for want of subject matter may similarly be included by similar implication.

Does an objection for want of subject matter that the alleged invention shows no inventive step also stand on the same footing : so as to be equally available to an opponent ?

On the one hand it may be argued that if there is no inventive step, obviously there cannot be any invention : and, if no invention, then obviously it cannot be said that the invention is sufficiently described : the same argument which has prevailed in regard to the

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<sup>27</sup> Ruling 1912 (E), 29 R.P.C. Appendix. xi.

objection for no manner of manufacture. In support of this argument such observations as those in *Wainwright's* case may be relied on—"that there was no invention involved;" and it may be said that such observations show that the Court or the Comptroller in arriving, on the general question, to a conclusion that there was no manner of new manufacture, in fact only arrived at such conclusion by considering also this question whether there was any inventive step; and that in fact it was only because they held there was no inventive step that they were able to arrive at the conclusion that there was no manner of new manufacture. On this argument it may be said that once it has become settled law that the question of subject-matter as to the wide point of "no manner of new manufacture" is an objection which is open to be raised by an opponent in opposition proceedings, it necessarily follows that it is also open to him to raise the specific point "whether there was any inventive step."

(The two objections are certainly logically closely related. If there is no inventive step, it follows there is no manner of new manufacture, in the sense requisite to afford subject matter for a patentable invention. Yet the non-existence of any "manner of new manufacture" may in other cases be found to be due to causes quite unconnected with any existence or non-existence of any inventive step).

On the other hand it may be argued that in order to decide whether there has been an inventive step or not in relation to any invention entails going into a variety of subsidiary questions outside the specification itself, concerning evidence as to the state of the prior art and as to the state of common knowledge and such matters. That this is a different matter to raising a question merely whether the alleged invention from its nature as described on the face of the Specification is subject matter for a Patent in the sense simply of being or not being a manner of manufacture within the meaning of Patent Law. That where matters outside the specification have to be investigated this cannot be treated as an objection for insufficiency in the description in the specification itself. And that it cannot be supposed that an objection of that nature, though unmentioned, is to be intended to be read into Section 9(1) (c) merely by implication.

The point does not appear to have been positively decided ; and is not free from doubt. If the construction of Clause (c) of Section 9(1) was free from all authority, a reasonable view it is submitted would be, that an objection of "no inventive step" is not included in this Clause (c) ; and that it is not open to an opponent in opposition proceedings to agitate this objection, but that in certain circumstances it might well be open to the Controller to take the objection. However in view of the decided cases, on the whole, it is submitted, that this objection that there is "no inventive step in the alleged invention" may also be held to be included by implication under the terms of Clause (c) of Section 9(1). And that it may be permissible for an opponent in opposition proceedings to agitate this ground also before the Comptroller.

**Concerning other objections for want of subject matter : such as illegality : or immorality : or unfitness for the exercise of the Crown's prerogative : concerning objections for want of utility : or objections for fraud.**

A similar question arises, whether any of such objections may be treated as being included by implication in any enlarged meaning of Section 9 (1) (c). Here again the matter is not free from doubt in view of the ratio decidendi of the decision in *Ex parte Muntz*. It is submitted however that none of these objections are properly to be treated as being covered even by implication so as to be within the terms of Section 9 (1) (c).

An opponent is debarred accordingly from agitating such objections as grounds for his opposition proceedings under the Section.

**Whether any other objections may be raised apart from Section 9 (1) (c) : force of the words "but on no other ground."**

It is to be observed that the ratio decidendi of the decision in *Ex parte Muntz* (cited above) was expressly stated to be that an objection for "no manner of manufacture" amounting to "no invention" was open to an opponent because the objection was by implication within a certain enlarged meaning of the wording of Section 9 (1) (c).

A different question also arises : how far if at all other objections, which cannot by implication be either included in, or related

to, the topic of insufficiency as stated in Section 9 (1) (c) may be raised at this stage by virtue of any general or fundamental principles of Patent Law independently of anything stated in Section 9 (1).

The crux of this matter is : what degree of force is to be given to the words "but on no other ground" with which Section 9 (1) ends.

This aspect of the matter was to some extent considered by the Court in the case of *In the matter of the Petition of International Bitumen Emulsions Ltd. for the revocation of Dehn's Patent*.<sup>28</sup>

This was a case where there had been a Petition for revocation to the Controller : the Controller had refused to revoke the Patent and the report is of the appeal against the Controller's order before the court. The Petition for revocation was of the nature of a belated opposition : being a Petition under Section 26 of the English Patents Act. Thus such petition of revocation could under Section 26 only be made by the petitioner on the same grounds as he might have opposed the grant under Section 11. Thus the decision may be treated for the present purpose as if it was a decision in proceedings in Opposition to Grant. In that case the opposition of the opponent as stated in his Petition was based on (a) prior publication (b) invention not sufficiently or fairly described and (c) ambiguity and uncertainty of claims :<sup>29</sup>

One of the points taken in argument by Sir Arthur Colefax in support of the Patent was to the effect that the opponent had "wrongly tried to import into this case a point which arises out of the Statute of Monopolies, namely, that there is no manner of new manufacture ; the Court cannot consider such a matter as this upon an appeal of this nature." This point is dealt with, though shortly yet definitely and clearly, by Luxmoore J. in his judgment which finally leads up to the passage on page 379 line 18, an extract of which is as follows :—

"The grounds of the appeal are stated to be that the Assistant Controller was wrong in holding (1) that the alleged invention had not previously been published, (2) that the invention was sufficiently and fairly des-

<sup>28</sup> (1932) 49. R. P. C. 368.

<sup>29</sup> See p. 375.

cribed in the Complete Specification. (3) that the claims were not bad for uncertainty and ambiguity. If ground (3) is intended to refer to some ground other than the ground referred to in (2) such ground is not in my opinion, open to the Applicant for, as I said before, the only grounds open are those set out in Section 11 of the Consolidated Acts, and of those grounds the two specified by the Appellant in the application are those comprised under sub-sections (b) and (c) of the Section, sub-head (b) covers ground (1) and sub-head (c) covers ground (2)."

The point was more directly raised in regard to the construction of the words "but on no other ground", in the case of *H. A. Metx Laboratories Inc. Application* :<sup>30</sup> In that case the Comptroller had refused the grant because he held that the application fell within the mischief of Section 38A of the English Acts, 1907-1932. On appeal the following material words occur in the judgment of Luxmoore J. :—

"The second point is : Assuming that it is open to the Comptroller to consider the particular point at any time before the grant is in fact made, can an opponent in opposition proceedings be heard with regard to it ?

"So far as the second question is concerned, the rights of an opponent in opposition proceedings are certainly limited : they are laid down by Section 11 of the Consolidated Acts in quite clear and explicit terms : there are certain heads to which I need not refer in detail ; they are five in number and are set out in sub-section (1) of Section 11. At the end of the sub-section are the words "but on no other ground". That, as I read it, is a statutory prohibition against an opponent taking any ground other than those which are set out in the sub-section.

Now what is said in this case ? The Opponents in their Notice of Opposition rely on Section 11 (1), (b) and (c). (b) relates to prior publication ; (c) is in the following words : "That the nature of the invention.....is not sufficiently and fairly described and ascertained in the complete specification." These words have been given a generous interpretation. The question in the present case is :

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<sup>30</sup> (1933) 50. R. P. C. 355.



Do they include an infraction of the prohibition which is set out in Section 38A which deals with cases where an application is made for Letters Patent for an invention for which, apart from that Section, Letters Patent would be granted. The Section says: if the invention is of the particular nature there described, then the specification shall not include claims for a substance, unless when it is prepared or produced by methods or processes of manufacture particularly described and ascertained. I can find nothing in Section 11 which says that it is to be open to an opponent to object to a specification on the ground that it does not comply with Section 38A. It is argued that I must construe Section 11(1)(c) so as to include this ground, because Section 38A deals inferentially with the nature of the invention. I do not think that this is a proper construction of the Act. Section 38A prohibits the inclusion of certain claims in the specification. In the absence of Section 38A, there would in fact be no ground of objection to these claims. In my judgment an objection to a grant because the specification infringes the requirements of Section 38A is quite a different matter from an opposition under Section 11; it is entirely outside the scope of that Section and I do not think it is open to an opponent to rely on non-compliance with Section 38A. The only ground for refusal of the grant in the present case was non-compliance with Section 38A. I think it was quite right for the Comptroller to take that ground provided the case falls within the Section, but that is a different thing from saying that the Opponent is entitled to put it forward. In those circumstances I hold the Opponent has no right to complain of the grant."

It is submitted therefore that in opposition proceedings it is not open to an opponent to raise any objections of any category which cannot be said to fall under any of the four clauses of Section 9(1).

**The Controller is unaffected by the words "but on no other ground".**

On the other hand it is clearly open, on the decisions last cited, it is submitted, for the Controller to raise certain objections which go to the root of the validity of the Patent on fundamental principles even though such an objection may be outside the limits of Section 9 (1).

As instances of such objections it is submitted that it would be open to the Controller, at the stage of opposition proceedings, to refuse to grant a Patent on his own initiative for an objection on the ground of want of subject matter for illegality : or for want of subject matter for immorality : or for want of subject matter for unfitness for exercise of the Crown's prerogative. It is submitted that it will be in the same way open to the Controller also in a proper case to refuse a grant at this stage on his own initiative on the ground of fraud where such fraud is a deceit on the Crown.

**Summary of objections which may be raised in British India in opposition proceedings.**

It may be convenient for purposes of reference now to state here *seriatim*, as a result of the foregoing discussion, all objections which are open to be raised at this stage : that is to say in opposition proceedings.

These are :—

Such as may be raised by the opposer :—

- (i) Want of novelty in any category and including prior user : under Section 9 (1)(d) : see also Section 9 (1)(b) : and see page 411.
- (ii) Prior grant : under Section 9 (b) : and see page 411.
- (iii) Insufficiency in any category : under Section 9 (1)(c) : and see page 411.
- (iv) Obtaining : under Section 9 (1)(a) ; and see page 412.
- (v) Subject matter as to “no manner of manufacture” : by implication under an enlarged meaning of Section 9 (1)(c) : see page 412.
- (vi) Subject matter as to “no inventive step : by similar implication : (though this is doubtful) see page 419.

Such as may be raised only by the Controller in a proper case but not by the opposer :—

- (vii) Subject matter as to illegality : see page 424.
- (viii) Subject matter as to immorality : see page 424.
- (ix) Subject matter as to unfitness for the exercise of the Crown's prerogative : see page 424.
- (x) Fraud amounting to a deceit of the Crown : see page 424.

### **Comment as to difference in grounds available in India and in the United Kingdom.**

It has been seen that in India a ground of prior user is available while in England it is not. It may reasonably be submitted that if it is the aim of the two systems of Patent Law to be worked on a similar scheme, it would be more convenient for the two systems to be made to conform. Under the present system in India in practice it may entail a great volume of comparatively infructuous work for the Controller to be compelled to adjudicate on such complicated technical questions of fact as he may at any time be called upon to do, so long as it is left open to an opponent to oppose a grant on a ground of prior public user. In England it has been held that even where an opponent bases his opposition on want of novelty by reason of prior documentary anticipation, the proper procedure in opposition proceedings is for the Controller to refuse to entertain any protracted discussion on the question of such anticipation ; and that he should rather in case of any doubt make the grant. The reason for this is clear : since if he refuses to make the grant his decision is final against the applicant, who, except for appeal, has no remedy. Whereas if he makes the grant, his decision is in no sense final against the opponent, who can always at later stage apply for revocation of the Patent. This principle has not always been applied in cases of opposition proceedings based on documentary anticipation before the Controller in India. In cases based on prior public user it would probably be more difficult even than in cases based on documentary anticipation to avoid a lengthy investigation of technical facts : for this reason that from the nature of things, it almost invariably follows that an opposition based on prior public user will entail protracted questions of fact of technical complexity. It is submitted that for the purpose of the practical efficient working of the system, it would be more advantageous if the ground of prior user now open to an opponent in opposition proceedings were cut out of the Indian Act. This would also have the advantage of bringing the Indian Act substantially into conformity with the English Statute.

### **Procedure to be followed in making opposition to grant.**

The procedure now referred to is all subsequent to the acceptance of the application for Patent by the Controller and the adver-

tisement of the fact of such acceptance. The steps of procedure which are laid down by Section 9 of the Act of 1911 and by the 1933 Rules made thereunder are then as follows :—

(i) Notice of opposition to the grant of the Patent is given by the opponent at the Patent Office at any time within four months from the date of the advertisement of the acceptance of the application (Section 9 (1) : See also Rule 20).

(ii) The opponent is required within 14 days of giving such notice of opposition to leave at the Patent Office his full written statement. (See Rule 21 (1)).

(iii) The Controller gives notice to the applicant for Patent of the opposition having been lodged. (Section 9 (2) and Rule 21 (2)). Furnishing him with a copy thereof. He will also specify a time within which the Applicant is to file his reply, if he wishes to do so. (See Rule 21 (2)).

(iv) The Applicant for Patent within the time specified by the Controller, may, if he so desires, file at the Patent Office a reply (Rule 21(2)). The time for this will ordinarily be one month (Rule 21 (5)).

(v) The Controller gives notice to the opponent of the reply ; and the Controller will specify a time within which the opponent is to file his rejoinder, if he wishes to do so. (See Rule 21 (3)).

(vi) The opponent within the time specified by the Controller may if he so desires, file at the Patent Office a rejoinder (Rule 21 (3)). The time for this will ordinarily be one month (See Rule 21 (5)).

(vii) The Controller then on the expiration of the four months allowed for notice of opposition, and after appointing a time for the hearing, proceeds to hear the applicant and the opponent if desirous of being heard, and to decide on the case (Section 9 (2) and Rule 22).

The procedure outlined above is considered in detail under the next following headings.

#### **The prescribed fee.**

This is Rs. 5.

#### **Form of Notice of opposition.**

This is form No. 6 : see Appendix No. 5 below.

By Rule 20 or the 1933 Indian Rules it is provided as follows :

“Notice of opposition to the grant, as to the amendment, etc. of a patent shall be given in duplicate. One copy of the notice shall be sent by the Controller to the applicant or his agent.”

**Signing : verification : agency.**

As to the form of the Notice of Opposition and its signature and its verification see Sec. 75 of the Act of 1911 and Rules 7 & 8 of the 1933 Rules. On the wording of the Rules as they now stand read with Section 75 it is necessary for the notice of opposition to be signed by the opponent himself and to be verified ; and that such verification also is to be by the opponent himself with a statement that the facts and matters stated therein are true to the best of his knowledge, information and belief. The full statement of opposition need not be signed by the opponent himself but can be signed by his agent and need not be verified by anyone. When the brevity and nature of the notice of opposition are considered it seems somewhat anomalous that this should be the position : and when it is considered that a common practice is to state as grounds of opposition in the notice of opposition merely a word for word statement of certain of the grounds mentioned in Section 9 of the Act, any statement by an opponent that such grounds simpliciter are true to his knowledge must be to some extent meaningless. However this verification is required of him and it must be supposed therefore to mean that he vouches for the truth of the grounds only in so far as they entail statements of fact without specifying how far they do so, or what statements of what facts they do entail.

**Full statement of opposition.**

Rule 21(1), it is observed, is mandatory and in every case of opposition a full statement from the opponent is required. (The practice in England is that such statement is filed at the same time as the notice of opposition : under the English rules framed under the English 1932 Act. In India this full statement may be put in after the bare notice provided it is within 14 days thereof.) Such full statement is to be filed in duplicate ; and in it the opponent is required to set out fully the nature of his interest, the facts upon which he bases his case and the relief which he seeks. The question what grounds can be and what grounds cannot be taken in opposition has been fully discussed earlier in this chapter and in previous chapters.

**Signing : agency : no verification necessary.**

Since the full statement of opposition is not one of the documents falling within Section 75 but is covered on the contrary by Section 76 of the Act of 1911, it follows that it need not be signed by the opponent himself but may be signed by his Agent and filed by his Agent. Also for the same reason it need not be verified by anyone. (See Section 76 of the Act 1911 and Rule 9 of the 1911 Rules.) All that is required is for the opponent previously to have given his signed authorisation to such Agent to act on his behalf. Such authorisation is to be on Form No. 31.<sup>31</sup> This form will require a stamp as a Power of Attorney either of Rs. 2 or of Rs. 10 : the lesser stamp being enough if the authority is given for a single transaction but the larger stamp being required where the authority is given for more than one transaction or generally in respect of several Patent applications. See the Indian Stamp Act (Act 11 of 1899) Art 48 as amended by the Bengal Stamp Amendment Act (Bengal Act III of 1922) and later by the Indian Stamp (Bengal Amendment) Act of 1935 (Bengal Act XII of 1935 Sec. 7(20)), which came into force on 1st June 1935.

**The Reply.**

Rule 21(2), it is observed, is not mandatory. Thus there is no necessity for the applicant to file any reply if he considers this to be unnecessary. If he wishes to do so however it is required to be in duplicate and to deal in full with the statement of the opponent. Thus it is advisable that it should contain both argument as well as facts.

The time allowed for filing such reply will ordinarily be one month from receipt by the applicant of the copy of the full statement of opposition. In special cases however the Controller will fix such time as appears to him to be reasonable. In a case in which it will be necessary to obtain instructions from abroad it is advisable for the applicant as soon as he receives the copy of the full statement of opposition to write a letter to the Controller asking for three months or whatever period is considered necessary in which to file the reply. Similarly if reference is made in the Full Statement to Books or Documents, copies of which are not readily available to the applicant in India sufficient time will be wanted by him in which

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<sup>31</sup> See Appendix No. 5 below.

to obtain the necessary copies first and then obtain instructions concerning them after that. The reply may be filed and signed by the Agent (in Calcutta) for the applicant. The applicant is in the same position in this respect as the opponent is in regard to the full statement of opposition. See rule 21(2) and see remarks above under "Signing, agency, no verification necessary".

### **The Rejoinder.**

Rule 21(3) similarly is not mandatory.

If the opponent wishes to file a rejoinder this also is required in duplicate. It is required to be confined only to matters in the reply. It may be filed by the Agent (in Calcutta) and does not require the opponent's signature or any verification : see remarks above.

### **Hearing date.**

By Rule 22(1) it is provided as follows :—

"On completion of these proceedings or at such other time as he may see fit, the Controller shall appoint a time for the hearing of the case, and shall give the parties not less than ten days' notice of such hearing."

Applications for a special date to be fixed are ordinarily made by letter addressed by the agent of the party to the Controller who then notifies the agents of the parties of the date fixed by letter.

### **Evidence.**

In England the practice is for all evidence which is to be relied on by the parties at a hearing of proceedings in opposition to grant to be given in the form of either written statements or statutory declarations. Reference may be made to Rules 42 to 50 and 116 and 117 of the 1932 English Rules ; in particular Rules Nos. 45, 46 & 47 and 116 & 117.

There are no rules relating to this in India. The present practice is ordinarily for such evidence, as is required to be given at the opposition proceedings before the Controller, to be given orally by witnesses before him. A shorthand note is taken by a shorthand writer supplied by the Patent Office. On request to the Controller copies of the depositions of the witnesses can be obtained on payment of the necessary charges.

By Section 65 of the Act of 1911 it is provided as follows :—

“Subject to any rules in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a Civil Court for the purpose of receiving evidence and administering oaths and enforcing the attendance of witnesses and compelling the production of documents and awarding costs.”

The Controller thus has power to issue sub-poenas for the attendance of witnesses. It has been decided also by a decision of the Calcutta High Court in *Dorman Long & Co. v. Jagadish Chandra Mahindra*<sup>32</sup> that he is under a duty to issue such a sub-poena at the request of a party in opposition proceedings ; and that his position is the same as that of any Judge under the provisions of Order 16, Rule 1 of the Code of Civil Procedure.

On the point whether or not the Controller has power to order the issue of a commission to examine witnesses there has been a ruling of H. E. the Governor-General, on his opinion on the point being asked by the Controller in connection with another case, that the Controller has no power to order the issue of a commission.

If expert evidence from outside India is therefore required by a party on the hearing of opposition proceedings it is necessary for the directions of the Controller to be obtained giving leave to the parties to put in such evidence in the form of affidavits.

It may be noted that in addition to such other powers as the Controller has in connection with the receiving of evidence, he has a general power whereby he can require an applicant or agent to submit a statement or make an explanation if required. This is under Rule 65 of the Indian 1933 Rules the material portion of which reads as follows :—

“Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a time to be notified by the Controller, or to attend before him and make explanations with respect to such matters as the Controller may require.”

This corresponds to Rule No. 114 of the English 1932 Rules.

(1934) 39. C.W.N. 573 at 579.



**Belated oppositions.**

Under Section 26(1) & (2) of the present English Patents & Designs Acts 1907-1932 it is provided as follows :—

- “(1) Any person who would have been entitled to oppose the grant of a patent or is the successor-in-interest of a person who was so entitled may within twelve months from the date of sealing the patent apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of a patent might have been opposed :

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

- (2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction or explanation or dismissing the application ; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent”.

And by Section 26(4) it is provided as follows :—

- “(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court.”

Such proceedings are commonly referred to in England as “belated oppositions”, since as provided by Section 26(1) the grounds on which such petition for revocation may be made are precisely only those on which the grant might have been opposed if opposition had been effected before the Patent had been accepted ; that is to say the grounds under Section 11 of the English Act. A recent example of a belated opposition may be seen in the case entitled *In the Matter of the Petition of International Bitumen Emulsions Ltd. for the revocation of Dehn's Patent* reported in (1932)

49. R.P.C. 468, where the proceedings are referred to (at page 377) under this description by Luxmoore J. in his judgment.

Statutory provision to the effect now embodied in the current Section 26 of the English Act appears to have been first made in England in the Act of (1907).

Even under the Act of 1907 in practice these proceedings only differed from proceedings in opposition to grant in that an appeal lay to the court instead of to the Law Officer. Now that under the 1932 Act appeal is to the Appeal Tribunal (that is a judge of the High Court to be nominated by the Lord Chancellor) even from proceedings in opposition to grant, there is not even this difference for practical purposes.

There is no similar provision in the Indian Act for a belated opposition of this nature before the Controller. Therefore in India once a Patent has been accepted, objections to the validity of the Patent can only be raised through a Petition for revocation under Section 26 of the Indian Act made to a High Court.

### **Appeal.**

In India an Appeal lies from the decision of the Controller in proceedings in opposition to grant only to the Governor-General in Council : as is provided by Section 9(3).

### **Comment as to appeals.**

In England until recently an appeal from the decision of the Comptroller in opposition proceedings was to the Law Officer (under the Act of 1907). The English Act of 1932, by Section 12 thereof which added a new Section 92A to the principal act, set up an Appeal Tribunal for Patent matters consisting of a Judge of the High Court to be nominated by the Lord Chancellor ; and by the Act of 1932 section 11 of the principal act was amended so that appeals from the Comptroller in opposition proceedings were to lie to that Appeal Tribunal.

The present arrangement in India under which an appeal from a decision of the Controller is required to be disposed of by H. E. the Governor-General in Council is not at all satisfactory : particularly in view of the fact that though the matter at stake may be in value far greater than the value of a civil suit in which an Appeal may lie to the Privy Council yet these appeals are to be disposed of

by an unjudicial body in an unjudicial manner ; for it appears to be the practice that any appeal which is filed to H. E. the Governor-General in Council is, after being circulated round the appropriate departments of Government, finally decided only on paper without even the parties to the appeal or their advocates being heard on the Appeal.

It may be anticipated that some more satisfactory provision for the disposal of Appeals will be required to be made in India as the volume of Patent work before the Controller and correspondingly the volume of appeals from him increases.

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## **CHAPTER XI**

### **OBJECTIONS AFTER GRANT OF THE PATENT—REVOCA- TION—COMPULSORY LICENSES—NO BELATED OPPOSI- TIONS BEFORE THE CONTROLLER—APPLICATIONS FOR REVOCATION BEFORE THE COURT —APPLICATIONS FOR REVOCATION OR COMPULSORY LICENSES BEFORE H. E. THE GOVERNOR-GENERAL IN COUNCIL FOR ABUSE OF MONOPOLY.**

## **PART I**

### **VARIOUS PROCEEDINGS FOR REVOCATION**

**Various proceedings possible : but no “belated oppositions” under the Indian Act of 1911.**

In the United Kingdom by virtue of Section 26 of the English Patents & Designs Acts 1907-1932 it is open for “any person who would have been entitled to oppose the grant of a patent” or who is “the successor in interest of a person who was so entitled” to apply to the Comptroller (not to the court) for revocation provided he makes such application within twelve months from the date of the sealing of the patent.

This matter has already been referred to in Chapter X. It is only necessary here again to note that there is no provision in India under the Indian Patents & Designs Act corresponding to this English Section 26. And accordingly the position in India is that all applications for revocation on grounds of invalidity are required to be made to the court under Section 26 of the Indian Patents & Designs Act 1911 ; applications for revocation on the ground of non-working or non-supply or on the ground of non-manufacture in British India which are made under Sections 22 and 23 are made to H. E. the Governor-General in Council ; applications for

revocation by way of surrender only, under Section 24, are made to the Controller.

It is proposed now to consider in turn the various proceedings which may be taken by way of an application for revocation : it will be necessary also here to consider the proceedings in which the Petitioner may ask, instead or alternatively, for the grant of a compulsory license.

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## PART II

### PETITION TO THE HIGH COURT FOR REVOCATION UNDER SECTION 26.

#### Who may apply for revocation to the High Court

By Section 26(2) it is provided as follows :—

“26(2) A petition for revocation of a patent may be presented—

(a) by the Advocate-General or any person authorized by him ; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ; or

(ii) that he, or any person under or through whom he claims was the true and first inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within British India, before the date of the patent, anything claimed by the patentee as his invention.”

The wording of this part of Section 26 is word for word the same as that of the English Section 25(4) of the English Patents & Designs Acts 1907-1932. The principles which have been arrived

at, therefore, in the English cases may be considered as applicable in regard to the construction of this part of the Indian section.

It will be noted that the grounds mentioned in this Section 26(2) as sufficient to give a person the right to make an application for revocation of a patent are different from the grounds mentioned in the earlier part of the section as the grounds of objection upon which revocation may be obtained when such interest or right to make the application is established.

**Status to present the Petition when the authority of the Advocate-General has been obtained.**

It is clear from the wording of the section, if the Advocate-General's authority has been obtained, the Petitioner may rely on any of the grounds stated in Section 26(1) for the purpose of obtaining the revocation of the patent in question.

**Origin and object of the provision relating to the obtaining of the authority of the Advocate-General.**

Formerly revocation of an invalid Patent was obtained by *scire facias*. If a subject sought to avail himself of the procedure by *scire facias*, he had first to obtain the fiat of the Attorney-General as in the case of an information with a relator.<sup>1</sup>

Certain official regulations were issued for the purpose of governing the relations between the relator and the Attorney-General in a proceeding by way of such an information which are set out in an Appendix<sup>2</sup> to Robertson's Proceedings by and against the Crown at p. 835 and were worded as follows :—

“Regulations as to proceedings in the Chancery Division of the High Court of Justice in the name of Her Majesty's Attorney-General at the instance of relators.

Note—These regulations will apply equally to such proceedings in the King's Bench Division.

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<sup>1</sup> As to *scire facias* see *Robertson's Proceedings by and against the Crown* (1908 edn.) Chapter X at p. 537. As to procedure in general on an information with a relator see *ibid* at page 486 ; see also *Annual Practice* 1936 p. 2 ; also *Chitty's King's Bench Forms* (16th edn : 1931) p. 832 ; see also *R. v. Eastern Archipelago Co.* (1853) 1. E. & B. 310, and *Eastern Archipelago Co. v. R.* (1853) 2 E. & B. 856, and, *R. v. Eastern Archipelago Co.* (1854) 4. D. M. & G. 199. As to former procedure for revocation of a Patent for fraud see *A. G. v. Vernon, Brown & Boheme* (1685) 1. Vern 277 and 370, and *Robertson (ibid)* at p. 471.

<sup>2</sup> See also *Daniell's Chancery Forms* (6th edn. 1914).

In the case of any application to Her Majesty's Attorney-General for his authority to commence in his name at the instance of a relator an action in the High Court of Justice, Chancery Division, the following regulations will be required to be observed, and, so far as they are prospective, the authority of the Attorney-General to use his name for the purpose of the proposed proceeding will be given on condition that the same shall be observed.

It is required that the statement of claim and all amendments thereof shall be signed by the Attorney-General.

The copy of the writ left with the Attorney-General for his signature shall be accompanied by the proposed statement of claim which the Attorney-General, if he shall allow the action, will also sign and return to the relator's solicitor to be delivered or filed as provided by the Judicature Acts, 1873 and 1875.

There shall also be left with the Attorney-General a second copy of the writ with a copy of the statement of claim appended thereto, on which there shall be written a certificate of counsel to the following effect : "I certify that this writ and statement of claim are proper for the allowance of Her Majesty's Attorney-General, Dated &c." This copy will be retained by the Attorney-General.

The papers shall be accompanied by a certificate of the solicitor presenting the same for allowance that the proposed relator is a proper person to be relator, and that he is competent to answer the costs of the proposed action.

If any amendment of the statement of claim shall at any time become necessary, the proposed amended statement of claim and a copy thereof showing the proposed amendment shall be left with the Attorney-General. On such copy shall be written a certificate of counsel that the proposed amendment is proper for the allowance of the Attorney-General. If the Attorney-General shall approve the amendment, the amended statement of claim will be signed by him and returned to the relator's solicitor to be delivered or filed as may be required. The copy so certified will be retained by the Attorney-General."

Since the English Patents, Designs & Trade Marks Act of 1883 (Section 26(1) ) the remedy by *scire facias* to obtain revocation of a Patent was abolished in the United Kingdom : and a procedure by

way of Petition under that Statute was created in its place. Under the Statute however equivalent rights to those which had previously been available by *scire facias* were retained ; and in connection with the exercise of those rights a procedure similar to that which had been previously operative was also continued.

The scheme of the Indian Patents & Designs Act in regard to the process made available under the Act for revocation of a Patent is in its origin and nature similar to the scheme inaugurated in the United Kingdom by the Act of 1883 and now operative in the United Kingdom under the current English Patents and Designs Act 1907-1932.

Under the scheme of the present Indian Act of 1911 it is open to a person if he has a peculiar private interest in the Patent in question, so as to be able to bring himself within the terms of any one of the clauses of sub-section (b) of Sec. 26(2), to present a Petition for revocation of a Patent without obtaining any fiat, authority or leave from the Advocate-General. This remedy was not originally available to such an individual at Common Law : and has been created directly under the Act and only by the Act.

Under the scheme of the present Indian Act of 1911, also, there is a concurrent remedy open, under sub-section (a) of Sec. 26(1) to any person to present a Petition for revocation of a Patent who obtains the authority of the Advocate-General. In this respect the Act is merely declaratory, in that it is merely continuing the right which any member of the public always had at Common Law to present a Petition for the revocation of a Patent on obtaining the fiat of the Law Officer of the Crown under the former procedure of *scire facias*.

It is thus due no doubt to the historical development of the procedure under *scire facias* that the present procedure exists under the present Act, whereby a person may in certain cases present a Petition for revocation of a Patent, if he obtains the fiat of the Advocate-General (under Sec. 26(2)(a)) but not otherwise.

While it is thus true that whereas originally, when the remedy of *scire facias* was available, no person was entitled to institute proceedings for the revocation of a Patent without first obtaining



the fiat of the Attorney-General (or in India the Advocate-General), and that since the present statutory remedy by Petition under the Act has been substituted it has been made open to a person if he has a peculiar degree of private interest in the Patent in question, to institute the proceedings in his own right even without obtaining any fiat, authority or leave from the Advocate-General; yet at the same time it is also noticeable, what is equally important, that the old right of any person to institute the proceedings even when he has no peculiar private interest in the Patent, provided he first obtains the authority of the Advocate-General, has been retained under the present Indian Act as before. In the latter class of cases it is submitted that the Petitioner must be taken to stand as a representative of the public when instituting his Petition for Revocation just as a person in the position of a relator was under the old procedure.

It is for these considerations that the obtaining of the authority of the Advocate-General is not to be regarded, it is submitted, as any mere formality: but as the whole basis of the right of such a Petitioner to present the Petition.

It is of interest to note how closely the present procedure relating to the institution of a Petition for the revocation of a Patent, when this is done with the leave of the Advocate-General, approximates to the older procedure when the proceedings were instituted on an information by a relator with the fiat of the Law Officer of the Crown. One of the few points of difference is that whereas under the former procedure the Petition was instituted in the name of the Law Officer of the Crown on the relation of the person moving for revocation, under the present procedure under the present Patents and Designs Act the Petition is instituted in the name of the Petitioner himself, and the name of the Law Officer of the Crown only appears on the Petition by way of an endorsement with his signature, showing that it has been filed with his authority.

Otherwise in essentials the same practice is adopted for the purpose of obtaining the authority of the Law Officer of the Crown and the same principles are applicable as to the exercise of his discretion in granting such authority as under the older procedure.

### Procedure on the application to the Advocate-General for his authority.

The practice now followed in British India is in all respects the same as that followed, in the United Kingdom. The person, who desires to file the Petition for Revocation in Court and for this purpose desires first to obtain the fiat of the Advocate-General, makes his application to the Advocate-General in writing in the form of a memorial. Copies of the Specification of the Patent sought to be revoked, and of the Petition sought to be filed in Court and of the Particulars of Objections forming the grounds of the Petition, also of any documents or other specifications relied on in the Petition or in the Particulars of Objections are forwarded as Annexures with the Memorial.<sup>3</sup>

With this memorial the applicant to the Advocate-General also forwards :—

(i) a declaration by the Applicant (a) verifying the statements in the memorial : and (b) declaring that the questions proposed to be raised in the Petition for Revocation and in the Particulars of Objections upon which the revocation of the Patent is sought are not and cannot be raised in any legal proceedings pending in British India at the date of the Application for the fiat.

(ii) also a certificate signed by Counsel to the effect that in his opinion the Petition for Revocation is "proper for the allowance of the Advocate-General" :

(iii) also a certificate by a Solicitor that the applicant is a proper person (or corporate body) to be the Petitioner, and that the applicant is competent to answer the costs of the proposed Petition for Revocation.<sup>4</sup>

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<sup>3</sup> Cf. *Edmunds* (1890) p. 361 ; *Frost* (4th edn. 1912) Vol. I, p. 293 ; *Fletcher Moulton* (1913) p. 211 ; *Terrell* (8th edn. 1934) p. 349.

<sup>4</sup> For cases relating to the exercise of his discretion by the Law Officer (who in India will be the Advocate-General) reference may be made to *Edmunds* (1890 edn.) page 362 ; *Frost* (4th edn. 1912) p. 294. Cf. *London C. C. v. A. U.* 1902 A. C. 165.

For a form of Petition for Revocation see *Frost* (4th edn. 1912) Vol. II, p. 480-482 : *Terrell* (8th edn.) p. 611.

For a form of Memorial to the Advocate-General praying for his authority to present the Petition see *Frost* (4th edn. 1912) Vol. II, p. 482. *Terrell* (8th edn.) p. 612.

[Continued on next page]

The practice appears to be based on the general practice which is resorted to in cases where an individual as relator seeks to institute an action on behalf of the Crown or of those who enjoy the Crown's prerogative.

### **Procedure relating to notice of the application made to the Advocate-General.**

The practice in the United Kingdom appears to be that notice is given to the Patentee (by the Secretary to the Law Officers' Department) of the fact of the application for the fiat having been made to the Attorney-General.<sup>5</sup> On application to the Attorney-General by the Patentee a copy is also sent of the draft Particulars of Objections which are intended to be relied on by the other party as the foundation for the Petition for Revocation. One result of this procedure is that the Patentee then has the benefit of having notice of the alleged objections which the other party intends to raise against the validity of his Patent at an early stage and even before any Petition is actually filed. He therefore has thus an opportunity, if he so desires, of taking steps for amending his Specification in proceedings for amendment before the Comptroller before any Petition for revocation is filed in Court. See *In the Matter of the Patent of the Western Electric Co. Ltd.* In that case it was held that not only was there no objection to the Patentee making such an application if he so desired before the Comptroller for the amend-

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For the form of authority which is endorsed on the Petition by the Advocate-General see *Frost* (4th edn.) 1912, Vol. II, p. 482.

For a form of certificate by Counsel see *Robertson* p. 543. *Daniels Chancery Forms* (6th edn. 1914) p. 29; *Chitty's King's Bench Forms* (16th edn. 1931) p. 832.

For a form of certificate by the Solicitor see *Terrell* (8th edn.) p. 613. Compare *Robertson* p. 543; *Chitty's King's Bench Forms* p. 833.

For a form of the Statutory Declaration required from the Applicant see *Terrell* (8th edn.) p. 613 also 349.

Generally see the commentary on Order 1, Rule 2 of the (English) Rules of the Supreme Court (Annual Practice 1936); also *Robertson's Civil Proceedings by and against the Crown* p. 486 & 543; also *Daniels Chancery Forms* (6th edn.) p. 29; also *Chitty's King's Bench Forms* p. 832. For further comments on what should be stated in the memorial see *Terrell* (8th edn.) p. 349.

<sup>5</sup> See *In the Matter of the Patent of the Western Electric Co. Ltd.* (1933) 50 R. P. C. 59.

ment of his Specification so as to cure, if he could, its defects, but that it was desirable for the Court to adjourn the hearing of the Petition for Revocation if necessary when it came on for hearing, so as to allow time for the application for amendment of the specification to be first disposed of.

It would appear that an Advocate-General of a High Court in India will adopt a similar course of procedure to that which has become customary with the Attorney-General in the United Kingdom and will accordingly give notice to a Patentee when an application for his authority is made by any person preliminary to the presenting of a Petition for revocation. On receipt of such notice a Patentee in British India prior to the filing in Court by the opposite party of the Petition for revocation, will then, it is submitted, be entitled to make an application for amendment of his specification if he so desires, before the Controller of Patents. For there will at that time be no "proceeding before a Court for the revocation of a Patent" which is "pending" such as to attract the provisions of Section 17 (9) of the Indian Act.

Provided the Patentee undertakes to proceed with due diligence to obtain the disposal of the application for amendment, it may be that a Court in India may direct the Petition for revocation to stand over pending the decision by the Controller of the application for amendment: as was done in the case of the *Western Electric Co. Ltd. Patent* (cited above).

### **Effect of obtaining the authority of the Advocate-General.**

A person who has obtained the fiat of the Advocate-General will be considered to be making a Petition for revocation as one of the public and not as an individual. See *Shoe Machinery Co. Ltd. v. Cutlan*.<sup>6</sup> It was pointed out in that case that it had been on this reasoning that in the case of *Deeley's Patent*<sup>7</sup> it had been held that a certain judgment which had been previously given in a matter in which the same person had been a litigant as an individual, was no estoppel against him as a Petitioner with a fiat in a petition for revocation.

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<sup>6</sup> (1895) 12 R.P.C. 530 (C. A.) at p. 533.

<sup>7</sup> (1895) 12 R. P. C. 192 at p. 199 : see also *Jameson's Patent* (1902) 19 R.P.C. 246 at p. 248 and at p. 252.

**The authority of the Advocate-General is not obtained as of course.**

The Petitioner does not obtain the authority of the Advocate-General as of right; for the Advocate-General has a discretion to grant or refuse it. And as it was put in one case referring to the similar position of the Attorney-General in the United Kingdom, "he has a most important duty to perform." In that case the Master of the Rolls in considering the granting of the fiat a writ of *scire facias* for revocation of a Patent observed as follows :—

"It has been said that the writ issues as of course, the fiat of the Attorney-General for issuing it being granted as of course I think this ought not to be the case; and I should hope there is some error or exaggeration in the notion upon that subject which seems to prevail, as it appears to me that the Attorney-General, when applied to for his fiat (without which the writ cannot issue), has an important duty to perform."<sup>8</sup>

In the same case it was also held that there was no reason why the Law Officer should not grant his fiat to an alien. Also that it was beneficial in certain circumstances that the Law Officer should take security for costs from the Applicant as a condition for granting his fiat.

Moreover though the Law Officer of the Crown will doubtless not be disposed, by a refusal of his fiat, to shut out a Petitioner from moving a Petition for revocation of a Patent in ordinary circumstances, yet it would appear from the reported English cases, that it has been his settled practice not to grant the fiat where the points in issue regarding the invalidity of the Patent could be decided in other litigation with reasonable convenience.

That it is a condition precedent, to an applicant's right to apply for the fiat, that it is not possible for the issues raised by him as to the invalidity of the Patent to be decided in other litigation then pending would seem to follow from the terms of the declaration which he has to file with his application for the fiat.

**But the authority of the Advocate-General is not ordinarily refused.**

In the absence of reasons to the contrary, where the Peti-

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<sup>8</sup> See the *Queen v. Prosser* (1849) 18. L. J. Ch. 35; compare also *Fletcher Moulton* p. 211; *Edmunds* p. 361; *Frost* (4th edn.) p. 293.

tioner makes out a *prima facie* case, the authority will ordinarily not be refused.

In the case of *Shoe Machinery Co. Ltd. v. Cullan* it was observed by Smith L. J. that "where there was anything like a *prima facie* case made out entitling the person to bring the action that he wanted to bring, and it was necessary to obtain the fiat of the Attorney-General, there was no Attorney-General, of late years at any rate, who has existed or who would exist hereafter, who would refuse his fiat".....And it was in that case also observed that this principle was so well recognised, that in another case where the point had come up, it was said that a man might in certain circumstances be held to have a right at law to bring an action, although he was in a position of having to get the fiat of the Attorney-General before he could do so.<sup>9</sup>

**Reasons why it may be advisable to obtain the authority of the Advocate-General in every case.**

The question has arisen in England in cases where no such authority has been obtained whether a person who has acquired a right to make the application by reason of his interest only on one of the grounds mentioned in Section 26(2)(b), will thereafter be entitled, in asking for the Patent to be revoked, to pursue all other grounds which are mentioned among the grounds on which a patent can be revoked.

There appears to be some authority for the proposition that when once a Petitioner has a locus standi to present the Petition he can impeach the Patent on any lawful ground he chooses.<sup>10</sup> Nevertheless this is not free from doubt.

In order, therefore, that the Petitioner may be certain of being free to pursue all grounds for revocation stated in Section 26(1), it may be advisable for him to obtain the authority of the Advocate-General under Section 26(2)(a), even in a case where he might have sufficient interest to file a Petition without such authority under Section 26(2)(b).

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<sup>9</sup> See *ibid* at p. 533.

<sup>10</sup> See *Edmunds* p. 366 ; *Frost* (4th edn. 1912) at page 292 and *Morgan's Patent* (1887) 5 P.O.R. 186 or (1888) 5. R.P.C. 186. See also *Muller's Patent* (1907) 24. R.P.C. 465 ; and *Traction Corporation Ltd. v. Bennett* (1908) 25. R.P.C. 819 at p. 822.

It will therefore be prudent for a Prospective petitioner for revocation in every case to obtain the authority of the Advocate-General. This becomes especially advisable if it is desired to rely for revocation on a ground or grounds on which the Petitioner cannot rely for the purpose of giving him his status to present the Petition.

To avoid all difficulty it is advisable that the authority of the Advocate-General should be obtained before the Petition for revocation is filed.

**Whether the authority of the Advocate-General can be obtained *nunc pro tunc*.**

As to what is the position in law if a Petition is filed and partly heard before the authority of the Advocate-General is obtained, and then it is desired to obtain the authority *nunc pro tunc*, appears to be a matter of some doubt. From certain of the earlier cases it would appear that a course had on several English occasions been adopted of allowing the case to stand over in order to allow the party claiming revocation of the Patent to obtain the fiat of the Attorney-General in the interval.<sup>11</sup>

In certain cases in order to save any objections that the Petition (or counterclaim) for revocation had been presented prior to the date when the fiat had been obtained and was therefore bad, the case appears to have been treated as being allowed to proceed on a basis that the Attorney-General's fiat though granted in fact at a date after the filing of the Petition was to have effect as having been filed at a date earlier than the filing of the Petition, that is to say as if when granted it had been antedated ; or as it has been put in the judgments, as if it had been granted "*nunc pro tunc*."<sup>12</sup>

But in the subsequent case *British Thomson Houston Coy. Ltd. v. British Insulated & Helsby Cables Ltd.*<sup>13</sup> the Court of Appeal in the United Kingdom have pronounced judgments from which it

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<sup>11</sup> See *Dege's Patent* (1895) 12. R. P. C. 448 ; *Jameson's Patent* (1902) 19. R. P. C. 246.

<sup>12</sup> See *Dege's Patent* (1895) 12. R.P.C. 448 ; *Jameson's Patent* (1902) 19 R.P.C. 246 ; Cf. *Frost's Patent Law and Practice* (4th edn. 1912) Vol. I at p. 294 ; *Terrell* (8th edn.) p. 348.

<sup>13</sup> (1924) 41. R.P.C. 345.

would appear that if the point came before the Courts again it would be held that the Attorney-General's fiat could not be ante-dated in the manner previously suggested in view of the previous cases.

The following observations contained in the judgment of Atkin L. J. in *British Thomson Houston Coy. Ltd*<sup>14</sup>. v. *British Insulated & Helsby Cables Ltd.* are of considerable interest on this point : he said :—

“It is plain that when this Counterclaim was delivered the Defendants were not authorised by the Attorney-General, and they did not obtain that authorisation until after an application had been made to the Court. Later on, in pursuance of an Order made by the Judge, an application was made to the Attorney-General for his authorisation, which he granted at a particular date. With great respect, I think it extremely unlikely that the Attorney-General himself, if he were asked to give such authorisation, would be the least likely to date his authorisation at any other date than that on which he in fact granted it. In fact, I myself have very considerable doubt as to the powers of the Attorney-General, whether he has any power to grant an authorisation and date it at some different date from that at which he does in fact grant it. To date an authorisation *nunc pro tunc* is something very different from the power given to the Court now authorised by the rules, of dating an Order *nunc pro tunc* in pursuance of a decision which must have been made at some earlier time. In any case I am quite satisfied that, if the Attorney-General has not in fact himself dated his authorisation *nunc pro tunc*, the Court has not power of its own motion to direct that authorisation shall be taken as having been granted at some other date than it was granted.

To my mind, the cases which have proceeded upon that authorisation, granted after the Counterclaim has been in fact delivered, have probably been misunderstood. I think that what has, in fact, been done is this, that the Counterclaim has been treated as being delivered *tunc pro nunc*, which is quite a different proposition, and

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<sup>14</sup> Ibid at p. 415.



that the true view of the matter is that, inasmuch as one may deliver a Counterclaim up to the time, and during the time, of the action, if the Court so approves, it may allow the defendant to obtain the fiat and then deliver his Counterclaim. I very much doubt whether it is necessary to state in a Counterclaim that authorisation has been obtained. In other proceedings that one is familiar with, criminal proceedings, and so on, it is not usual, in the actual document, the indictment or elsewhere, to record that the proceeding is by leave of the Attorney-General or the Director of Prosecutions, as the case may be. However, that is another matter; and it may very well happen that, by order of the Court or by consent of the authorities, the parties may agree that the Counterclaim shall not in fact be re-delivered, but shall be taken to be re-delivered if the parties are in a position to re-deliver. I think that is what took place in this case; therefore it appears that the Defendants must be taken to have specially delivered the Counterclaim at a time when they were authorised by the fiat of the Attorney-General. Therefore, the Counterclaim is in order, and it will follow that the Patent having been declared in the action to be void, the Order for revocation can properly be made."

In that case the Petition was entertained and revocation granted solely in view of the special directions which had been previously given by the Court of first instance, the force of which was taken to be that the Petition was to be treated as being re-delivered after the fiat had been obtained. If it had not been for such special directions of the Court, the judgments of the Court of Appeal appear to indicate clearly that the Petition would have been dismissed for the reason that the fiat had not been obtained previously to the date of the filing of the Petition; and for the reason that the Appeal Court was clearly of the view that it was not within the power of the Attorney-General to ante-date his fiat in any way so as to make it effective from any date earlier than that on which it had been given.<sup>15</sup>

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<sup>15</sup> See *Dege's Patent* (1895) 12. R. P. C. 448; *Jameson's Patent* (1902) 19. R. P. C. 246; *Max Muller's Patent* (1907) 24. R. P. C. 465; *British Thomson Houston Coy. Ltd. v. British Insulated and Helsby Cables Ltd.* (1924) 41. R. P. C. 345; *Cincinnati Grinders (Inc) v. B. S. A. Tools Ltd.* (1931) 48. R. P. C. 33; *Western Electric Coy. Ltd.'s Patent* (1933) 50. R. P. C. 59.

**Status to present the Petition when the authority of the Advocate-General has not been obtained.**

It is clear, as already indicated, that a person will have the necessary status to present the Petition in his own right even without obtaining any authority of the Advocate-General, if he can bring himself within the terms of sub-section (b) of Sec. 26(2).

**"Any person alleging".**

A question arises whether in order to establish his status in his own right to present a Petition under Sec. 26(2)(b) the Petitioner must prove the facts which give him the status or whether mere allegation in his Petition is enough of itself to give him the requisite status.

In regard to the proper construction of this phrase where it occurs in the corresponding wording of the English Act, it has been suggested that a mere unfounded allegation will not be sufficient to give a Petitioner the requisite status to move a Petition for Revocation.<sup>16</sup> But on the wording of the Section it would seem doubtful, in a case where the requisite allegations are contained in the Petition, whether anything more can be insisted upon by way of a condition precedent to the Petitioner's having a right to be heard by the Court. In any event where there is no reason to suppose that the Petitioner's allegations contained in the Petition are not *bonafide*, it would seem that on the wording of the Section (Section 26(2)(b) of the Indian Act) the making of the allegations in the Petition, without more, will be sufficient to give the Petitioner the right to be heard.<sup>17</sup>

**Grounds for status under sub-section (i).**

**"Obtained in fraud of his rights or of the rights of any person under or through whom he claims."**

As to the nature of the facts which the Petitioner, for the purpose of acquiring the requisite status to present the Petition, will have to establish, in order to show that the Patent was obtained in fraud of his rights, reference may be made to Chapter VII, p. 258 where this matter has already been discussed.

**"Any person under or through whom he claims."**

As to the phrase "any person under or through whom he claims",

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<sup>16</sup> See *Terrell* (8th edn.) p. 346.

<sup>17</sup> See *Frost* (4th edn.) p. 292 note (r).

it would seem that this phrase is used to enable the person, in whose name the Petition is brought, to rely on fraud perpetrated against a predecessor in title. Since the fraud is limited to a class of fraud perpetrated at the time the Patent was obtained and in connection with the act of obtaining it, it would seem to follow that the person intended to be referred to in the section as having been defrauded can only be the true and first inventor : for there will be no other person who would be in a position to be affected by the fraud indicated. Therefore it would also seem to follow that a Petitioner, for the purpose of acquiring a status to move a Petition, can only rely on this ground in circumstances where he is a successor in interest or in title, in respect of some right or other, of the real true and first inventor. This may be so in a case where he is a successor or transferee in respect of the right to make application for the Patent. It is difficult to envisage any other right of which the Petitioner can be a successor or transferee from the true and first inventor so as to say that he is claiming "under or through" him unless the sub-section is meant to cover all such persons as those who are merely successors in business of the person who was the true and first inventor. In any case it may be a question of mixed law and fact depending on the individual facts of the case whether, even if fraud can be shown, the Petitioner can be said to be a person claiming "under" or "through" the person who was the real true and first inventor.

In sub-section (iii) of Section 26(2)(b), as is not the case in sub-sections (i) and (ii), the nature of what it is that the Petitioner is to be in the position of claiming—"under" or "through" the other person referred to in the sections—is specifically mentioned : that is to say "an interest in any trade business or manufacture."

#### **Grounds for status under sub-section (ii).**

As to the nature of the facts which the Petitioner, for the purpose of acquiring the requisite status to present the Petition, will have to establish in order to show that he was the true and first inventor, reference may be made to Chapter VII, p. 248 where this matter has already been discussed.

#### **Grounds for status under sub-section (iii).**

The facts involved in this sub-section amount in effect to

showing prior user by the Petitioner : as to which reference may be made to Chapter VI, p. 174.

**Grounds on which revocation may be claimed on Petition to Court.**

The grounds which, if any one or more of them be established, will entitle the Petitioner to have an order revoking the Patent are set out in Sec. 26(1) and are as follows :—

“26. (1) Revocation of a patent in whole or in part may be obtained on petition to a High Court on all or any of the following grounds, namely :—

- (a) that any invention included in the statement of claim is of no utility ;
- (b) that any invention included in the statement of claim was not, at the date of the application for a patent, a new invention within the meaning of this Act ;
- (c) that the applicant was not the true and first inventor thereof or the assign or legal representative of such inventor thereof ;
- (d) that the original or any amended application or specification does not fulfil the requirements of this Act ;
- (e) that the applicant has knowingly or fraudulently included in the application for a patent or in the original or any amended specification, as his invention, something which was not new or whereof he was neither the inventor nor the assign nor the legal representative of such inventor ;
- (f) that the original or any subsequent application relating to the invention, or the original or any amended specification, contains a wilful or fraudulent mis-statement ;
- (g) that the whole or a part of the invention or the manner in which the whole or a part is to be made and used as described in the original or any amended specification, is not thereby sufficiently described, and that this insufficiency was fraudulent or is injurious to the public.”

Since these grounds refer to matters which will result in the invalidity of a Patent and such matters have already been fully

discussed, reference may be made, for the facts which it will be necessary for a Petitioner to prove in order to establish the various grounds mentioned in the Section, generally to Chapters VI and VII. Since these grounds mentioned in Sec. 26(1) are also the same grounds on which a defendant in an infringement suit may rely by way of defence to such suit, and since the meaning of the sub-clauses of this section is further discussed in detail in connection with the question of defence to an infringement suit, reference may also be made to the subsequent Chapter relating to an infringement suit.

### **Practice and procedure regarding the Petition to the Court for Revocation.**

In most respects the practice and procedure which is to be adopted in regard to the hearing in Court of a Petition for Revocation under Section 26 of the Indian Patents and Designs Acts will be the same as the practice and procedure adopted in a suit for the infringement of a Patent. For all such matters reference may therefore be made to a later Chapter<sup>18</sup> dealing with the practice and procedure in an infringement suit. It is proposed to mention here only certain points which arise in practice and are peculiar to the hearing or disposal of a Petition for the Revocation of a Patent.

### **Security for costs.**

Both the English Statute and the Indian Act are designed, with the safeguards indicated, to make it essential that only persons who have a certain degree of interest may move Petitions for revocation. The Indian Section 26(3) contains also an additional safeguard in the form of a provision of security for costs : for the purpose of protecting patentees from the trouble and expense of litigation in defending petitions with which they might otherwise be burdened in cases which were not *bona fide*.

### **The Petition.**

It will be advisable to state in the Petition itself that the authority of the Advocate-General has been obtained (if this is the case) and to mention the date on which it was obtained : that is to say a date prior to the date of the filing of the Petition. Though it is doubtful whether it is necessary that the Petition should contain any express statement as to the authority having been obtained : see

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<sup>18</sup> Chapter XVII.

the observations of Atkin L. J. in *British Thomson-Houston Co. Ltd. v. British Insulated & Helsby Cables Ltd.*, already cited at page 446 above. On the other hand in cases where the authority has not originally been obtained but an adjournment has been given to enable the Petitioner to have time and obtain the authority and the authority has then been obtained, it has been usual for directions to be given that the Petition be amended so as to include an amendment that the authority has been obtained. See *Cincinnati Grinders (Inc.) v. B. S. A. Tools Ltd.*<sup>19</sup> and *In the matter of Jameson's Patent*.<sup>20</sup>

### Service of notice of the Petition.

This is regulated by Section 27 of the Indian Act : the provisions of which are as follows :—

“27. (1) Notice of any petition for revocation of a patent under Section 26 shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein, and it shall not be necessary to serve the notice on any other persons.”

### Right to begin.

At the hearing of a Petition for Revocation of a Patent the Respondent (*i.e.* the Patentee) will have the right to begin.<sup>21</sup>

The Respondent will then, it seems, be entitled to call merely formal evidence for the purpose of discharging the onus of establishing in the first place that his Patent is valid and subsisting. Thereafter the Petitioner will call his evidence whereby he will seek to show the invalidity of the Patent and establish his case. After which the Respondent will be entitled to call his evidence in rebuttal whereby he will seek to refute the case for invalidity made by the petitioner.<sup>22</sup>

### The nature of the reliefs obtainable on a Petition for revocation.

The only relief obtainable on a Petition for revocation will be an order for the revocation of the Patent in question : and an order for the taxed costs of the hearing.

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<sup>19</sup> (1931) 48. R. P. C. 33 at p. 43, (Clauson J.).

<sup>20</sup> (1902) 19. R. P. C. 246 at p. 251.

<sup>21</sup> See (English) Rules of the Supreme Court Order 53A Rule 10. The same procedure is followed in British India.

<sup>22</sup> See *Terrell* (8th edn) p. 351 ; *Fletcher Moulton* p. 215.

The Court will have power to include in its order as to costs an order regarding payment of any costs which may have been incurred in connection with the obtaining of the authority of the Advocate-General.<sup>23</sup>

**Not open in British India to a Defendant in an infringement suit to counterclaim for revocation.**

In the case of *British Thomson-Houston Coy. Ltd. v. British Insulated Helsby Cables Ltd.* it was clearly pointed out by Atkin L. J. that in the United Kingdom the right which a Defendant had in an infringement suit to counter-claim for revocation was purely statutory and was a right which was created solely by Section 32 of the English Patents and Designs Act. This Section 32 is to the following effect :—

“32. A defendant in an action for infringement of a patent, may without presenting a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent”.

The observations of Atkin L. J. were as follows :—

“It appears to me that the power to counterclaim for revocation is purely statutory, and depends upon Section 32. A defendant, if entitled to present a petition to the Court for the revocation of a patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent ; and the person entitled to present the petition for revocation is, in this case, a person authorised by the Attorney-General. It seems to me that a person may not, therefore, deliver a counterclaim for revocation, unless he was, at the time he delivered his counterclaim, authorised by the Attorney-General to present the petition”.

There is no section in the Indian Act of 1911 corresponding in its terms to Section 32 of the English Act.

It is clear therefore, that it is not open to a Defendant in an infringement suit in British India to claim, in the suit, revocation of the Plaintiff's Patent.

If the Defendant pleads by way of defence that the Plaintiff's Patent is invalid and if the Court upholds the Defendant's objec-

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<sup>23</sup> See (1924) 41. R. P. C. 345 at p. 415.

tions, the Court may, in the infringement suit, declare the Patent invalid. It will thereafter be open to the Defendant if he desires to obtain the revocation of the Patent to file a Petition for revocation. In such Petition, as a ground in support of the Petition it appears to be open to the Petitioner to plead that the Patent has on a previous date already been declared invalid, mentioning the infringement suit.<sup>24</sup>

### **Appeal.**

In England appeals from petitions for revocation lie to the Court of Appeal and House of Lords as in ordinary civil actions.<sup>25</sup>

In India it is submitted, appeals will on similar principles be governed by the Code of Civil Procedure in precisely the same manner as appeals from other civil litigation in the High Court on its original side.

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## **PART III**

### **PETITION TO H. E. THE GOVERNOR-GENERAL IN COUNCIL FOR REVOCATION OR FOR COMPULSORY LICENSE UNDER SECTIONS 22 & 23.**

#### **Construction of the Act as affecting practice and procedure thereunder.**

A detailed comparison has already been drawn between the provisions relating to non-supply and non-working and non-manufacture under the current Indian Act and the English Act of 1907.<sup>26</sup> For the reasons there discussed it is submitted that the decisions in English cases relating to questions of practice and procedure arising on a construction of the English Act of 1907 are equally applicable regarding similar questions arising under the Indian Act of 1911.

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<sup>24</sup> See, for example, the draft form of memorial for revocation set out in Terrell (8th edn.) at page 612 which appears to be framed to meet such a situation.

<sup>25</sup> See *Terrell* (8th edn.) p. 354.

<sup>26</sup> See Chapter VIII above.



**As to who may apply for revocation to the Governor-General in Council.**

The words used in Section 22 are "any person interested": in Section 23 the words are "any person". In view of this difference in wording it is clear, it is submitted, that it is open to any person, even a common informer, to make an application under Section 23. It is not necessary for the Petitioner to show any degree of personal interest in the patent attacked before being entitled to be heard.

There has been in the English cases direct judicial authority that this in the correct construction of the words: since this very point was discussed at length by Mr. Justice Parker (as he then was) in the case of the Application for the revocation of Hatschek's Patents: and the possible evil effects of the section were criticised and certain suggestions were made as to how the Comptroller in England might prevent these evils.<sup>27</sup>

It was expressly held in considering the same wording of the English Section 27 of the English Act of 1907 that any person whether having any real interest in the development of British Industries or not, whether a foreigner or a British subject and whatever be his motive even if he was a mere common informer, might apply: and even that there was nothing to prevent him making repeated applications from time to time as he pleased.<sup>28</sup>

In fact it was to give reasonable protection to patentees that the learned Judge proceeded to show how under the Rules, it might be in certain cases open and advisable for the Comptroller to insist on the Applicant's making out a *prima facie* case before calling on the Patentee even to file any reply. How far it is necessary for the Applicant to prove his case independently and how far he may rely on compelling the Patentee to disclose the desired facts will be hereafter further considered: in doing so certain passages of the judgment of Mr. Justice Parker may be cited which will also be found to treat of the point already referred to (that anyone may make the application).

As to applications under Section 22 it is submitted that a similar degree of interest will be required to be shown by the

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<sup>27</sup> See (1909) 26. R.P.C. 228 at p. 245 and 246.

<sup>28</sup> See 26. R.P.C. at p. 239 and 246.

Applicant as is required by an Opponent in proceedings in opposition to the grant of a patent.

In such cases it is submitted it will be in the discretion of H. E. the Governor-General in Council in every case to direct whether the question, whether the applicant has or has not the requisite degree of interest, be heard as a preliminary point or not. For the protection of the patentee it is suggested that it might be in the public interest for the matter to be decided in most cases as a preliminary point in these proceedings: even though in Opposition Proceedings (before the Controller) the tendency is for an issue as to interest not to be decided as a preliminary point.<sup>29</sup>

### Comments

At the present day it would appear entirely unnecessary to have Sections 22 and 23 as separate sections. It seems also both pointless and inexpedient that this difference as to who may make an application should continue to exist in regard to the two sections. In England the effect of the two sections was combined as long ago as 1919. And in England it has been made necessary for any person who desires to make an application for revocation or compulsory licenses to show that he has some personal interest in the matter:<sup>30</sup> The Indian Act should be amended on the same lines.

**Grounds on which revocation (or compulsory license) may be claimed on Petition to H. E. the Governor-General in Council.**

Regarding the nature of the grounds which a Petitioner when putting forward a case of abuse of monopoly for reasons of non-supply or non-manufacture must establish in order to succeed under Section 22 or Section 23 on an application for revocation or for the grant of a compulsory licence, reference may be made to Chapter VIII (above) where this matter has already been considered in detail.

### Procedure : Rules.

It appears that no Rules of any sort have been made under the Indian Patents & Designs Act concerning the procedure to be

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<sup>29</sup> See Chap. X above.

<sup>30</sup> See Section 27 of the current English Act in Appendix No. 3 below, which is the same for this purpose as Section 27 of the English Act of 1919 as originally passed.

adopted for the adjudication of Petitions under Section 22 or Section 23 by H. E. the Governor-General in Council.

**How far the applicant may rely on discovery from the Patentee in order to establish his grounds.**

Since the issues raised on a Petition for revocation under Section 22 or Section 23 may involve going into facts and figures relating to the whole output of the Respondent's business, it is evident that a Respondent may be very gravely prejudiced if he is compelled to show to the Petitioner all his books and accounts with all the figures showing his stocks, sales and methods of business together with the names of all his customers in a case where in truth it is found in the end that the Petitioner has no proper right to claim Revocation at all. It is evident that these proceedings are open to be abused by an unscrupulous trade rival, solely for the purpose of obtaining inside information of his rival's business, which would not otherwise be available to him, or for the purpose of pure harassment. It is because of the seriousness to the Respondent of the disclosure that he may have to make in order to defend such a Petition, if it becomes necessary for him to defend it, that questions of onus and questions of discovery in these Petitions assume an unusually large degree of importance.

The whole question of where the onus lay in these applications and as to how in practice an applicant was to prove his case came under discussion in an English reported case. The observations of the Comptroller-General in regard to the application made under Section 27 of the English Act of 1907 are so much in point that it will be convenient to set out an extract of his material observations here :—

“This is a hearing of two Applications under Section 27 of the Patents & Designs Act, 1907, and arises under the following circumstances. The Applicant has in each case filed the ordinary Form 24, under Patents Rule 78, asking for revocation of Patents No. 7188 of 1902 and 13,556 of 1902, on the ground that the patented articles are manufactured exclusively or mainly outside the United Kingdom. The Patentees have been called on under Patents Rule 79 to leave their declaration in answer. They reply (1) that on a proper construction of the Act read with the Rules, they ought not to be called on to leave evidence until the Applicant has made out a *prima facie*

case, or given evidence in support of his allegations ; (2) in the alternative that I have discretion to order such evidence to be left with the Application, and that my discretion ought to be used in this case. These are the points that I have to decide.

Mr. Gray and Mr. Hume appeared for the Patentees, and Mr. Russell Clarke for the Applicant. It was admitted on both sides that the question of the Rules being *ultra vires* could not be argued before me having regard to Section 86, sub-sections (2) and (3) of the Patents & Designs Act 1907, and the case of the *Chartered Institute of Patent Agents v. Lockwood*, reported in 11 R. P. C. page 374.

Mr. Gray and Mr. Hume therefore confined themselves to the following arguments :—(1) Reading the Rules as part of the Statute it is necessary, they said, to see if they conflict or are inconsistent with its other provisions, following the principle stated by Lord Herschell at page 384 of Lockwood's case, *viz* :—"No doubt there might be some conflict between a Rule and a provision of the Act. Well there is a conflict sometimes between two Sections to be found in the same Act. You have to try and reconcile them as best you may. If you cannot, you have to determine which is the leading provision, and which the subordinate provision, and which must give way to the other." The Rules, it was argued, do conflict with Section, inasmuch as by Sections 27(1) and (2) the onus is clearly thrown on the Applicant to show that the patented article is manufactured exclusively or mainly outside the United Kingdom, and the Rules strictly read make no provision for the discharge of this onus. That the onus is thrown on the Applicant is, it was said, implied in sub-section (1) and is clear from sub-section (2). The Comptroller has to "consider" the Application, and he cannot do so unless there is something more than the mere form to consider. The consideration of the Application, according to this view, precedes the inquiry mentioned later, and there must be a preliminary hearing, if necessary, at which the Applicant must make out his case under sub-section (1) and so lay the foundation for the Comptroller's jurisdiction, before the other questions as to adequate working or the existence of satisfactory reasons, are discussed. I have most carefully considered this point, with the assistance of Mr. Russell Clarke's argument for the Applicant ; and I am of opinion that the Rules and the Section are not inconsistent or conflicting. It seems to me clear from a consi-

deration of the other provisions of the Act, and the circumstances under which Section 27 was introduced, that the Legislature deliberately intended to relieve the Applicant from making out a *prima facie* case or throwing upon him the necessity of proving—without help from the Patentee—that the patented article is manufactured exclusively or mainly outside the United Kingdom. If the Legislature desired to put this burden upon the Applicant it had only to insert the words which are used in Sections 24(2) and (3). There the Section (followed by the Rules) provides that a *prima facie* case must be made out by the Applicant, and that it must be “proved” to the satisfaction of the Court that the reasonable requirements of the public with reference to the patented invention have not been satisfied. The rules shew that this must be done by declaration or affidavit, and the Board of Trade make a preliminary investigation to decide whether a *prima facie* case has been made out by the Applicant (see Patent Rules 68 to 74). No such provisions are contained in Section 27. A further argument is afforded by sub-section (5) of Section 3 of the Patents Act, 1902. This sub-section which affords an alternative ground upon which an Applicant may ask for a compulsory licence or revocation reads as follows :—“If it is proved to the satisfaction of the Judicial Committee that the Patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the Patentee can show that the reasonable requirements of the public have been satisfied, the Petitioner shall be entitled either to an Order for a compulsory licence or, subject to the above proviso, to an Order for revocation of the Patent.” It seems clear from the wording of this sub-section that the burden of proof would fall upon the Applicant. The sub-section has not been retained among the amended provisions of Section 24 of the Act of 1907 ; but it appears in a very different shape in Section 26 sub-section (1). If Parliament had desired to leave the onus on the Applicant the words “if it is proved &c.” could have been retained in Section 27. It may be noted also that in Section 27 itself the word “proved” is used where the onus is clearly thrown on the Patentee, but there is no such expression in connection with anything that the Applicant is called upon to do.

Section 3 of the Act of 1902 was largely inoperative, owing it has been stated to the heavy costs entailed by the proceedings and the

fact that the burden of proof was on the Applicant, and it may well be that it was the deliberate intention of the Legislature to relieve the Applicant of the burden of proof and make the Patentee disclose at the earliest opportunity what he is really doing in this country with the patent rights he has obtained, so as to assist the Court in coming to a proper decision. I see no hardship or injustice in this, on the assumption that the Legislature treats adequate working in this country, when the main or exclusive working is abroad, as a public duty attaching to the monopoly granted here; and that to secure the performance of this duty "any person" may give information. The fact that Parliament deliberately substituted "any person" for "any person interested" in this Section would seem to support this contention.

I am of opinion therefore that upon a proper construction of this Section the Applicant is not compelled to make out a *prima facie* case before the Patentee is called upon to leave evidence or make a disclosure of what he relies upon in answer to the application.

What then is the result from these conclusions? It does not appear to me to follow of necessity that the full onus is therefore cast upon the Patentee. I think it would be a reasonable construction of the Section that at the "consideration" and "inquiry" mentioned both Applicant and Patentee must do their best to assist the Comptroller with evidence upon which he may come to a proper decision. The proceedings before the Comptroller have always proceeded on wide and not unduly formal lines, and I think it most important that this should be continued. If Section 27 has been enacted to protect public interests it is reasonable that both parties should do their best to assist and help in the inquiry and the Comptroller has wide powers under Rule 81 to call on any other person who can assist him to give evidence. The Rules therefore in my opinion might without inconsistency have provided that the Applicant should give the best particulars he can of the allegations he makes, even though there was no onus upon him to prove his case. It is true they have not done that, and they are *prima facie* therefore, open to the objection raised here that they place a Patentee at the mercy of any one who dishonestly uses the process under Section 27.

In my opinion, however, the answers to this objection, are (1)

that the Patentee, as I hope to show later, can be protected against *mala fide* applications ; (2) that in the majority of cases the giving of particulars by the Applicant except to show *bona fides* would be useless, if the Patentee must also give full disclosure. The facts as to working in this country are obviously within the knowledge of the Patentee, and often within his knowledge alone. The Applicant cannot prove a negative, and would in most cases find it absolutely impossible to give any useful particulars without discovery from the Patentee. The Rules therefore call on the Patentee, at once, to disclose his case without waiting for any particulars from the Applicant ; and if the Patentee can be protected against dishonest and bogus applications, there is no unfairness in his being called upon to do so ; if the reasoning above is sound.

It follows therefore that in my view the "consideration" and the "inquiry" are part of the same process, and that the consideration of the application takes place at the inquiry. There is only one "inquiry" mentioned and this can neither be appropriated to a preliminary consideration of the Applicant's case, nor confined to the trial of the defences which the Patentee may raise. All the issues it would seem have to be considered together, and this is not only a convenient but a less costly process. There is no hardship or injustice in trying at the same time alternative pleas. It is done every day in the Law Courts, where alternative defences are raised in the pleadings. In proper cases the inquiry may of course be adjourned, to obtain further evidence, or allow new issues to be raised, but in ordinary cases I see no necessity for this. If the allegations in the application form are correct, the Patentee must admit them and lose his Patent, unless he is prepared to prove adequate working in this country (where the onus is clearly upon him) or give satisfactory reasons for his inaction. If, on the other hand, the allegations are incorrect, the Patentee must say so, and then by Rule 79 state what he is actually doing in this country, as, according to the reasons given above, it is his duty to assist the consideration of the case in every possible way. If the facts as to working in this country are thus given by the Patentee there is no necessity that I can see for a double inquiry, as the facts which are put forward to negative exclusive or main working abroad, would be the same facts necessary to support a plea of adequate working in

this country, if the Patentee is thrown back on this defence ; and it is for this reason apparently that the Rules only provide for one set of particulars as to working in this country. The Patentee may of course, if he choose, join issue solely on the allegations in the application, and fight out the case on that basis ; after leaving declarations in accordance with the Rules as to the extent to which and the place in which the patented article &c. is manufactured in this country. If he has a reasonable case but is unsuccessful at the hearing, an adjournment might in proper cases be granted to enable him to bring forward a proof of any "satisfactory reasons" upon which he thinks he can rely to show why adequate working is not carried on here. In conclusion, I think any other reading of the Section than that given above would entail great expense and might render the Section practically inoperative, if a too difficult or impossible task were thrown on the Applicant."<sup>31</sup>

Similarly it was observed in *Hatschek's* case by Mr. Justice Parker as follows :—"The keynote of the Section (*i.e.* Section 27 of the English Act of 1907) is, in my opinion, forfeiture for abuse of the monopoly at the instance of even a common informer, the abuse being in certain circumstances presumed unless disproved."<sup>32</sup>

It is submitted that the above principles for the reasons stated will be equally applicable in British India under the Indian Act.

**Procedure which may be adopted by H. E. the Governor-General in Council to prevent abuse of the section and for the protection of patentees.**

As long as it is open under the current Act for any person, even a common informer, to take proceedings under Section 23 it is obvious that the Section is open to considerable abuse by unscrupulous persons. The possibility and nature of such abuse were remarked on in emphatic language in relation to the then existing English Act and Rules in the judgment already referred to of Mr. Justice Parker, of which the following extract will be of interest :—

"Lastly, I desire to make one or two observations on the Patent Rules which govern the procedure before the Comptroller

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<sup>31</sup> See *Applications for Revocation of Ilgner's Patents* (1909) 26. R. P. C. 198 at p. 200.

<sup>32</sup> See 26. R. P. C. at p. 240.



under Section 27 of the Act. As those Rules at present stand, the applicant applies for revocation, merely stating in the application that the patented article is manufactured or the patented process is worked exclusively or mainly abroad, and he need give no evidence in support of his statement; though the onus of satisfying the Comptroller of the truth of these statements rests in the first instance, in my opinion, at any rate, on him. The application is served on the Patentee, who has thereupon within 14 days to declare on oath whether the statement is or is not correct; and if he says the statement is incorrect, he must further declare on oath to what extent and in what place the patented article or process is manufactured or carried on within the United Kingdom; and, if such extent is inadequate, the reasons for the inadequacy. The Applicant has a certain time to file, but need not file, Statutory Declarations in answer; and then the matter comes before the Comptroller, there being possibly up to this point no evidence that the case is within the Section at all, for neither party is bound to give evidence of any manufacture abroad. The question whether the Patent is or is not to be revoked is disposed of at the same hearing, and I am told that the patentee has to open his case and give his evidence before the applicant gives any evidence at all. This procedure clearly, and in my opinion, wrongly, puts the patentee on his defence before the Comptroller has been satisfied by the applicant that the state of affairs contemplated by sub-section 1 has arisen; and such a procedure, besides being in my opinion most unfair to the patentee, is obviously open to very serious abuse. Even if the patented article or process is not manufactured or carried on abroad at all, yet, if anyone makes an application under this Section the unfortunate patentee has to disclose, perhaps to some competitor or intending competitor, particulars of his business which he may not desire to disclose, and to give evidence in defence of his conduct before any case raising a presumption against him has been made out. If, for example, the Patent belongs to a firm like Messrs. Armstrong & Co. and is for some improvement in some small part of the mechanism of, say, a machine gun, anyone desiring to find out how many of such machine guns were manufactured in this country might make the necessary application for revocation; and, without tendering any evidence that the case was within the Section, force the patentee to disclose on oath the extent to which the article protected by the

Patent was manufactured in this country. Having obtained that information he might elect to withdraw the application. Inasmuch as an application under the section can be made by any one, whatever may be his motive, and the Section in effect penalises patentees who have abused their monopoly, it is in my opinion all the more necessary, in order to prevent the Section being improperly used, to insist that every applicant shall give at any rate *prima facie* evidence of the existence of the state of affairs contemplated by sub-section 1, before the patentee is put to the trouble and expense of finding out and proving the extent to which the patented process or article is manufactured or carried on in this country or abroad, and of explaining and justifying everything he had done since the grant of his Patent. It must be remembered that not only can any person apply under the Section, but he can apply from time to time as he pleases. Failure on one application would be no bar to another application a year later, and although the section was no doubt passed in the interests of the public, still, if it be worth while retaining any Patent system at all in this country, it ought, I think, to be construed to give reasonable protection to patentees; and for this purpose the applicant, who may be a mere common informer, ought to be required to prove what even a common informer has to prove, namely some case requiring an answer. In my opinion the proper course for the Comptroller to pursue when he receives an application under Section 27 is, to inquire whether the patentee admits that the state of affairs contemplated by sub-section 1 has arisen. If this is not admitted, he should inquire into the matter in the presence of both parties; and the applicant, being the person on whom the onus lies, should be the first to tender evidence. It may well be that the patentee knows nothing about what is being done abroad nor what is being done in this country in the way of manufacturing the patented article or carrying on the patented process. There is no particular reason why he should know what is being done abroad unless he has foreign Patents or is himself manufacturing the article or carrying on the process abroad. Even as to the extent to which the article or process is being manufactured or carried on here, he may have no information; for he may have sold licences outright, and not confined the use to the revocation of royalties. I do not say that he may not in the course of the inquiry be compelled to say what he does know; but at least the applicant ought at first to be

called upon to make out some case requiring an answer and at any rate until he has given some evidence that the case is within the Section, I do not see what answer is required. If, on the other hand, the patentee admits that the state of affairs contemplated in subsection 1 has arisen, or if after inquiry the Comptroller is satisfied that it has arisen, the patentee may fairly be called on to state, first, what his defence is, and then to prove it. It would be convenient that, in stating what the defence is, the patentee should state the reasons on which he intends to rely, if the extent to which the patented article or process is manufactured or carried on is inadequate, and the particular facts on which he intends to rely, if he contends that it is adequate.

I should like to point out that, even as the Patent Rules now stand, it appears to me that the Comptroller can call upon the applicant for evidence of the truth of the statement contained in the application, enlarging the time for the patentee to put in his evidence till this is done: and if the applicant does not furnish evidence sufficient to call for an answer, may refuse to proceed further with the matter. Similarly, he can, I think, enlarge the time for filing evidence which can only be relevant for the patentee's defence, until he is satisfied that there is a case for calling on the patentee to defend himself. But under these circumstances, it appears to be desirable that the Rules should be altered. It must be remembered that the Section is in its nature a penal section, that the patentee is on his trial, that mere accusation raises no presumption of guilt and that the Comptroller is a Court exercising judicial functions. It is not merely the case of a departmental inquiry. The Comptroller is in the position of a judge, and not of a Commissioner employed to take evidence and with power to summon before him and examine any person he pleases. The procedure therefore I think should be clearly specified in the Rules, and should be a procedure adapted to the circumstances having regard to the onus which the Act throws on the applicant and the patentee respectively."

Since the date of that judgment the English Act and the English Rules have been considerably revised. The position remains however, it seems, in India the same as that which was thus adversely criticised by Mr. Justice Parker: only, possibly, rather worse, since there appear to be no Rules of any sort in force in British India

governing the hearing of a Petition under Section 22 or Section 23. As long as the Indian Act and Rules remain unamended, all that can be done for the protection of patentees against vexatious proceedings under this part of the Act is it seems that perhaps H. E. the Governor-General acting under his general inherent powers may be vigilant to prevent Patentees being compelled to put in a reply or make any embarrassing statements concerning their own business unless the Petitioner first established a *bona fide prima facie* case. The present provisions of the Act as contained in Sections 22 & 23 are however highly unsatisfactory and incomplete. Luckily it would appear that the full effect of Section 23 has not as yet been fully appreciated by any of that unscrupulous portion of the community which may be assumed to exist in British India equally as in other countries.

### Discretion.

It is submitted that the power to revoke (or to issue compulsory licences under Section 23) is discretionary ; and need not be exercised on a *mala fide* application even if the requisite grounds stated in the Sections were in fact established.

This aspect of the matter was emphasised in England by the Comptroller-General in *Ilgener's* case when he referred to the safeguards which he could invoke under the Act and the Rules to make it difficult for a dishonest application for revocation to be proceeded with. The following extract of his observations as to this may be noted :—

"I am however prepared to hold that the Comptroller has power under the general practice of the Office and under Patents Rules 80 and 81, to call the Applicant before him and examine him ; or to call for a sworn declaration if necessary, or to appoint a hearing at which both parties may be heard, and the proceedings stayed where necessary. I shall be prepared to use these powers in any cases where my attention is called to circumstances which raise a presumption of *mala fides* or dishonesty, or in any exceptional case. I would further point out that a dishonest application even if fully proved, need not be granted by the Comptroller under Section 27. The word used is "may", which in my opinion gives the Comptroller discretion to refuse a *mala fide* application in such cases. There are further the powers as to costs under Section 39(1) which may be used if necessary, against an Applicant. I think that

if the procedure outlined above is followed at this Office, it will meet sufficiently every case of harshness or unfairness which a too strict reading of the Section might entail upon a Patentee.”<sup>33</sup>

It is submitted that the force of this decision is equally applicable in respect of the Indian Act of 1911.

### **Costs.**

It was held in England with regard to a Petition to the Board of Trade for a compulsory license under the former Statutes, that the Board of Trade had no power to make any order as to costs. The disadvantage of this omission to give it the necessary power was commented on both in the case of the *Incandescent Gas Light Company's Patent (Meteor Petition)* reported in (1898) 15. R. P. C. 727 and in the case of *Bartlett's Patent (Gormully's Petition)* reported in (1899) 16. R. P. C. 641 at pages 651 and 652. It was no doubt partly considerations of the expense even to a successful Petitioner of presenting a Petition before the Board of Trade which accounted for the small number of Petitions which appear to have been presented.

It is submitted that a similar position arises in regard to the question of costs on a Petition for a compulsory license or revocation to H. E. the Governor-General in Council under Sections 22 and 23 of the Indian Patents & Designs Act of 1911. It would seem that the mere words in Section 22(4) empowering H. E. the Governor-General in Council to order the grant of licenses “on such terms as he may think just” do not carry the power of making an order for the payment of costs in connection with the filing or hearing of the Petition. But the matter is not free from doubt. In this connection it is to be observed that while Section 65 of the Indian Act expressly gives to the Controller the power of awarding costs, there is no Section giving such power to H. E. the Governor-General in Council in regard to the proceedings which are to be had under the Act before him.

### **Concurrent remedies.**

It has been held in a decision on the construction of Section 27 of the English Act of 1907 in effect that there was nothing to prevent a person in a proper case making an application to the Comp-

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<sup>33</sup> See (1909) 26. R. P. C. 198 at p. 203.

troller under that Section for revocation of a patent on the ground of its being worked mainly or exclusively abroad, even though there might at the time be a suit pending in Court in which the Patentee was suing him for infringement.<sup>34</sup>

The following passage from the decision of the Comptroller-General in that case may conveniently here be noted :—

“I come finally to the particular circumstances of this case, upon which I understood the Patentees’ Counsel to rely. It was said that adopting the view that the Comptroller has a discretion to call on the Applicant to make declarations, or to be examined before him in exceptional circumstances, and even to refuse to proceed with the case, it is a good ground for the exercise of such powers that an action of infringement has been commenced by the Patentee against the Applicant under Section 27, before the proceedings under that Section were taken. In this case an action for infringement has been commenced and the pleadings were closed before the Application was filed. The defendant (the Applicant here) has not pleaded as a defence under Section 25 that the Patent is worked mainly or exclusively abroad, nor has he counterclaimed for the revocation of the Patent under Section 32. Mr. Russell-Clarke contends under these circumstances the Applicant has a perfect right to come here and choose the simpler, cheaper, and more speedy process under Section 27. I can see no answer to this, having regard to the fact that under Section 21 (amendment of Specification), and under Section 26 (revocation) it is specifically provided that where an action for infringement is pending no application shall be made under those Sections (except by leave of the Court in Section 26) and that this provision was deliberately omitted in Section 27. Its omission would thus seem by implication to authorize a defendant in an infringement action to make an application under the Section. Although, however, in my opinion such a defendant may rightfully commence proceedings under Section 27, I think it is a matter for consideration in each case whether it is right and proper that he should pursue his remedy here, while an action for infringement is pending elsewhere. The whole circumstances should be considered, in each case ; above all the state of the action in the High Court, the

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<sup>34</sup> See *Application for revocation of Ilgner’s Patents* (1909) 36. R. P. C. 198 at p. 204.

pleadings and any other relevant facts. There might be cases where the process would be an abuse, and used for improper purposes, and in such cases the use of the Comptroller's discretionary powers would, I think, be amply justified. If for example, in any case it was clearly shown that the Applicant was making use of the proceedings here merely to fish out a case against the plaintiff in an infringement action, I should be prepared unhesitatingly to use any of the discretionary powers I possess. In this case, however, after careful consideration, I do not think it necessary to call upon the Applicant to leave a declaration or make any explanation. The pleadings were closed in June before Section 27 came into operation, and Mr. Gray very frankly admitted that in this case there was no question of *mala fides* or suspicion. As I cannot assent to his view that the applicant should in every case be called on for evidence, I must therefore refuse to exercise any power that I have in this case and must consequently call on the Patentees to leave their declarations at the Office, in accordance with Patents Rule 79, within 14 days from the date of this decision. I reserve the question of costs."

It is submitted that the reasoning in the above decision is equally applicable on the wording of the present Indian Act of 1911, which is for all material purposes similar to that of the English Act of 1907 there considered.

### **Appeal.**

There is no appeal from any order made under Section 22 or Section 23 of the Indian Act.

### **Comments.**

The provisions at present contained in the Indian Patents & Designs Act 1911 which are directed to preventing an abuse by a patentee of his monopoly, do not appear to be satisfactory. They are likely to be ineffective in one direction and oppressive in another.

In cases where a person acting from the highest motives might desire to take action for the public good against a patentee to prevent an abuse of monopoly, the provisions will tend to be ineffective; owing to the cumbersome and expensive nature of the procedure ordained to be employed. In all probability a year will elapse from the day when the applicant files his Petition to the day when

that Petition is disposed of by H. E. the Governor-General in Council. It will be inevitable that there will be delay before a hearing can be given to what is after all in most cases a comparatively small matter, when there is so much other vital, more important and more pressing business of state calling for prior fixtures. As to the expenses, this will tend to be above the ordinary as the solemnity and rareness of an occasion when a matter is to be placed before such an august body as H. E. the Governor-General in Council is to the ordinary citizen also above the ordinary : and he will not as a rule trust to his own powers the task of putting forward his Petition. Furthermore as already observed, it seems that even a successful Petitioner will not be able to recover any of his costs for the Proceedings before H. E. the Governor-General in Council from his unsuccessful opponent. It was been remarked in England that it was for the very same reasons that the provisions contained in the Act of 1902 came to be almost a dead letter. If the procedure of placing the requisite petition before the Board of Trade was too cumbersome and too expensive for the ordinary business man, as it was found to be, the Indian procedure will be even more impracticable.

On the other hand in cases where a person acting from the lowest motives may desire to use the provisions of the Act as a useful means for obtaining information in regard to a competitor's trade and business which would normally be to him a closed book, the proceedings will be effective enough to be highly oppressive to the unfortunate patentee. The abuses, to which the Act, as it stands, is open, have been sufficiently envisaged by Parker J. in the judgment already referred to. It is only right to point out that in India the position is not likely to be better than that which was objected to in England : particularly in view of the fact that in India there are no rules at all regulating the procedure on these petitions in Patent matters to H. E. the Governor-General in Council and accordingly it may be supposed that any patentee against whom a Petition of this nature was brought would not feel safe in defending himself against attack without putting forward in connection with his reply all the fullest possible particulars in the way of facts and figures to justify his management of his monopoly. In doing so he would be playing into the hand of an unscrupulous adversary. And there would be nothing to prevent the Petitioner, in a



purely vexatious case, from withdrawing his petition at any stage after he had considered that he had obtained enough information or inflicted enough annoyance. Nor would there be anything to prevent him repeating the treatment and putting forward another vexatious Petition the next year.

It is submitted that it would be beneficial to all parties who might be concerned regarding any dispute arising from an alleged abuse of monopoly if the present provisions of the Act were amended on lines similar to those which have been adopted in the United Kingdom : so as to give the power of making orders in regard to petitions for abuse of monopoly to the Controller of Patents in the first instance with the safeguard of an appeal if dissatisfied to the High Court.

## PART IV

### PETITIONS TO THE CONTROLLER FOR REVOCATION ON SURRENDER OF PATENT UNDER SECTION 24 : REVOCATION BY NOTIFICATION UNDER SECTION 25

#### **Surrender of a Patent.**

By Section 24 of the Indian Act it is provided as follows :—

“24. A patentee may at any time, by giving notice in the prescribed manner to the Controller, offer to surrender his patent, and the Controller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the Patent.”

Applications under this Section will as a rule be purely formal. They are not like other proceedings dealt with under this chapter based on “objections” made by persons attacking the patent after grant. These applications are merely mentioned here since proceedings taken under Section 24 do in fact constitute another method of obtaining revocation. In these proceedings it is the Patentee himself and no one else who is entitled to make the application.

**Revocation by Notification.**

By Section 25 of the Indian Act it is provided as follows :—

“25. A patent shall be deemed to be revoked if the Governor General in Council declares, by notification in the Gazette of India, the patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public.”

This Section would appear to give H. E. the Governor-General power to revoke a patent on his own initiative without any application having been made by any person and irrespective of Sections 22 and 23. There does not appear to have been as yet any case of a patent having been revoked under this section.

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## **CHAPTER XII**

### **PROCEDURE RELATING TO AMENDMENT OF A SPECIFICATION—I. DEVELOPMENT OF THE RIGHT TO AMEND—**

#### **II. AMENDMENT BY THE CONTROLLER—**

#### **III. AMENDMENT BY THE COURT—PROCEDURE RELATING TO RECTIFICATION OF THE REGISTER OF PATENTS**

### **PART I**

#### **DEVELOPMENT OF THE RIGHT TO AMEND IN BRITISH INDIA**

##### **Origin of the right to amend under English Law.**

For a long period in the earlier history of Patents it was beyond all possibility for a Patentee to obtain any amendment of his Patent : except only an amendment of a clerical error appearing on the face of it. The stringent limitations on monopolies which were for the first time reduced to writing in the Statute of Monopolies, (though it enacted no new law and was both in form and substance merely declaratory of the existing law), and the vigorous spirit in which the restrictions of that Statute were enforced by the Courts, together with the jealous scrutiny with which all Patent rights in general were examined by the Courts, with a view to protect the public from unjust monopolies, created in the end, at one time, a result much to the detriment of the Patentee.<sup>1</sup> It was in such circumstances that the letters patent and the specification came to be treated as unalterable, clerical errors only excepted ; and any defect or flaw which either of these instruments contained was held to be irremediable, being interpreted most strictly against the Patentee.

In the Common Law courts this doctrine of protecting the public at the expense of the patentee was pushed even further in another respect ; and it came to be held that Letters Patent were

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<sup>1</sup> See Webster on Letters Patent at page 11.

wholly void for any defect in part. Thus the Patentee was deprived of the whole of his invention from the failure of some condition, as by want of novelty, in a very small part.

It was to amend this state of the law that in 1835 in England the act, being 5 & 6 Will 4.c 83, was passed which was known as Lord Brougham's Act. By this act it was provided, for the first time, that a patentee might, with the consent of the proper law officers of the Crown, amend the title and specification of his Letters Patent.<sup>2</sup>

Under Section 1 of the Act express provision was made in effect that "a patentee might, (after obtaining leave of the Attorney-General or Solicitor-General), enter with the Clerk of the Patents in England a disclaimer of any part either of the title of the invention, or of the specification, stating the reason for such disclaimer, or might, with similar leave, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as should extend the exclusive right granted by his Letters Patent. And that such disclaimer or memorandum of alteration being filed by the said Clerk of the Patents and enrolled with the specification should be deemed and taken to be part of such Letters Patent or such specification in all Courts whatever."

Then followed certain provisions providing for the possibility of objection by persons entering caveats, the effect of amendments on pending actions, and advertisement. It may be of interest in passing to note the wording of these provisions which were the forerunners of present day practice in those respects. The following is an extract of the material part of the said Section 1 :—

*"Provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration ; which caveat, being so entered shall give the party entering the same a right to have notice of the application being heard by the Attorney-General or Solicitor-General, or Lord Advocate respectively : Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by scire facias), pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence,*

<sup>2</sup> See Edmunds on Patents (1890 edn.) note at page 637.

*and deemed and taken to be the title and specification of the invention, for which the letters patent have been or shall have been granted : Provided also, that it shall be lawful for the Attorney-General or Solicitor-General or Lord Advocate before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-General or Solicitor-General or Lord Advocate, shall seem right and shall if he so require such advertisement, certify in his fiat that the same has been duly made."*

The Act was the beginning of the growth of the right in a Patentee to amend his Specification. Lord Brougham's Act of 1835 was repealed by the Act of 1883. By the Act of 1883 this right of amendment was regulated by Sections 18 and 19 of the Act which were worded as follows :—

- "18(1) An applicant or a patentee may, from time to time by request in writing left at the Patent Office, seek leave to amend his specification including drawings forming part thereof by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.*
- (2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner and at any time within one month from its first advertisement any person may give notice at the patent office of opposition to the amendment.*
- (3) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request and shall hear and decide the case subject to an appeal to the law officer.*
- (4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.*
- (5) Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether and subject to what conditions if any, the amendment ought to be allowed.*

- (6) *When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.*
  - (7) *The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether and subject to what conditions, if any, the amendment ought to be allowed.*
  - (8) *No amendment shall be allowed that would make the specification as amended, claim an invention substantially different from the invention claimed by the specification as it stood before amendment.*
  - (9) *Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud ; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.*
  - (10) *The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*
- 19(1) *In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed."*

From the wording of these two sections it is observed that under Section 18 a definite procedure was laid down for applications being made for amendment before the Comptroller, and that before him an application was open by way of disclaimer, correction or explanation ; while under Section 19 provision was made for the first time for the Court, also, in an action for infringement and in proceedings for revocation to have the power of making an order that a Patentee might be at liberty to apply at the Patent office for amendment. It will be noted that under this Act of 1883 no positive power was given to the Court of itself to order any amendment but only the power of allowing a Patentee to make an application at the

Patent Office ; also that this power only went to the extent of allowing him then to make an application for amendment by way of disclaimer and not by way of correction or explanation. Even so, the provisions of this Act of 1883 must have been of great benefit to Patentees who would otherwise, for some slight technically or error in phrasing, have been faced with a certainty of losing both their suit and their Patent.

The subsequent provisions of the Act of 1907 which were embodied in Sections 21 and 22 were as follows :—

*"21. (1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.*

*(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.*

*(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.*

*(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.*

*(5) The decision of the Comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend, and where notice of opposition has been given the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request and, where there is no opposition, the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.*

*(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.*

(7) *Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud ; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification.*

(8) *This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.*

22. *In any action for infringement of a patent or proceedings before the court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs, advertisement or otherwise, as the court may think fit :*

*Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment and where an application for such an order is made to the Court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court."*

Here it will be observed power was for the first time given to the Court itself in its own jurisdiction to order an amendment : but only by way of disclaimer.

It was the Act of 1919 by its amendment of Section 22 of the Act of 1907 (that is by the amendment effected in the schedule of the Act of 1919) whereby in Section 22 of the Act of 1907 after the words "by way of disclaimer" there were inserted the words "correction or explanation", which eventually extended to the Court during an action for infringement and in a proceeding for revocation powers similar in extent to the powers of the Comptroller. The position has remained unaltered in the current English Act of 1932.

**Previous Indian Law : progressive extension for the benefit of the Patentee of the right to amend in India.**

In India it appears that the history of the development of the Patentee's right to amend has followed a different course. It appears that as early as 1856 under Section 29 of that Act it was intended to



provide statutory provision in India to the effect that certain defects in a specification were not to be fatal to the privilege ; and that such defects might be amended by the Court. if by such amendment no injury was caused to the public.<sup>3</sup>

It may be observed that under that Act, while all Petitions for exclusive privileges under that Act were to be made to the Governor-General in Council and all grants of exclusive privileges were made by him, at the same time it was provided that all questions of validity or invalidity were to be decided by the Court. There was of course at that time no Patent Office. It may therefore be supposed that the power of amendment was given to the Court as being a suitable constituted body then in existence in India capable of exercising it in practice satisfactorily : possibly it was considered by the framers of that Act as impracticable for the Governor-General in Council to be required to adjudicate on minor questions relating to amendment, as it would be for him to adjudicate on lengthy disputes concerning the legal validity or invalidity of a Patent which were decided by the Court. It may well be that this Act which by chance gave to the Court a power of ordering amendments in its own jurisdiction which the Courts in England did not possess till a much later date, was only in intention following out the principles underlying Lord Brougham's English Act of 1835. In England leave was required to be obtained from the Law Officers and after that the amendment was actually effected by the Clerk of the Patents : while in India at that time there being no Clerk of the Patents (and, it seems, no corresponding Law Officers) both the granting of leave and the actual effecting of the amendment was put in the hands of the Court.

In fact the Act of 1856 by reason of certain legal defects never became operative and was replaced by the Act of 1859.<sup>4</sup>

By Section 14 of the Act of 1859, following again, as it appears, what had been the underlying principles of Lord Brougham's English Act of 1835, it was provided as follows :—

“14. If, after the filing of the specification, the Petitioner shall have reason to believe that through mistake or

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<sup>3</sup> See Act VI of 1856 and Theobald's Legislative Acts of the Governor-General in India in Council (1868 edn.) Vol. II at p. 397.

<sup>4</sup> See Appendix No. 4.

inadvertence he has erroneously made any mis-statement in his petition or specification, or included therein something which at the date of his petition was not new or whereof he was not the inventor, or that such specification is in any particular defective or insufficient, he may petition the Governor-General in Council for leave to file a memorandum pointing out such error, defect, or insufficiency, and disclaiming any part of the alleged invention, or, in case of any defect or insufficiency of the specification, for leave to file an amended specification. The petition shall state how the error, defect, or insufficiency occurred and that it was not fraudulently intended, and shall be accompanied by a declaration in writing signed by the petitioner, and if he be absent from India by his agent, stating that the contents of such petition are true to the best of his knowledge and belief. Upon such petition the Governor-General in Council may make an order allowing such memorandum or amended specification to be filed. All the provisions of Sections X, XI and XIII, applicable to specifications, shall be applicable to the petitions, orders, and memoranda or amended specifications referred to in this Section. An amended specification filed under the provisions of this Act shall, except as to suits or proceedings, relating to the exclusive privilege which shall be pending at the time of the filing of such amended specifications, have the same effect as if it had been the specification first filed, provided that nothing contained in an amended specification shall extend or enlarge any exclusive privilege before acquired."

But from this it will be observed that the application for amendment was under this part of the Act required to be made to the Executive side of Government that is to say to the Governor-General in Council. And the only person who could make such an order for amendment was the Governor-General in Council.

At the same time power was expressly given to the Court to order an amendment of a specification at the hearing of any applica-

tion under Sections 24 and 25 of that Act (that is to say at the hearing of certain applications in effect for revocation of the Patent), as was expressly provided in Section 30 of the Act of 1859 which was worded as follows :—

“30. If the Court, at the hearing of any such application as last aforesaid, shall think that the petitioner has, in the description of his invention in the petition or specification (if any) included something which at the date of the petition was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect, or insufficiency was not fraudulently intended, the Court may adjudge the said exclusive privilege to have been acquired and to be valid, save as to the part thereof affected by such error, defect, or insufficiently, or if the Court shall think that the error, defect, or insufficiency can be amended without injury to the public, they may adjudge the exclusive privilege in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be amended in any of the said particulars ; and thereupon the petitioner, his executors, administrators, or assigns shall, within the time limited by the said Court for the purpose, file a specification amended according to such order. Provided that no such amended specification shall have the effect of extending or enlarging the exclusive privilege before acquired.”

In this respect giving the Court power to amend during the hearing the Indian Act of 1859 is ahead of the corresponding legislation in England at that time. The reasons for giving the Courts in India the power to make the orders itself may however as indicated have been due to factors of administrative convenience : since there was no Clerk of the Patents or Comptroller of Patents or Patent Office or other convenient office to whom the work could have been delegated.

By the Act of 1888 little alteration was made ; Sections 18 and 19 of that Act being worded as follows :—

18. (1) If, after the filing of the specification, the applicant

has reason to believe that through mistake or inadvertence he has erroneously made any mis-statement in his application or specification or included therein something which at the date of the delivery or receipt of his application was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, he may apply to the Governor-General in Council for leave to file a memorandum pointing out the mis-statement or disclaiming any part of the alleged invention, or for leave to file an amended specification, as the case may be.

- (2) The application must be in writing signed by the applicant, and must state how the error, defect or insufficiency occurred and that it was not fraudulently intended.
- (3) Upon the application the Governor-General in Council may make an order allowing the memorandum or amended specification to be filed.
- (4) The provisions of Section 6, with respect to applications, and of Sections 9 and 11 with respect to specifications shall apply, so far as they can be made applicable, and copies thereof to applications, and to amended specifications, respectively, made and filed under this section.
19. An amended specification filed under the last foregoing section shall, except as to any suit or proceeding relating to the exclusive privilege which may be pending at the time of the filing of the amended specification have the same effect as if it had been the specification first filed :

Provided that nothing in an amended specification shall be construed to extend or enlarge an exclusive privilege before acquired.

Sub-sections 2, 3, and 4 of Section 36 of that Act which relate to the power of the Court to make orders of amendment were as follows :—

36. (2) If it appears to the High Court, at the hearing of any such applications as last aforesaid that the appli-

cant has, in the description of his invention in the application for leave to file a specification thereof or in the original or any amended specification, erroneously included something which at the date of the delivery or receipt of the application for leave to file the specification was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect or insufficiency was not fraudulently intended, the Court may adjudge the exclusive privilege to have been acquired and to be valid save as to the part thereof affected by the error, defect or insufficiency : or

- (3) If it appears to the High Court that the error, defect or insufficiency can be amended without injury to the public, the Court may adjudge the exclusive privilege in respect of the whole of the invention to be valid, and may, upon such terms as it thinks reasonable, order the specification to be amended in any particular in which it is erroneous, defective or insufficient ; and thereupon the applicant shall, within a time to be limited by the Court for the purpose, file in the office of the Secretary a specification amended according to the order.
- (4) The provisions of Section 18 with respect to the distribution and disposal of copies of amended specifications and of Section 19 with respect to the effect of such specifications, shall apply, so far as they can be made applicable, to an amended specification filed under this section.

The next Act after 1888 was the Act of 1911 which is the Act now in force. It was this Act which set up the Indian Patent Office as it now exists and the Controller of Patents in India. The Sections of this Act relating to amendment are respectively Section 17 regarding amendment by the Controller and Section 18 regarding amendment by the Court.

It was not till 1930 that power was given to the Indian Courts to make orders for amendment otherwise than by way of disclaimer ; when the 1930 Act made an amendment in Section 18 of the 1911 Indian Act corresponding precisely to the amendment made in the

English Act of 1907 by the English amending Act of 1919. By Section 12 of the Act of 1930 the words "correction or explanation" were inserted after the word "disclaimer" in Section 18 of the principal Act of 1911.

**Frequent necessity for amendment in practice.**

The principle of the Common Law remains even at the present day unaltered whereby it is held that if a Patent is defective in certain respects in part, the Patent is bad in *toto* and consequently void.

Thus where a Patent or an application for Patent has several claims and one or more of such claims are bad either by reason of being too wide and including matter which is not new or for any other reason, then though there may remain one or more claims which are good in themselves when standing alone, yet the whole Patent will be bad and the Patentee will be deprived of the advantage of even those claims which in themselves are good : unless leave can be obtained to amend the Patent so as to strike out and omit those portions which are bad, or except, since 1930, where the discretion of the Court can be involved under Section 35A.

Without here giving numerous examples of cases where it becomes a matter of great if not vital importance to the Patentee to obtain leave to amend his application or his Specification, it becomes at once obvious that such a necessity will in practice frequently arise.

While the statement to be found in Webster on Letters Patent at p. 17 that "the patentee was liable to be deprived of his patent from the failure of some condition such as want of novelty in a very small part of the invention, insufficient description, ambiguous terms uselessness of parts, inadequacy of means, indefinite claims, surplusage, no proper distinction between new and old, or some objection to the specification as not being a true, full, clear and faithful account of the invention" does not remain true so as to mean that such defects are now fatal and final and cannot be amended, yet it does still remain substantially true in the sense that such defects may still be fatal unless they are amended.

**Amendments are readily allowed :**

The tendency is to allow amendments readily. The view now generally taken of the matter is, that, in a case where an amendment

is properly requested, the position amounts to this, that the Crown has purported to make a grant which is not valid : therefore it is obviously fitting that the Patentee should be allowed to amend so as to have his grant in proper order and in valid form provided that he can do so without injuring the rights of the public and without extending the scope of his monopoly. Each case will depend on its own facts and can only be decided on its own merits.

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## PART II

### AMENDMENT BY THE CONTROLLER

**Amendment of Application or Specification : by the Controller : before application is accepted.**

As already stated (see Ch. IX at p. 366), after the application for a patent has been submitted with the specification and drawings to the Controller, there follows a process of examination of these by the Patent Office for the purpose of seeing that the application is in order in respect of certain specific requirements. These requirements are stated in para 5 of the Indian Patents & Designs Act of 1911. If these requirements are not fulfilled it is open to the Controller at his discretion in a proper case to require that the application, specification or drawings be amended before he proceeds with the application. [ See Section 5(1) ].

In this case, as is seen from the wording of the section, any amendment ordered is made as a result of the directions of the Controller acting *suo motu* on his discretion.

**Amendment of application or specification : at the request of the applicant for Patent : before the Controller : before application is accepted.**

If the applicant for patent wishes to amend his application or specification or drawings he may ask for leave from the Controller to do so. [See Section 17(1)]. Where the application has not reached the stage of being accepted by the Controller the matter rests merely between the applicant and the Controller. This is only reasonable since no one else has then had notice of the extent of the monopoly

claimed in the application and no one but the applicant is affected. It is for the Controller then to determine whether and subject to what conditions, if any, the amendment will be allowed. The Controller in such case has full power to decide the matter without further ado himself. This clearly appears from Section 17(2) of the Act of 1911.

**Amendment of application for Patent or specification : at the request of the applicant for Patent : before the Controller : after application has been accepted.**

Where the application has passed the stage of being accepted it still remains open to the applicant for Patent to ask at any time for leave from the Controller to amend the application or specification or drawings. He may make such application for amendment before the Controller at any time during the whole life of the Patent. [See again Section 17(1)]. But in this case, it is necessary for the matter to be advertised in order that any persons interested may give notice of their opposition before any amendment can be allowed by the Controller. Section 17 of the Act of 1911 reads as follows :—

- “17. (1) An applicant or a patentee may at any time, by request in writing left at the Patent Office and accompanied by the prescribed fee, seek leave to amend his application or specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.
- (2) If the application for a patent has not been accepted, the Controller shall determine whether and subject to what conditions (if any) the amendment shall be allowed.
- (3) In any other case the request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within three months from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.
- (4) Where such a notice is given the Controller shall give notice of the opposition to the person making the request, and shall hear and decide the case.
- (5) Where no notice of opposition is given or the person



so giving notice of opposition does not appear, the Controller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

- (6) The decision of the Controller in either case shall be subject to an appeal to the Governor-General in Council.
- (7) No amendment shall be allowed that would make the application or specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before amendment.
- (8) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud ; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the application or specification.
- (9) This section shall not apply when and so long as any suit for infringement or proceeding before a Court for the revocation of the patent is pending."

The steps of the procedure, which is laid down by Section 17 and by the Rules are thus as follows :—

(i) The application for amendment is made in writing and left at the Patent Office, stating the nature of and reasons for the proposed amendment. [(Section 17(1).]

(ii) The request and the nature of the proposed amendment is advertised in the prescribed manner and certain interested persons notified [Section 17(2) and see Rule 30].

(iii) Any person may then within three months of the first advertisement give notice at the Patent Office of opposition to the amendment [Section 17(3) and see Rule 31].

(iv) After three months have elapsed, if there is no opposition to the amendment, the Controller deals with the application for amendment in the same way as in a case where an application is made before the application for Patent has been accepted : and himself decides the matter without further ado forthwith. [See Section 17(5)].

*Alternatively :*

(iv) If there is opposition forthcoming to the amendment then the Controller is required by the Act of 1911 to give notice of the opposition to the person making the request for amendment. [Section 17(4) & Rule 31.]

(v) In this case, where there is opposition, the Controller then proceeds to hear and decide the case: that is whether the amendment is to be allowed or not. [Rule 31 & Rules 20, 21 & 22.]

The procedure outlined above is considered in detail under the next following headings.

**Form of application for amendment of application for Patent or of Specification before the Controller.**

If the application is merely for the correction of a clerical error under Section 62, the application may be made on Form No. 28. Otherwise any application to be made under Section 17 of the Act for the amendment of an application or a specification (including drawings) is to be made on Form No. 11 and is required to be accompanied by a copy of the application, specification or drawings, showing in red ink the proposed amendment in such a manner as to indicate clearly the alteration desired. The matter is regulated by Rules 29 to 32 of the Indian Patents & Designs Rules, 1933.

**The Fee.**

If for a clerical error only, the fee will be Rs. 7 only.

Otherwise the prescribed fee is Rs. 10, if the application for amendment is made before the application for Patent is accepted by the Controller. And Rs. 20, if afterwards.

**As to Advertisement and notice.**

Rule 30 of the Indian 1933 Rules provides as follows :—

“If the request relates to an application for a patent which has been accepted, the request and the nature of the proposed amendment shall be advertised by notification in the Gazette of India and in such other manner, if any, as the Controller may in each case direct. The Controller shall also notify all persons whose names, at the time of the request, are entered on the register as claiming an interest in the Patent.”

The object of such advertisement is to give notice of the

proposed amendment to any persons who may be interested in the Patent but whose names are not recorded on the register. The new Rule 30 takes the place of both rule 23 and rule 45 of the Indian 1912 Rules.

**As to notice of opposition :—**

**Who can oppose.**

The wording of Section 17(3) of the Act of 1911 is that "any person" may give notice of opposition to the amendment within three months from its first advertisement. The words "any person" here used are the same as the words used in the Indian Section 9(1) relating to notice of opposition to a grant of a Patent.

In regard to the construction of that section it has already been shown how the words "any person" have to be read with a limited meaning as if the words were "any interested person".

It is submitted that in proceedings in opposition to amendment, the term "any person" used in Section 17(3) of the Act has a similarly restricted meaning; and is actually limited to mean in effect any person who has a certain degree of interest personally in the amendment. It is submitted that the position is the same as in proceedings in opposition to the grant of a patent.<sup>5</sup> And it is submitted that the Controller should refuse to hear in the proceedings before him any person who does not show such sufficient interest. It is also submitted that it is open to the applicant for the amendment on his part to take, in such proceedings before the Controller, an objection that the opponent to the proposed amendment has not sufficient personal interest to entitle him to oppose.

In regard to the question what degree of interest is necessary by a person who wishes to oppose an application for an amendment, such interest will, it is submitted, be similar to the interest required in an opponent in proceedings in opposition to the grant of a Patent. As to this reference may be made to Chapter X where this point has already been fully discussed.

**No application for amendment can be made before the Controller during pending court proceedings.**

It must be emphasised that no such application for amendment as has been discussed in the last two paragraphs can be made before

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<sup>5</sup> See page 403 above.

the Controller at all when and so long as any suit for infringement or proceedings before a Court for the revocation of the Patent is pending. In such event any application has to be made to the Court: which matter is further considered hereafter.

This is the effect of the provisions of Section 17(9) of the Act of 1911, which provides that Section 17 shall not apply when and so long as any suit for infringement or proceeding before a Court for the revocation of the patent is pending.

Amendments ordered by the Controller to be made under Section 5 of the Act of 1911 are not of course affected by Section 17(9). Since the application for Patent has in cases contemplated by Section 5 not reached the stage of being accepted by the Controller it follows that it is not possible for any suit contemplated by Section 17(9) to exist, there being no complete Patent in such case to form the subject matter of such suit.

Where a suit has been instituted and proceedings have been taken in Court in regard to the Patent in connection with which the patentee may wish to make applications for amendment, questions may arise whether the suit or proceeding is pending so as to constitute a bar to his making his application before the Controller or not.

It has been held in the case of *In re National Carbon Coy. Ltd.*,<sup>6</sup> by the Calcutta High Court that it is open to a Patentee to apply to the Controller for amendment of his specification even during the interval after the delivery of judgment in an infringement suit which had been instituted by him in the Calcutta High Court and before the filing of an appeal which was filed by the Defendant in such suit. It was held by Panckridge J. in the course of his judgment in that case, that there was not in such circumstances, at the time when the application for amendment was presented to the Controller, any suit for infringement "pending".<sup>7</sup>

**Nature of amendments allowable by the Controller on application made to him.**

Section 17(1) refers to a request for leave to amend an application or specification including drawings forming part thereof "by

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<sup>6</sup> (1933) 38 C. W. N. 729, or 61, Cal. 450.

<sup>7</sup> See also *Cropper v. Smith* (1884) 28. Ch. D. 148.

way of disclaimer, correction or explanation". And it is further provided by Section 17(7) as follows :—

"No amendment shall be allowed that would make the application or specification as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before amendment."

It is clear from this that any amendment seeking to add new matter or relating to new invention or to an improvement going beyond the invention contemplated in the original application or specification is not allowable.<sup>8</sup>

**Effect of the Controller's order where leave to amend has been granted.**

Section 17(8) provides as follows :—

"Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud ; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the application or specification."

**Right of Appeal.**

The decision of the Controller, as to the proposed amendment whether the amendment is opposed or not, is subject to an appeal to the Governor-General in Council. [See Section 17(6)].

**Restriction on recovery of damages.**

Section 19 of the Act of 1911 provided as follows :—

"Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act, no damages shall be given in any suit in respect of the use of the invention (before the date of the decision allowing the amendment) unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge."

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\* For a consideration of the nature of amendments which may be allowed and illustrative cases see *Terrell* (8th edn.) at p. 229 *et seq.*

**Necessity of advertisement after amendment effected.**

The Section above quoted prescribes also that the amendment shall be advertised in the prescribed manner.

Such advertisement is required to be made in every case of an amendment made by the Controller or at the request of the applicant for a patent or patentee, that is to say under Section 17 of the Act of 1911, whether there has been any opposition to the amendment or not.

The practice is for such advertisement to be published in the Gazette of India and in two or more newspapers or technical journals if directed by the Controller.

There is no provision under the Act or under the Rules making it necessary for an amendment to be advertised where the amendment has been made under Section 5 of the Act of 1911 by the Controller before the application of patent has been accepted. There is no necessity for any such advertisement since no one apart from the applicant himself has then as yet had any notice of the extent of the monopoly claimed in the original application or specification as stood before amendment.

**Application to Controller for amendment of application or of specification where the amendment is merely to correct a clerical error.**

This is a different matter to that which has in this chapter been so far considered. This is regulated by Section 62 of the Act of 1911. Under Section 62 the Controller may "On request in writing accompanied by the prescribed fee... correct any clerical error in or in connection with an application for a patent or in any specification".

The application in such case is made on Form No. 20.<sup>9</sup>

The prescribed fee is then Rs. 5.

In such case no advertisement of the application for amendment is required whether the application for patent has been accepted or not : the Controller has power to deal with the matter himself forthwith.

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\* See Appendix No. 5 below.

## PART III

### AMENDMENT BY THE COURT

#### **Amendment of an application for a Patent or specification (or of a specification by the Patentee) : before the Court.**

Section 18 of the Act of 1911 provides as follows :—

“In any suit for infringement of a patent or proceeding before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit.

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Controller, and the Controller shall have the right to appear and be heard.”

Apart from this section there appear to be no Rules made by any of the High Courts in India in regard to the procedure to be followed when an application is made to the Court by the patentee for leave to amend his application for Patent or his specification.

It may be of service however to refer to the provisions of the English Rules relating to such matters. These are to be found in Order 53A Rule 21 of the Rules of the Supreme Court.<sup>10</sup>

## PART IV

### ENTRIES IN AND RECTIFICATION OF THE REGISTER

#### **Entries in the Register.<sup>11</sup>**

Entries in the register have an especial importance in view of the Videntary value which is given to them under the Act and in

<sup>10</sup> See Appendix No. 3 below. Also the comments contained in the (English) Annual Practice 1935 at p. 1008. Compare also (English) R.S.C. Order 53A Rule 6.

<sup>11</sup> For the statutory provisions regarding the Register of Patents see Sections 58 to 64 of the Indian Act of 1911 : also Rules 49 to 61 of the 1933 Rules.

particular under Section 63. In all cases where there is a whole or partial transfer of the ownership of a Patent, as when any assignment of it is made or any license in respect of it is granted, it becomes advisable to have particulars of the fact registered in the Register. Circumstances therefore frequently occur when it becomes necessary for an interested person to apply for entries to be recorded in the Register of Patents. The making of such entries is governed by Section 63 of the Indian Act of 1911.

### **Rectification of the Register.**

Provision for rectification of the Register of Patents is contained in Section 64 of the current Indian Act of 1911, which is worded as follows :—

“64(1) The Controller may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging or varying such entry as he thinks fit and rectify the register accordingly.

(2) The Controller may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) An appeal shall lie to the High Court from any order of the Controller under this section ; and the Controller may refer any application under this section to the High Court for decision, and the High Court shall dispose of any application so referred.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Controller in the prescribed manner, who shall upon the receipt of notice rectify the register accordingly.

(5) Nothing in this section shall be deemed to empower the Controller—

- (a) to rectify the register of patents, or to decide any question relating to a patent, otherwise than for the purpose of correcting a mistake of fact apparent from a reference either to the patent itself or to some order



of a competent authority made under any other provision of this Act, or

- (b) to make any such order cancelling the registration of a design as is provided for in Section 51A."

Prior to the Act of 1930 it was only by an application to a High Court and not to the Controller that such rectification could be effected.<sup>12</sup>

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<sup>12</sup> At the time when the amendment of the 1930 Act was made as above stated, the making of the consequential amendment in the marginal note to the section appears to have been overlooked: since in the official Patent Office Handbook this is still worded "Rectification of register by Court." This presumably is in error, since under the current Act it seems clear that a High Court has no jurisdiction to entertain the original hearing of an application for rectification of the Register of Patents and has no jurisdiction to dispose of an application for rectification of the Register of Patents at all (apart from a case where the matter is referred to it by the Controller under Sec. 64(3)), except on appeal from a decision of the Controller.

## **CHAPTER XIII**

### **PROCEDURE RELATING TO EXTENSION OF THE TERM OF A PATENT—PROCEDURE RELATING TO RESTORATION OF A LAPSED PATENT**

#### **PART I EXTENSION**

##### **The Ordinary term.**

The term of the monopoly of a Patent in India was originally fourteen years until the year 1930. By Section 9 of the Indian Act of 1930 the word "sixteen" was substituted for the word "fourteen" in Section 14(1) of the Indian Patents & Designs Act of 1911; and thereby the effective term of a patent in British India was made to be sixteen years; as it is now.<sup>1</sup>

##### **Power of extension : previous English law.**

Originally the only manner in which a Patentee could obtain any extension of the period of fourteen years limited by the Statute of Monopolies for the period of his Patent, was by the obtaining of the passing of a private Act of Parliament. There were several instances in which this was done. The following instances may be mentioned :—Juites Patent for making stone pipes which was on the ground of lack of remuneration extended in favour of an assignee for fourteen years in 1743 by an Act of 16 Geo. II c. 25. Pownoll's Patent for an engine for raising ballast or dredging extended for fourteen years in 1749 by an Act of 23 Geo. II c. 33 on the ground that after the patentee's death his young children had not been able to work it and accordingly there had been a lack of remuneration. Cookworthy's Patent relating to the making of porcelain extended in 1775 by an Act of 15 Geo. III c. 52; Watt's Patent (for steam engines) extended in (1775) by an Act of 15 Geo. III c. 61: Liardet's Patent for cement or stucco for walls

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<sup>1</sup> In England until the year 1919 the term of the currency of the monopoly of a Patent was for fourteen years. By the Act of 1919 Section 17 of the principal act was amended so that the term was made to be a period of sixteen years; as it is now.

extended for lack of remuneration in 1766 for eighteen years by an Act of Geo. III c. 29 : in that case the extension was made subject to the conditions that the Patentee was not to take more than a certain price for the cement, that the patent was not to be transferred to more than five persons, that a new specification of the invention was to be enrolled, that the Act was not to hinder the use of any other cement, and that every objection that the cement was not a new invention sufficient to invalidate the patent was to be a bar to any action brought under the Act. Hartley's Patent for applying iron plates to wooden buildings and ships as a protection against fire, extended for lack of remuneration in 1777 by thirty one years by an Act of 17 Geo. III c. 6 : in that case the prolongation was made on similar conditions to those imposed in Liardet's case and on a further condition that the invention might be applied without license in any buildings used in fitting out or victualling the King's ships of war. Dr. Bancroft's Patent for a process of vegetable dyeing extended in 1785 by fourteen years by an Act of 25 Geo III c. 38 : on the ground that the inventor had lost the benefit of his patent through the American war. Turner's Patent for a yellow ochre for painting coaches, extended in 1792 by eleven years by an Act of 32 Geo. III c. 72 on the ground of lack of remuneration due to secret piracies : in that case the extension was granted upon the following conditions, that the patentee should not sell the patented article at more than five hundred guineas per hundredweight and otherwise on similar conditions to those mentioned in regard to Liardet's extension.<sup>2</sup>

Then by Lord Brougham's Act of 1835 (being 5 & 6 Will 4. c. 83) by Section 4 thereof the Privy Council were given jurisdiction to hear petitions for the prolongation of the term of the monopoly of a patentee and express power was created for the Crown to grant an extension up to seven years ; by granting new letters patent for the invention for a term not exceeding seven years after the expiration of the first term.

The wording of this Section 4 as originally passed which is of interest as follows :—

*“And be it further enacted, that if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall*

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<sup>2</sup> See *Edmunds* at p. 373 *et seq.*

*advertise in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carried on such manufacture or where he lives in case there shall not be any paper published in such town, that he intends to apply to His Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition His Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Council Office ; and if His Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his Counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their Counsel and witnesses ; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to His Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years and His Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any custom, or usage to the contrary in anywise notwithstanding :*

*Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."*

In 1839, by the English Statute of 2 & 3 Vict. c. 67 Section 1, the proviso contained in the last sentence of the said Section 4 was repealed ; since it was found that in some cases parties desirous of obtaining an extension, who might have presented a petition before the expiration of the term, might nevertheless be prevented by causes over which they had no control from prosecuting with

effect their application before the Judicial Committee of the Privy Council.

In 1884, by the English Statute of 7 & 8 Vict. c. 69, under Section 2 thereof further power was created to grant extension in special cases up to fourteen and not merely seven years. The wording of the Section may be of sufficient interest to be here quoted :—

*"And whereas it is expedient for the further encouragement of inventions in the useful arts to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse : be it enacted. That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to Her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by Her Majesty referred to the Judicial Committee of the Privy Council the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to Her Majesty that a further period greater than seven years extension of the said patent term ought to be granted to the petitioner, it shall be lawful for Her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in the like manner, and subject to the same rules as the extension, for a term not exceeding seven years is now granted under the powers of the said Act of the sixth year of the reign of His late Majesty."*

In 1883 by the English Act of 1883 by Section 113 thereof the enactments abovementioned were repealed and the provisions

regarding extensions were set out in Section 25 of the Act of 1883 as follows :—

*"25. (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term ; but such petition must be presented at least six months before the time limited for the expiration of the patent.*

*(2) Any person may enter a caveat, addressed to the registrar of the Council at the Council Office, against the extension.*

*(3) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.*

*(4) The Judicial Committee shall in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such and to all the circumstances of the case.*

*(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen years ; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.*

*(6) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.*

*(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee ; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice."*

It is remarked in Edmunds on Patents<sup>3</sup> that in the Act of 1883

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<sup>3</sup> See at p. 378.

for the first time the term "extension" was used in place of the term "prolongation." At the time when he was writing in the year 1890, it was of some importance for him to observe, that, as the provisions for extension in the Act of 1883 did not come into effect until the year 1898, the law and practice for prolongation of Patents as it had existed before 1883 would continue to be resorted to until 1898 ; and he may be supposed to have emphasised the two different expressions, "prolongation" and "extension" for convenience in referring to the two systems. For present day purposes such distinction appears now to be immaterial.

The principles stated in this Section 25 of the Act of 1883 appear to have been in the main merely declaratory of the principles upon which the Judicial Committee of the Privy Council had in practice acted under the previous Statutes which had been repealed by that Statute. As to those principles, that is to say in regard to the exercise of their jurisdiction for the extension of patents, it has been stated in effect that the Judicial Committee considered themselves as representing the legislature to a certain degree, and that they were invested with somewhat similar powers of discretion to those exercised formerly by Parliament ; that extension had never been granted by them as a matter of course ; that the Judicial Committee as a rule recommended an extension if grounds were established similar to those on which private Acts of Parliament had been passed such as are recited in such old Acts ; that at the same time it had never been their course to put themselves precisely in the position of the legislature ; and that since Lord Brougham's Act had been passed with the view of providing a remedy easier and cheaper than a petition to Parliament, it was the practice of the Judicial Committee to recommend extension in cases in which a private Act of Parliament would never have been obtained, where such cases were meritorious enough as regards the individual, beneficial enough as regards the public and deficient enough as to remuneration to justify an extension.<sup>4</sup>

In 1907 by Section 18 of the English Act of 1907 it was provided that petitions for revocation should be made to the Supreme Court (instead of to the Privy Council) and the power to extend for

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<sup>4</sup> See *Edmunds* at p. 389 and the cases there cited ; where the practice regarding petitions for extension before the Privy Council is fully considered.

a further term, as before, not exceeding seven or, in exceptional cases, fourteen years was given to the Court. It would appear that the Court continued to act on the same principles in granting or refusing extensions as had been acted on previously to 1907 by the Privy Council.

In 1919 amendments were made in Section 18 of the principal Act whereby the maximum periods of extension were reduced from seven to five years or for exceptional cases from fourteen to ten years respectively and the petition was allowed to be presented in the discretion of the Court at any time up till the date of the expiry of the patent. Apart from such minor amendment the provisions regarding extension in the United Kingdom since 1907 have been substantially the same as are current at the present day.

### **Present English Law.**

The relative provisions regarding extension which are operative at the present day in the United Kingdom are contained in Section 18 of the English Patents & Designs Act 1907-1932 which is as follows :—

18. (1) "A patentee may, after advertising in manner provided by rules of Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent :

Provided that the Court may allow such a petition to be presented at such time, not being later than the time limited for the expiration of the patent, as the Court may in its discretion think fit.

(2) Any person may give notice to the Court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(4) The Court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to



the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding five years, or, in exceptional cases, ten years, or may order the grant of a new patent for such term as may be specified in the order and containing any restrictions, conditions, and provisions the Court may think fit.

(6) Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the Court in considering its decision may have regard solely to the loss or damage so suffered by the Patentee :

Provided that this sub-section shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's dominions."

#### **Previous Indian Law.**

In 1859 under Section 4 of Act 15 of 1859 it was provided as follows :—

"4. If, within the space of six calendar months from the date of such order, the petitioner cause a specification of his invention to be filed in manner hereinafter mentioned, the petitioner, his executors, administrators, or assigns, shall be entitled to the sole and exclusive privilege of making, selling and using the said invention in India, and of authorizing others so to do, for the term of fourteen years from the time of filing such specification, and for such further term (if any) not exceeding 14 years from the expiration of the first fourteen years as the Governor-General of India in Council may think fit to direct, upon petition to be presented by such inventor, at any period not more than one year, and not less than six calendar

months, before expiration of the exclusive privilege hereby granted." Thereby provision was made for possible extension up to 14 years by H. E. the Governor-General in Council upon petition duly presented.

In 1888 under Sections 15 & 16 of Act 5 of 1888 it was provided as follows :—

"15. (1) The inventor of a new manufacture may, at any time not more than one year and not less than six months before the time limited for the expiration of an exclusive privilege acquired under Section 8, apply to the Governor-General in Council for an extension of the privilege for a further term.

(2) When an application is made under sub-section (1) the Governor-General in Council may, if he thinks fit, refer it to a High Court for report.

(3) The Court to which the application is referred shall, in making its report, have regard to the nature and merits of the invention in relation to the public, to the profits made by the inventor as such, and to all the circumstances of the case.

(4) The procedure on the reference shall be such as the Court thinks fit, and may include the issue of citations calling upon persons claiming to have any interest in the reference to appear before the Court on the day on which the reference is to be considered, or on any day to which the consideration thereof may be adjourned, and make with respect thereto any representation which they may see fit in relation to any of the matters to which the Court is required by the last foregoing sub-section to have regard in making its report.

(5) If the Governor-General in Council is of opinion or where a reference has been made under sub-section (2), if the Court reports, that the inventor has been inadequately remunerated by his exclusive privilege, the Governor-General in Council may, on a payment of the fee prescribed in that behalf in the fourth schedule make an order extending the term of the privilege for a further term not exceeding seven or, in exceptional cases, fourteen years from the expiration of the first term of fourteen years.

(6) But an exclusive privilege of which the term has been extended under the last foregoing sub-section shall, notwithstanding anything in that sub-section, cease if the inventor fails to pay before

the expiration of each year of such extended term the fee prescribed in the schedule aforesaid in respect of the continuance of the privilege.

16. An order under Section 6, sub-section (1), authorising the filing of a specification, or under Section 15, sub-section (5) extending the term of an exclusive privilege, may be made subject to such conditions as the Governor General in Council thinks expedient."

It is to be observed that there is little difference between the effect of those provisions and the provisions of the current Act now in force.

### **Present Indian Law.**

The current provisions as to extension in British India are contained in Section 15 of the Indian Patents & Designs Act of 1911 as amended by Act 7 of 1930. The later Act restricted the maximum period of extension ordinarily allowable to five years and in exceptional cases ten years where it had been seven and ten respectively under the Act of 1907 : apart from this it merely made a verbal amendment in regard to the provision for advertisement. These provisions are to the following effect :—

"15. (1) A patentee may present a petition to the Governor-General in Council praying that his patent may be extended for a further term ; but such petition must be left at the Patent Office at least six months before the time limited for the expiration of the patent and must be accompanied by the prescribed fee and must be advertised by the patentee within the prescribed time and in the prescribed manner.

(2) Any person may within such time as may be prescribed and on payment of the prescribed fee give notice to the Controller of objection to the extension.

(3) Where a petition is presented under sub-section (1), the Governor-General in Council may, as he thinks fit, dispose of the petition himself or refer it to a High Court for decision.

(4) If the petition be referred to a High Court, then on the hearing of such petition under this section the patentee, and any person who has given notice under sub-section (2) of objection, shall be made parties to the proceeding, and the Controller shall be entitled to appear and be heard.

(5) The Court to which the petition is referred shall, in considering its decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(6) If it appears to the Governor-General in Council, or to the High Court when the petition has been referred to it, that the patentee has been inadequately remunerated by his patent, the Governor-General in Council or the High Court as the case may be, may by order extend the term of the patent for a further term not exceeding five or, in exceptional cases ten years, or may order the grant of a new patent for such term as may be specified in the order and subject to the payment of such fees as may be prescribed and containing any restriction, conditions and provisions which the Governor-General in Council or the High Court, as the case may be, may think fit :

Provided that any patent so extended or granted shall, notwithstanding anything therein, or in this Act, cease if the inventor fails to pay before the expiration of each year the prescribed fee.

### **The Tribunal.**

It is to be observed that the tribunal by whom the Petition will be decided may be either H. E. the Governor-General in Council if he thinks fit to dispose of the petition himself, or a High Court if H. E. the Governor-General in Council thinks fit to refer the petition to a High Court for decision.

### **The Relief.**

The maximum period of extension which such tribunal is empowered to grant is five years, or, in exceptional cases ten years.

It is to be noted that the section (in sub-section 6) also contains a provision to the effect that, alternatively to an extension such tribunal "may order the grant of a new patent for such term as may be specified in the order". In view of this provision it would seem that such tribunal is empowered if it thinks fit to grant a new patent for the full patent period of sixteen years. Such a Patent it may be supposed, will however seldom be granted except for such a term as that for which the old Patent might have been extended.

In making any order for extension, or for a new patent, the tribunal may impose any restrictions, conditions and provisions which it may think fit.

**Discretion.**

No patentee in any circumstances has any legal right to an extension. The grant is now, as it has always been, a matter of discretion and in the nature of an equitable reward. Just as, in the United Kingdom, the Court now acts on the same principles upon which in exercising its jurisdiction under the previous acts the Privy Council acted, which in its turn acted largely upon the principles upon which the private Acts of Parliament originally used to be enacted, so, it is submitted, H. E. the Governor-General in Council in India or the Court will act on the same principles and be guided by the same considerations. The cases of decisions of the Privy Council are therefore still applicable. For the purposes of the present work however it would appear unnecessary to review in detail the cases decided by the Privy Council under the jurisdiction exercised by it under the Acts previous to the English Act of 1907 ; and it will be sufficient if in this chapter reference is made only to a certain Indian decision and certain English cases decided by the Courts in England since the year 1907.

**Grounds in general.**

In the United Kingdom under sub-section 6 of Section 18 of the English Patents Acts of 1907-1932 there is a special provision allowing applications to be made by way of Originating Summons instead of by way of Petition where the application for extension is made on the ground of war-losses. One advantage of such procedure is that, all evidence being on affidavits, time and money is saved. There is however a more vital benefit to patentees who can bring themselves within that part of the section, in that it is, by virtue of the express wording of the sub-section referred to, made unnecessary for them on such applications to establish any other grounds of merit or anything else beyond only the one ground, that "by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention) owing to his having been engaged in work of national importance connected with such hostilities".

It need only be pointed out that there is no provision in the Indian Act corresponding to Section 18(6) of the English Statute. Accordingly the very numerous English cases where application has

been made by Originating Summons on the ground of war-loss are not directly applicable in British India. For the sake of simplicity reference in this chapter has only been made to English cases in which the petition was made otherwise than under the English Section 18(6).

**As to grounds : Comments on Section 15(5).**

It may be noticed that Section 15(5) of the Indian Act is only applicable to cases where there is a "Court to which the petition is referred". From the wording of this sub-section it would follow that where H. E. the Governor-General in Council, not being such a Court, disposes of the Petition himself, he need not in considering his decision have regard to any of the matters mentioned in that sub-section. It can hardly be supposed that this was the meaning of the Legislature ; and in practice it may be assumed that the grounds and matters mentioned in the sub-section would be considered by H. E. in Council if the Petition was dealt with without reference to a High Court. It would rather seem that the words "the Court" have crept into the Indian Act unnoticed being taken from the corresponding passage of the English Act. There would seem no real justification for making any difference between the grounds on which a Petition will be decided if disposed of by H. E. the Governor-General in Council and the grounds upon which the same Petition will be decided if disposed of by a High Court.

On the other hand as pointed out in the recent Indian case of *Indian Casablancas High Draft Coy. v. Millowners' Association of Ahmedabad*<sup>5</sup> it will be for the very reason that the matter involves the taking of evidence and the determination of questions of fact requiring a judicial decision, that H. E. the Governor-General in Council will ordinarily refer a case to a High Court. In the nature of things it will be difficult if not impossible for H. E. the Governor-General in Council to conduct a judicial enquiry such as will involve the taking of evidence. Accordingly in practice it may well be that it will only be in an enquiry conducted by a High Court on a reference that the matters mentioned in sub-section (5) of Section 15 will be fully gone into.

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<sup>5</sup> See (1935) 59. Bom. 564.

**Grounds in particular.**

The grounds mentioned in the Indian Patents & Designs Act itself as those which are to be considered are :—

1. That the patentee has been inadequately remunerated by his patent. It is also stated that regard shall also be had to :—
2. The nature and merits of the invention in relation to the public.
3. The profits made by the patentee as such.
4. All the circumstances of the case.

In considering whether the patentee has been inadequately remunerated it has been the consistent practice in England to take no account of inadequate remuneration which has been due to the default of the patentee or his own neglect in working his patent.

For practical purposes in view of the practice which has been established in decided cases the points to be made out by the patentee may be considered under the following heads :—

1. Merit of the invention.
2. Inadequate remuneration.
3. No laches or default on the part of the patentee causing such inadequate remuneration.
4. Other circumstances : such as :—
  - (a) Special circumstances : *e.g.* : in relation to the manner in which the Patent has been owned and managed ; and in respect of the position as to similar foreign patents.
  - (b) The utmost good faith.
5. Whether the grounds (1 to 4 above) are such that the case is an exceptional case such as to call for an extension of more than 5 years.

As to the grounds to be considered by the tribunal on a Petition for extension the following general observations of Luxmoore J. in a modern case, where the principles are very well put, is of interest :—

“In exercising the discretion which is given to the Court by the Section it is plain that there are three things which have to be considered before any extension at all is granted. The three matters which have to be considered are, the nature and merits of the

invention in relation to the public, the profits made by the patentee, and all the circumstances of the case. If after consideration of those three heads the Court comes to the conclusion that an extension should be granted, then, if the extension is to be for a period in excess of five years the Court has to consider other matters. It has to consider whether the case is an exceptional one or not; and in this respect, of course, it must be borne in mind that in the ordinary case where an extension is granted that is itself an exceptional case."

### Merit of the invention.

The merit to be established comprises to some extent both a degree of utility in the invention and a degree of ingenuity exercised by the patentee. It is obvious that the mere degree of utility necessary to support a patent, that is to say to save a patent from being held invalid for want of utility, is not sufficient to support a petition for extension of that patent. For the latter purpose an exceptional degree of utility is required to be established in order to establish exceptional merit such as is not possessed by the ordinary run of patents. As to the element of ingenuity, it is hardly possible to lay down any general rule or principle or to say more than that this is one of the elements which may in some cases be considered in weighing whether or not there is a sufficient degree of merit in the invention to warrant an extension of the Patent. As an instance where the ingenuity and brain-work of the Patentee was given considerable weight by the Court in arriving at a conclusion that the invention was a meritorious one, reference may be made to the case of *Perry and Brown's Patents* (cited below). But it is to be observed that in that case there was also great utility to the public. As was said in one case by Sargant J. in words since often quoted with approval:—"the Court has to find as a condition precedent to its exercising its discretion in favour of the patentee, that there has been some considerable benefit given to the public by the inventor in respect of (the) invention. The Patent must be one of more than ordinary merit and utility, and, of the two, it appears to me, having regard to the words "in relation to the public", that the utility is an even more important factor than the inventiveness or skill shown in making the invention."<sup>6</sup>

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\* See *Trantom's Patent* (1917) 34. R. P. C. 28 at p. 37.



It is obvious that the importance to the public of an invention will often bear no proportion at all to the ingenuity or lack of ingenuity shown by the inventor in achieving the invention. Again as has been pointed out in other cases a predominantly important invention may depend upon a minute inventive step which may yet be vital.

It has been held in one case that the apparent simplicity of an invention may enhance rather than diminish its merit.<sup>7</sup>

It has been stated that there must be some character of public interest established in the patent. On this principle patents which lead to an improvement relating to public health, safety or comfort are in a favourable position when renewal is sought.<sup>8</sup>

### The Position of an assignee as to merit.

Apart from any question of procedure as to the necessity or not of having the original patentee a party to the application for extension, and apart from any question of inadequacy of remuneration, to both of which matter reference will be made hereafter, there have been in England somewhat conflicting decisions on the point whether or not an assignee of a patent should be considered to be in as favourable a position as an original grantee of a patent when applying for extension.

It would appear that the modern view at least (like that which is stated in *Fletcher Moulton* at p. 313 to have been the earlier view, before the tide turned against assignee-applicants) is that an application for extension by a patentee who is an assignee is treated in regard to the question of merit on the same footing substantially as an application for extension by a patentee who is the original grantee.<sup>9</sup>

<sup>7</sup> See *Stoney's Patent* (1888) 5. R. P. C. 313 at p. 522.

<sup>8</sup> See eg *Perry & Brown's Patents* (1931) 48. R. P. C. 200 at p. 213 relating to Gyro-compasses for navigation. *Bischof's Patent* for purification of water, (1884) 1. R. P. C. 162; *Shone's Patent*, relating to drainage (1892) 9. R. P. C. 438; *Lyon's Patent* for a disinfectant (1894) 11. R. P. C. 537; *Currie & Timmis Patent* for railway signals (1898) 15. R. P. C. 63 (P. C.); see *Fletcher Moulton* at p. 306 and other cases there cited.

<sup>9</sup> See also *Terrell* (8th edn. 1934) p. 298, *Fletcher Moulton* p. 313: but as to inadequacy of remuneration to an assignee see further at p. 514 below.

There is one good reason why it is desirable that this should be the principle to be adopted : that it is for the benefit both of the inventor and of the public that there should be the prospect of a proper reward for those persons who had assisted the inventor to develop the new manufacture.

It might also become impossible for a Patentee to deal commercially with his patent in any effective or profitable manner towards the end of its life, if, though it should be a patent of outstanding merit, yet an assignee were to be regarded as having no prospect of obtaining an extension for it. It will be remembered that in some cases it is impossible, by reason of the nature of the patented article, for a patentee to expect to obtain any adequate remuneration within sixteen years. Such cases arise for example where the patent is in relation to ships or machinery which wear out but slowly and where replacements owing to the nature of existing conditions can be made only at long intervals of time. In all such cases it is apparent that great hardship might be inflicted on a patentee if his assignee had no chance of obtaining an extension for the patent in question.

It is to be noted further that the person referred to in Section 15 throughout is "the patentee." In view of the definition of a patentee as "the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent", which has been embodied in Section 2(12) of the Indian Patents & Designs Act since 1930, and in view of the corresponding definition in England under Section 93 of the English Patents & Designs Acts 1907-1932 which has been effective since the year 1919 it would seem even the more unreasonable now to adopt for the administration of Section 15 any other principle than the one submitted above as to the equal standing of an assignee with that of a grantee in an application for extension.

#### **Inadequate remuneration.**

It is of course difficult to lay down any principle as to what will and what will not be considered to be inadequate remuneration.

In many of the reported Petitions for extension which have succeeded the Petitioner has been able to show that great expense either in conducting experiments or in perfecting the invention or in setting up machinery or factories specially for the invention in

question have been incurred and as against such expenditure the profits have shown a definite loss : in other cases while there has been no loss, that the profits when reckoned against such expenditure have not shown any adequate remuneration.

It has been held in the recent Indian case already cited<sup>10</sup> that in considering the question of the remuneration which has been enjoyed by the Patentee regard must be had not only to remuneration received by him in British India but also to any remuneration received by him abroad (in all countries where the invention was registered or exploited). See the following passage in the judgment of Kania J. on this point :—

“The decisions in *In re Bower-Barff Patent* and *In re Adair's Patent*<sup>11</sup> suggest that when an extension of a patent is asked for, it would be legitimate for the Court to inquire what profits the inventor had made since its registration, and that inquiry may not be limited to what the inventor earned in his country but might include profits made by him in all countries where the invention was registered or exploited. It further appears that in such case the Court insists on a full disclosure of the profits made by the inventor or his assignees, and when the Court believes that there has not been a full or *bona fide* disclosure, the Court may summarily reject the application.....”

#### **Inadequacy of remuneration : whose remuneration is the criterion ?**

In many if not most cases it will have happened that the Patent will have changed hands during its life. In such cases questions will arise as to the relative importance of the various amounts of remuneration obtained by the various persons who have owned the Patent from time to time. The question is, when a Petition for extension is put forward by an assignee, whether his remuneration alone is the important criterion, or the original Patentee's remuneration or the total remuneration of both or the total remuneration of all persons who have owned the patent in sequence, that is to say the remuneration earned by the Patent itself irrespective of the persons benefited, or what.

In this respect it has been clearly decided in England by Luxmoore J. in the case of *In the Matter of Patents of Maschinenfa-*

<sup>10</sup> *The Indian Casablancas High Draft Company v. The Millowners' Association of Ahmedabad* (1935) 59 Bom. 564 or 37 Bom. L. R. 187.

<sup>11</sup> 1895. A.C. 675 ; and 1881. 6. App. Cas 176 respectively.

*brik Augsberg-Nurmberg A. G.*<sup>12</sup> that it is insufficient to consider the profit made by the assignee; you must consider the profits made by the patentee as such; and that this includes the profits made by the original patentee and all subsequent holders.

The passage containing the material observations which is of interest may be noted :

"It becomes necessary to consider the second point, namely, the question of the Patentee's remuneration. In this connection it is necessary to bear in mind that the Petitioners are the assignees of the Patent and are sub-licensees. When the Privy Council dealt with the question of extension it was difficult for an assignee of a patent to obtain any extension at all. But the practice is I think less stringent today. The assignee, however, is always treated as being of less merit than the original inventor,<sup>13</sup> but it has been recognised that unless an assignee can in a proper case get an extension you are in fact putting a fetter in the way of the inventor. I think the authorities are unanimous that in all extension cases an important matter for consideration is the position of the inventor of the original patent. The position is I think explained in *Hopkinson's Patent* (1897) 14. R. P. C. 5 at page 9. Lord Hobhouse who delivered the decision of the Board, says this: "The claims of assignees were the subject of consideration in the case of *Claridge's Patent*, which was decided in the year 1851. The judgment of the Board was delivered by Sir J. Jervis. He pointed out that assignees, though their right to petition was recognised, were not to be treated with the same indulgence as patentees. In that case, Claridge the inventor, had received ample satisfaction. The Company, his assignees, had entered into a commercial speculation, and their loss was not a ground for prolongation of the patent." Now, what is the position here? The Petitioners bought these Patents towards the end of their existence for a sum £800. They spent considerable money in exploiting them and have not in fact made any profit on their purchase. But it is not sufficient to consider the profit made by the assignee; you must consider the profits made by the Patentee

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<sup>12</sup> (1930) 47. R. P. C. 193 at p. 212.

<sup>13</sup> It is submitted that this means only that in so far as it is the individual position of either which is considered it is that of the original inventor which is given more weight.

as such. This includes the profits made by the original patentee and all subsequent holders. In the present case the original holder was the M. A. N. and the M. A. N. in fact made no profit out of the Patents in suit beyond the share of the purchase consideration and the share of the royalties paid on gas holders erected under the licence. There is no evidence before me as to the amount of these profits and this may well be a serious objection to the Petition."

**Laches or default.**

An extension will not be obtainable even if there has been inadequate remuneration if this has been caused by the neglect or default of the Petitioner himself. It seems also that an extension may similarly be refused where the inadequate remuneration has been caused by the neglect or default of a person other than the Petitioner himself at a time when such person was the Patentee.

**Other circumstances : foreign patents.**

In considering the question of inadequacy of remuneration the amount of remuneration obtained by the Patentee from foreign patents for the same invention may be taken into account as a reason not to grant an extension. See the remarks above.

**Other circumstances : good faith.**

Since the exercise of the tribunal of its power to grant or refuse an extension is a matter of discretion, and since it is more often than not impossible for the Tribunal to investigate the truth or untruth of the statements made by the Petitioner as grounds for his application for extension, it has been always recognised and emphasised that it is essential that in putting forward such Petition the Petitioner is bound to exercise the utmost good faith. He must state without concealment or distortion or inaccuracy all material facts relating to the circumstances in which he is asking for an extension. If it is found that he has not fulfilled his obligations in regard to such a duty, this will be treated as a bar to his obtaining any extension.

**Exceptional extension.**

As was observed by Luxmoore J. *In the Matter of Perry & Brown's Patents*<sup>14</sup> every case in which an extension at all is granted

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<sup>14</sup> (1931) 48. R. P. C. 200.

is an exceptional case. For a case therefore to be a proper case for more than five years extension, such a case must be in an appreciable degree even more exceptional still. The following extracts from the observations of the learned Judge in his judgment in that case put the whole matter very clearly :—

“In exercising the discretion which is given to the Court by the Section it is plain that there are three things which have to be considered before any extension at all is granted. The three matters which have to be considered are, the nature and merits of the invention in relation to the public, the profits made by the patentee, and all the circumstances of the case. If after consideration of those three heads the Court comes to the conclusion that an extension should be granted, then, if the extension is to be for a period in excess of five years, the Court has to consider other matters. It has to consider whether the case is an exceptional one or not ; and in this respect, of course, it must be borne in mind that in the ordinary case where an extension is granted that is itself an exceptional case.

Let me consider, first, the three requirements which the Statute has laid down for consideration, first of all, the nature and merit of the invention in relation to the public. Both the inventions in this case are of the highest ingenuity. They relate to a most recondite subject matter. Both inventions, I think, are only possible to a highly trained engineer, physicist, or mathematician. Obviously the nature of the inventions is one only possible to a man of exceptional capacity. The inventions have only to be explained for their merit to be self-evident. Their value from the public point of view is obvious. Anything which makes navigation easier and safer must be of the greatest importance to the public. I have no doubt whatever that the first condition is amply fulfilled.

Then the second condition is with regard to the profits made by the Patentee as such. In some respects the accounts which have been put before the Court are not as satisfactory as they might be, or such as the Court might possibly require in an ordinary case. No separate accounts in respect of this Patent, or the working of this Patent, have, in fact, been kept, but the accounts of the business in which the Patentee has been interested have been properly kept during the whole of the time, and accountants have been employed to prepare the necessary accounts to show what has been expended and

what has been received in respect of these particular Patents. Those accounts have been submitted to the Comptroller, who in turn has employed skilled accountants to consider the whole matter ; and there is no doubt whatever from the accounts which have been kept that the Court is in a position to say without any doubt whatever that, not only has the inventor not been adequately remunerated, but he has, in fact, made a substantial loss. Whether the loss is £18,000 or £13,000 does not seem to matter. It is not like the ordinary case where there has been some remuneration to the Patentee, but he is unable to satisfy the Court how much that remuneration is. In the present case there is no doubt whatever that there has been a loss, and I do not think in the circumstances that this case comes within any of the decisions with regard to the failure to keep proper accounts, or to satisfy the Court with regard to remuneration at all. In my view, the Petitioner has amply satisfied me that he has made a loss and a *fortiori* that he has been inadequately remunerated in respect of his invention.

I do not think there is any other particular circumstance I have to consider in the present case. There is certainly nothing in the general circumstances of the case to prevent me from saying that this is a case in which an extension ought to be granted.

In those circumstances, and having come to the conclusion that there should be an extension, the question is : What is the amount of that extension ? Is it to be limited to the five years which are mentioned in sub-section (5), or is this one of the exceptional cases in which I am at liberty to grant up to ten years extension ?

As has been said in many of the cases, it would be most unwise to lay down any general rule with regard to what is an exceptional case. All these matters are matters of discretion, but there is no doubt whatever that the merit of the invention is one of the main considerations which the Court has to take into account. I think that it is probably right to say that the exceptional cases may fall into three main classes : first of all, if the Court is satisfied that the invention is of exceptionally inventive ingenuity and also satisfies the condition that it is useful to the public. That, of course, is with regard to the exceptional character of the invention itself. I have little doubt that both the inventions in the present case fall

within that head. The second head, I think, is, if the invention has sufficient merit to warrant an extension, and is also of exceptional benefit to the public. Here again I have no doubt that the benefit to the public in a case of this kind is undoubtedly exceptional.

The third head is : if, upon a review of the whole of the circumstances of the case, it appears that the invention is inherently of such a character that it must take longer than usual to get it on the market. This may be referred to as the business element. You must consider the class from which the purchasers are to be drawn. I think you must consider the amount of loss which has been made, and the period during which that loss has been made, and how long it is likely to take before that loss is wiped out and a proper remuneration earned by the inventor for his particular invention. In my view, both these inventions fall within the third class as well. Quite obviously gyro-compasses are expensive to make, and the class requiring to buy them must necessarily be limited. It must also necessarily take a long time to establish the invention. The loss at any rate up to the present time, is something like £13,000 and that has occurred over a period of some 16 years. It is not likely that loss will be wiped out and a remuneration adequate to the skill of the invention be received unless the term is extended for a considerable time. This is not like an ordinary article which, when once it is introduced to the public, the public wants generally to possess and to purchase. This is much more like the sluice gates, the sanitary sewage patents, and the electric signalling system which have been referred to in the cases ; only, to my mind, the present case justifies an extension more clearly than the facts did in those cases. I have little doubt that as regards both these Patents the case is an exceptional one within the meaning of subsection (5), and I think that the proper extension to grant in both these cases is the full term of the ten years."

In that case there being two Patents for which extension had been asked, and the first Patent having expired prior to the date of the judgment, the Court made a re-grant of that Patent for 10 years from the date of expiration on what were referred to as "the usual terms", that is to say the *British Thomson-Houston* terms.<sup>15</sup> In the case of the second Patent, that not having then expired, an

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<sup>15</sup> See (1929) 46. R. P. C. 367 at p. 377.



extension of that Patent was granted for 10 years from the date on which it would expire.

**Prudence : necessity for foresight and separate accounts.**

From what has already been said it is clear that it will make a very great difference, at the time when a Petition for Extension has to be prepared, whether or not the earlier accounts in relation to the patent throughout its life have been properly, carefully, and separately kept. For this reason it is advisable for a Patentee from the outset to make a point of keeping carefully such separate accounts in relation to every separate Patent. Even if he will not eventually be the person who will be the Petitioner on a petition for extension, yet it is apparent that everything he neglects to do which would increase the chances of an assignee from him in obtaining an extension, will tend to the devaluation of his Patent should he desire to assign it. He will therefore be the more likely to obtain a good price for his Patent in the event of an assignment, if he can at that time hand over to the assignee such clear accounts relating to the remuneration received by him up to the date of such assignment, as will make it the easier for such assignee to obtain in due time an extension if required.

**Procedure in relation to the Petition.**

Under the Indian Patents & Designs Rules 1933 provision is made regulating the procedure relating to the filing and advertising of the Petition and to the filing of a notice of opposition by an opponent and of such matters. Provision is also made regarding the procedure relating to the forwarding of the Petition to H. E. the Governor-General in Council by the Controller. Though the wording of Section 15 of the Act of 1911 merely refers to a Patentee "presenting a petition to the Governor-General in Council, and though the wording of Rule 25 of the 1933 Rules does not appear anywhere to state that the Petition will be filed in the first place at the Patent Office to be forwarded eventually to H. E. the Governor-General in Council, it is clear from various provisions in Rule 25 that it is intended to direct that the Petition is to be filed in the first place with the Controller.

Rule 25 which may for convenience be here noted is as follows :—

"25. (1) A petition for the extension of the term of a patent

shall set forth clearly the nature and merits of the invention in relation to the public, the profits made by the patentee as such and all the circumstances of the case.

(2) The Controller shall advertise every such petition in the Gazette of India.

(3) Every such advertisement shall state the object of the petition and the address within British India for service under this rule. It shall also specify that notices of objections shall be lodged on Form 6 within two months from the date of the notification.

(4) Every such petition shall also be advertised by the patentee, in not less than two newspapers named by the Controller, within 14 days from the date of the notification in the Gazette and in the manner described in sub-rule (3). Copies of the newspapers containing these advertisements shall be supplied to the Controller.

(5) The petitioner shall, within three weeks of filing the petition, lodge a duplicate of the petition with two copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts shall be proved on oath. He shall also, upon receiving two days' notice, give the Controller or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of accounts, by reference to which he proposes to verify the said balance sheet or from which the materials for making up the said balance sheet have been derived.

(6) Any person desirous of opposing the prayer of the petition shall lodge with the Controller a notice on Form 6 accompanied by a fee of Rs. 5/-. Such person shall at the same time serve a copy of such notice upon the petitioner. Such notices shall be lodged and served within two months from the date of the notification of the petition in the Gazette of India.

(7) The petitioner shall, within one week of the receipt of such notice, serve a copy of his petition upon each person giving such notice.

(8) Every person giving such notice as aforesaid shall, within 14 days from the service of the petition upon him, serve upon the petitioner one copy and lodge with the Controller two copies of

particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.

(9) Any person who shall not, within the said 14 days, lodge and serve such particulars of objections as aforesaid shall be deemed to have abandoned his opposition.

(10) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

(11) Any person who has delivered particulars of objections shall be entitled at his own expense, to obtain copies of the accounts which have been lodged by the petitioner.

(12) The Controller may excuse petitioners and opponents from compliance with any of the requirements of sub-rules (5), (7), (8) and (10) and may give such directions in matters of procedure and practice as he shall consider to be just and expedient.

(13) Service of any document requiring service under this rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.

(14) On completion of these proceedings, if any, or at such other time as he may see fit, the Controller shall forward one copy of the documents left by the party or parties to the Governor-General in Council through the Secretary in the Department of Industries and Labour."

The two material forms for application for extension and for opposition to extension are set out in the Second Schedule to the Indian Patents & Designs Act of 1911 being Form No. 9 and Form No. 6 respectively : which may for convenience be noted here :—

#### FORM No. 9.

Petition for extension of term of Patent. Section 15.

In the matter of Patent No.....dated.....  
 .....and granted to.....  
 for an invention for.....  
 .....

and

In the matter of Section 15 of the Indian Patents and Designs Act, 1911.

To His Excellency the Governor-General in Council.

The humble petition of.....

.....

Sheweth as follows :—

On the                      day of                      letters patent numbered  
were granted to.....  
for an invention for.....

That the facts and matters stated herein are true to the best of  
your petitioner's knowledge, information and belief.

Your petitioner(s) therefore humbly prays that the said letters  
patent may be extended for a further term of                      years, or for  
such other term as the Governor-General in Council shall deem fit.

Dated this                      day of                      19

(Signed).....

Petitioner

"The note given in the official Patent Office Handbook in  
regard to the matters which should be contained in the body of the  
form after the words "for an invention for" is as follows :—

Note. (1) Here set forth (a) the circumstances under which  
the petitioner obtained rights in the patent ; (b) the history of the  
art with special reference to the invention and subsequent improve-  
ment ; (c) the special utility and advantages of the invention in  
relation to the public ; (d) all information relating to foreign  
patents ; (e) the rights of third parties, such as licenses, etc. ; (f) the  
difficulties with which the patentee has had to contend in introduc-  
ing into British India the manufacture according to his invention ;  
(g) statement regarding the inadequacy of remuneration.

(2) The continuation of the petition should be upon paper of  
the same size on one side only, with a margin of 1½ inches on the  
paper."

## FORM No. 6.

Notice of opposition. Section 15, or Rules 25.....

(To be supplied in duplicate)

I (or we)

hereby give notice of my (or our) intention to oppose :—

.....  
Under Rule 25 the petition for extension of term of Patent No.....  
.....

The grounds of opposition are as follows :—

.....  
.....  
I (or we) declare that the facts and matters stated herein are true to the best of my (or our) knowledge, information and belief.

My (or our) address for service in British India is as follows :

.....  
.....  
Dated this                      day of                      19

(Signed).....

To

The Controller of Patents and Designs  
1, Council House Street, Calcutta.

The fee payable to the Patent Office for an application (on Form No. 9) for extension is Rs. 50/-

The fee payable to the Patent Office for an opposition thereto (on Form No. 6) is Rs. 5/-

There are no provisions in the Rules relating to the procedure in disposing of the Petition after it has been forwarded to H. E. the Governor-General in Council.

As already observed H. E. the Governor-General in Council may decide to dispose of the Petition himself or refer it for decision to a High Court. In the former case it may be assumed that any directions as to the mode of hearing or disposal of the Petition will require to be applied for through the Department of Industries & Labour. In the latter case the matter will presumably be dealt with by that High Court to whom it is referred, as a Motion, and under the ordinary civil practice of that particular Court in hearing and disposing of motions.

**Extension of Patent of Addition.**

It has been held in England that the Court has power to extend a Patent of Addition just as any ordinary Patent.<sup>16</sup>

**Who may apply for an extension of a Patent.**

From the terms of Sec. 15 it seems clear that no one but the Patentee may apply for an extension. Thus it will not be open to a licensee to make such an application.<sup>17</sup>

**Necessary Parties to the Petition.**

It has been held in England that the original grantee of the Patent is ordinarily required to be a party : but that this may be dispensed with. Though that was a case under the Originating Summons procedure under sub-section (6) of the English Act it is submitted that as to parties, the principle will also apply to the Petition procedure ; and that the same principle will be applicable in British India.<sup>18</sup>

**Proof of inadequacy of remuneration.**

It will be necessary to embody in the Petition or file with it as a Schedule a comprehensive and full statement of accounts from which the extent of the remuneration obtained and its inadequacy is to appear. In this respect it will be important that the statement of accounts shows the whole sequence of accounts throughout the life of the patent and the sequence of the various amounts of remuneration obtained by the various persons who have been patentees since the original grant.<sup>19</sup>

**If the Patent has expired before date when order for extension is to be made.**

It may happen that the Patent in respect of which extension is asked for has expired before the disposal of the Petition. In such a case the Court has power, under the section, to order a fresh grant. But it should be noted that in such cases in the order for such fresh grant there are usually imposed on the patentee certain conditions similar to those embodied in the order in the case of

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<sup>16</sup> See *In the matter of the Patents of Maschinenfabrik Augsburg-Nurnberg A.-G.* (1930) 47. R.P.C. 193 at p. 209.

<sup>17</sup> For the definition of a Patentee see Sec. 2(12)4.

<sup>18</sup> See *Dressler's Patents* (1929) 46. R.P.C. 165.

<sup>19</sup> See also the observations under the heading "Inadequacy of remuneration : whose remuneration is the criterion ?" at page 514 above.

*British Thomson Houston* (1929) 46. R. P. C. 367 which were followed for example in the more recent case of *In the matter of Perry & Brown's Patents* (1931) 48. R. P. C. 200 at p. 215. The order in the *British Thomson Houston* case as to its material parts as reported in the official report was as follows :—

“And the applicants by their Counsel undertaking to use their best endeavours to procure the registration of such of the licences granted under the above-mentioned Letters Patent as are applicable to the new Letters Patent hereinafter ordered to be granted and of any licences which may be granted under the said new Letters Patent. This Court doth order that new Letters Patent in respect of the matters comprised in the above-mentioned Letters Patent for a term of two years from the expiry of the above-mentioned Letters Patent No. 10918 of 1913 be granted to the Applicants subject to a proviso that no action or other proceeding shall be commenced or prosecuted and no damage shall be recovered (1) In respect of any infringement of the said new Letters Patent which shall have taken place after the expiry of the above-mentioned Letters Patent and before the date of this Order (2) In respect of the use or employment at any time after the date of this Order of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase or sale of any article manufactured or made in infringement of the said new Letters Patent after the expiry of the above-mentioned Letters Patent and before the date of this Order provided that such use, purchase, sale or employment is by the person or corporation by or for whom such machine or machinery process or operation was *bona fide* made or carried on or by his or her executors, administrators, successors or vendees or his or their assigns respectively (3) In respect of the use, employment or sale at any time after the date of this Order by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process or operation, of any improved or additional machine, machinery, mechanism, process or operation, or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the said new Letters Patent ; provided that the use or employment of any such improvement or additional machine, machinery, mechanism, process or operation shall be limited to the buildings, works or premises existing at the time being or afterwards

erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph his or their executors, administrators, successors or assigns”.

See also *In the Matter of Horstmann, Horstmann and Edgar's Patent* (1929) 46. R. P. C. 1 : the latter was a case where the application was made under the Originating Summons procedure peculiar to England but on this point it is submitted the case will be applicable. In this case various conditions were imposed on the patentee on the basis that the patent having expired was required to be restored and, as it was thus being restored, all conditions usual in a case of restoration were to be imposed.

It may be noted that in England the position where a patent had expired and there was a re-grant (or restoration) was at the date of the last-mentioned case regulated by Rule 62 of the English Rules of 1920 which corresponds verbatim to Rule 65 of the present English Rules of 1932 and which corresponds to some extent but only partially to Rule 28 of the Indian Rules of 1933.

**Procedure at the hearing in a High Court of a Petition for extension referred by H. E. the Governor-General in Council under Section 15(3).**

It has been held in the recent case already cited, in the Bombay High Court, that the ordinary rules of procedure followed by the High Court, devoid of its technicalities, will be adopted on the hearing of a Petition for extension of the term of a Patent. See the judgment of Kania J. in *The Indian Casablanca High Draft Coy. v. The Millowners' Association of Ahmedabad* during the course of which the learned judge observed as follows<sup>20</sup> :—

“This is the first case which has been referred to this Court under the Act and under the circumstances there is obviously no precedent on the point. The reason for referring the petition to the High Court appears to be that the matter involves taking of evidence and determination of questions of fact and which requires a judicial decision. Section 15(4) of the Act provides that if the petition be referred to the High Court the patentee and the objectors shall be made parties to the proceeding and the Controller shall be

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<sup>20</sup> (1935) 59. Bom. 564 at p. 568.



entitled to appear and be heard. It, therefore, appears that on a reference to the High Court by the Governor-General in Council the matter ceases to be merely administrative and becomes a judicial proceeding ; the parties to the proceeding being the patentee on the one hand and the objectors on the other and the Controller has also the right of audience. In the High Court Rules no procedure is separately prescribed for the hearing of such a petition, and, in the absence of such provision, I think, the ordinary rules of procedure followed by the High Court, devoid of its technicalities, should be adopted so far as the same are applicable to the particular case.”...

#### **The Court adjudicates on the same Petition.**

It has been held that when a case is referred to the High Court for decision under Section 15(3), it is not necessary for a fresh Petition or fresh pleadings by the Objectors to be filed, but that the Court may adjudicate upon the same Petition originally submitted to H. E. the Governor-General in Council. See the observations of Kania J. in the case above cited.

#### **Amendment of grounds of objection.**

It was held in the same case that the Objectors might add to the objections submitted to H. E. the Governor-General in Council by way of amendment of those objections preliminary to the hearing in the High Court ; and in effect that in the High Court the matter was governed by the ordinary law relating to the amendment of pleadings.

#### **Appeal.**

The Section (Section 15) does not expressly create or mention any right of appeal. In cases which are disposed of by H. E. the Governor-General in Council there will be no appeal from his decision. In cases which are referred by H. E. the Governor-General in Council to a High Court for decision an appeal will lie, it is submitted, under the Civil Procedure Code to the appropriate Appellate Bench of such High Court.<sup>21</sup>

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<sup>21</sup> In England under the present Act (1907-1932) a decision by the special Judge, being “such Judge of the High Court as the Lord Chancellor may select for the purpose”, is not appealable : in view of the express provisions of Section 92 (2) of English Acts 1907-1932. See also *Terrell* p. 293 and the case there cited.

## PART II

### RESTORATION OF A LAPSED PATENT

#### Previous remedy available.

Originally the only procedure available in England for the restoration of a lapsed Patent was to obtain a Private Act of Parliament.<sup>22</sup>

#### The statutory remedy now available in British India.

The current Indian Act of 1911 now contains express provision for the restoration in certain circumstances of a Patent which has lapsed owing to the non-payment of fees. These provisions are contained in Section 16 which is as follows :—

“16(1) Where any patent has ceased owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Controller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional or unavoidable and that no undue delay has occurred in the making of the application, the Controller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Controller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Controller shall hear the case and subject to an appeal to the Governor-General in Council, issue an order either restoring the patent subject to any conditions and restrictions deemed to be advisable or dismissing the application.

Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for

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<sup>22</sup> See *Romer, Practice before the Comptroller of Patents* (1911 edn.) p. 102.

the protection of persons who may have availed themselves of the subject-matter of the Patent after the patent had ceased."

The matter, together with the procedure to be followed as to advertisement and notice of opposition, is also regulated by Rules 26 to 28 of the 1933 Rules which are as follows :—

"26. If the Controller entertains an application under Section 16 of the Act for the restoration of a lapsed patent, he shall advertise it in the Gazette of India."

"27. Notice of opposition to the restoration may be given within six weeks of the advertisement, and the procedure for the disposal of such opposition shall be regulated by the provisions of rules 20, 21 and 22."

"28. In every order restoring a lapsed patent, it shall be provided that the continuance of the patent shall be subject to any directions given by the Controller in respect of any application by any person who availed himself of the subject matter of the patent any time during the period from the date of the lapsing of the patent to the date of the order of restoration."

#### **The tribunal.**

The tribunal before whom the application is made and by whom it is decided is the Controller.

#### **The grounds.**

The grounds necessary to be established sufficiently appear for practical purposes from the section itself : the omission must have been "unintentional or unavoidable".

#### **The relief.**

The Controller after hearing the application may either make an order dismissing the application or an order for restoration subject to the conditions prescribed under Rule 28 of the Indian 1933 Rules : or he may make such an order for restoration but subject to such further conditions and restrictions deemed by him to be advisable.

The provisions for the protection of persons who may have availed themselves of the subject matter of the patent after the patent had ceased which are referred to under sub-section (5) of Section 16 of the Indian Act and which are thereby made obligatory

in every case where an order for restoration is made can only mean those which are contained in Rule 28 of the Indian 1933 Rules. But when this Rule 28 is looked at, it will be seen that nothing specific is laid down beyond "any directions given by the Controller" in respect of any application by any person who availed himself of the subject matter of the patent at any time during the period from the date of the lapsing of the patent to the date of the order of restorations. Thus it follows that in a case where there is no application by such a person as is mentioned, no directions would be given by the Controller such as would be made obligatory to be embodied in an order for restoration by reason of Section 16(5); and even in cases where an application by such a person has been made, if the Controller should happen on such application to see fit to give no directions, then, also, nothing would be obligatory to be embodied in the order for restoration. Thus the effect of the Indian Section 16(5) is that nothing need be embodied compulsorily, in the order of restoration except those directions referred to above, if any. In this respect it is to be noted that the Indian provisions differ from the English provisions, which are contained in Section 20 of the English Patents & Designs Acts 1907-1932 and the English Patents Rules 1932, Nos. 61 to 66 and in particular Rule 65 thereof: as a result of which certain provisions for the protection of persons who may have availed themselves of the subject matter of the Patent after the Patent has been announced as void in the Journal, must in every case in which an order for restoration is made be inserted in such order: that is to say whether or not there has actually been any separate application by any one of such class of persons and whether or not the Controller has given any directions on any such separate application.

**Unintentional or unavoidable : undue delay.**

Restoration under the Indian Act may be asked for if the non-payment of the fee was either unintentional or unavoidable.<sup>23</sup>

As to the effect of the word "unintentional", if the non-payment of the fee is intentional, and assuming that it was not possible to show that it was unavoidable, then no matter what were the reasons of the Patentee, the Controller will not have power to order

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<sup>23</sup> The corresponding section of the English Statute does not contain the words "or unavoidable".

restoration. See the decision of the Comptroller in the *Ruth Aldos Company (Inc.)* case<sup>24</sup> which was confirmed by Luxmoore J. on appeal. In the course of that decision the Comptroller made the following observations :—

“In interpreting Section 20, one must bear in mind the decision given by the late Lord Parker (then Mr. Justice Parker) in the matter of *Land's Patent* (1910) (27 R.P.C. page 481). In that case, in which the application for (an) Order for restoration was refused. Mr. Justice Parker said, (page 483, line 33) “It is quite clear that the omission of the payment of the fee is the omission which is referred to in sub-section 3, and the Section only applies if the omission to pay the fee was unintentional. In order that an omission to pay a fee should be intentional, it is only necessary that it should be present to the mind of the person who has to pay the fee, that the fee is payable and that he should deliberately elect not to pay it. His reasons for that election are it appears to me absolutely immaterial. In the present case the Petitioner knew that a certain fee was payable, and under circumstances which he explains in his Declaration, he did deliberately elect not to pay. His reasons for making that election he also gives, and it appears he was under an erroneous notion as to the law. He thought that having applied for Letters Patent for an improvement in the machine protected by the original Letters Patent and having paid the fee in respect of such application, it was not necessary for him to protect or keep up in any way, the original Patent. He thought that he could rely upon the Patent for the improvement as protecting the original Patent and in that erroneous belief, he deliberately elected not to pay the fee. If I were to say that that omission to pay the fee was unintentional within the meaning of this Section, it is difficult to say where one could possibly draw the line in giving the relief for which the Section provides, for in every case, if a man deliberately elected not to pay the fee, I should have to consider what his reasons were, and if his reasons were bad, in other words, if he were a man of no common sense, I might have to give relief, whereas, if he was a man of common sense, I might have to refuse relief. The truth is that the Section only provides for one of a series of cases in which, prior to the passing of this Act, Parliament used to give

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<sup>24</sup> (1933) 50. R.P.C. 409.

relief to patentees, that is the narrow case of unintentionally omitting to pay the fee. It does not provide for the case where the man deliberately elects not to pay the fee under an erroneous supposition, which influences his conduct, and with which, under this Section, it appears to me, the Court has nothing to do. I do not therefore see my way to interfere with the decision of the Comptroller."

Applying that decision to this case, it is quite clear that the Patentees intended not to pay the fee on Patent No. 282,791. I accept their statement that it was never their intention that the Patent of Addition No. 309,099 should be allowed to lapse, but while I have the greatest sympathy with them in their difficulty, I am unable to agree that I have any power to restore the Patent of Addition by itself. It is quite clear that I cannot restore Patent No. 282,791, since on their own showing, the omission to pay, the fee in that case was clearly intentional. The consequence of that omission, namely the expiration of the Patent of Addition, was not contemplated by them, but this is exactly the position which occurred in *Land's case*. In that case the Patentee never intended to allow his monopoly to lapse, but clearly intended not to pay the fee on the Patent in question.

Mr. Dunlop suggested, that, as it was not possible to restore the Patent of Addition without the original Patent, I should restore the original Patent which would have the effect of restoring the Patent of Addition, and subsequently the Patentees should make an offer to surrender the Patent under the provisions of Section 26(3); that I should then make an Order revoking the original Patent, and convert the Patent of Addition into an independent Patent under the proviso to Section 19(4). While this is an ingenious suggestion, it does not dispose of my difficulty in having to come to a conclusion that the omission to pay the fee on the original Patent was unintentional, and it is essential that I should be so satisfied before I can exercise any discretion in restoring the Patent under Section 20. I am bound, therefore, to dismiss this application on the ground that I am not satisfied that the omission to pay the fee on Patent No. 282,791 was unintentional, and I order that the application be dismissed accordingly."

It appears that the alternative ground that the omission to

pay the renewal fee was "unavoidable" is a ground peculiar to the Indian Act and not available in the United Kingdom under the corresponding section (i. e Section 20 (3) ) of the English Acts 1907-1932. There do not appear to have been any reported cases as to what amounts to avoidability.

For a case in which restoration was refused for undue delay in making the application for restoration, see *Reihl's Patent*<sup>25</sup>.

### **Appeal.**

Under Section 16(5) there is an express right of appeal from any order by the Controller (that is whether for restoration or for refusal of restoration or for restoration on conditions) to H. E the Governor-General in Council.

### **Practice under the Indian Act and Rules.**

The provisions regarding applications for restoration are contained in Section 20 of the English Patents & Designs Acts 1907-1933 and the Rules 61 to 66 of the English Patent Rules of 1932. Such provisions are more detailed than the Indian provisions. But it may be assumed that the Controller in India does in practice follow the English practice even though not bound to do so, since there is nothing in any of the provisions in the Indian Act or Rules repugnant to his doing so ; and since the English Rules where they differ may be treated merely as additional in regard to matters of detail not provided for by the Indian Rules. The two systems differ also in regard to the provision for appeals : the appeal allowed from the decision of the Comptroller being in England to the Court. Apart from these differences the provisions in both systems of law are in general to the same effect.

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<sup>25</sup> (1922) 39. R. P. C. Appendix p. iii.

## CHAPTER XIV

### INFRINGEMENT—WHAT CONSTITUTES INFRINGEMENT— DEFENCES IN RELATION TO THE GRANT— DEFENCES OF DENIAL OF THE ACT ALLEGED—DEFENCES IN RELATION TO THE SPECIFICATION—LORD MOULTON'S DEFENCE

**The Royal Command comprising the prohibition.**

It has been seen that in the form in use in the United Kingdom the Letters Patent themselves contain the royal command to all subjects of the Crown, other than the Patentee himself, forbidding them from dealing in certain ways with the invention. It is in truth by this prohibition to others, alone, that the monopoly is effectively granted to the Patentee. The material words of such prohibition are :—

“Know ye, therefore that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such a manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of sixteen years from the date hereunder written of these presents : And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention. We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of sixteen years



either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

The words of the form of grant of patent in use in India which are material for the present purpose are :—

"The Governor-General in Council is pleased to order by these presents that the above said petitioner.....shall, subject to the provisions of the Indian Patents & Designs Act of 1911, as patentee have the exclusive privilege of making, selling and using the invention throughout British India (including British Baluchistan, the Santhal Parganas and the Shan States) and of authorising others so to do for the term of sixteen years....."

The Indian form of grant (though it may be a matter for some regret that it is less direct in its wording without any other apparent advantages) must be taken to carry with it a similar command on persons other than the patentee not to make, sell or use the invention throughout the territory and for the period stated.

Any person disobeying the royal command comprising this prohibition commits an infringement of the Patent.

Such infringement, though in truth a disobedience of the royal command and a breach of the royal prerogative, is not, and has never been, treated as a crime : and since the matter is one which especially and directly concerns the Patentee and no one else, the taking of redress is left to the Patentee and no one else. Even he is not entitled to proceed criminally against the infringer ; but only by civil suit. The right of bringing a civil suit is expressly given to him under the Indian Patents & Designs Act of 1911 [under Sec. 29(1) ]. It has not been made open to anyone but the Patentee himself to take steps for the breach of the royal command, that is the infringement, either by criminal proceedings or by civil suit.

It may be of interest to note that the counterfeiting of trade marks and certain matters related thereto are treated as crimes under the Indian Penal Code ; for which reference may be made to Sections 478 to 489 thereof and to the Merchandise Marks Act (Act IV of 1889). Also certain matters relating to the use of false descriptions of goods, which cover among other things false trade-marks, false statements of the country of origin and so on, are made offences under the Merchandise Marks Act and the Sea Customs Act of 1878 (as amended). For corresponding provisions in the criminal law of England reference may be made to the English Merchandise Marks Act of 1887 (50 & 51 Vict. Ch. 28). Such crimes are made punishable by fine or imprisonment or both. But infringement of patent is in no case treated in India as a crime. The present chapter is concerned therefore only with the civil right to sue possessed by the patentee.

#### **What constitutes infringement.**

Infringement is the act, or acts (somewhat analogous to trespass) in respect of which the Patentee is thus given a statutory right to bring a suit against the infringer. The Patentee possesses no right at Common Law or apart from the Act of 1911 to sue for infringement. The act itself also does not use the term infringement in conferring on him this right of suit nor does it contain any definition of the term. But by Section 29 of the Indian Patents & Designs Act of 1911 the Patentee is given the right to bring a suit in certain circumstances which are there stated. The Patentee's right in British India to sue for infringement of his Patent is derived from this section and this section only. Accordingly only such acts as fall within that section amount to an infringement ; and anything outside that section is not an infringement.

Under Section 29(1) of the Act of 1911 it is provided as follows :—

“A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells or uses the invention without his license, or counterfeits it, or imitates it.”

The material words for the present purpose are “makes, sells or uses the invention”.

**Three main classes of defence to a claim of alleged infringement.**

As soon as the point is brought up whether any particular act is an act done by such specific person, at such time, in such place, and in such manner, as to amount to an infringement for which another specific person will be entitled to sue, this opens up the possibility of three quite distinct lines of defence. First there is the class of defence that the act alleged to have been done was not an act, the doing of which, at the place or at the time or in the manner alleged, amounts to any infringement in relation to the terms of the grant of the Patent. Then there is the second class of defence which is comprised in a denial that the alleged act, which is complained of as being the infringement, was in fact committed. Then there is the third class of defence that the act was not an act of such a nature in relation to the description of the patented invention in the Specification itself, as to amount to any infringement.

In regard to defences raised only in relation to the terms of the grant it is clear that such defences will succeed or fail irrespectively, entirely, of any similarity or dissimilarity between the Patented invention and the article or act alleged to be an infringement of it; and in such a defence (in relation to the terms of the grant) questions of the construction of the Specification as to the nature or ambit of the invention patented will be entirely immaterial and irrelevant, and need not at all be gone into. It is immaterial also whether the alleged act complained of as being an infringement was committed or not. In that class are also included defences that the Defendant is a person in particular, who is, for one special reason or another, relieved from liability in relation to the grant. Also the defences that the Plaintiff in particular is not entitled to sue for infringement at all.

The second class of defence, that of a denial that the act complained of as being an infringement was committed, stands by itself. Obviously if such a defence is established no question either of the terms of the grant or of the contents of the specification need arise.

On the other hand in regard to a defence of the third class, in which the Defendant relies on his article or process being different from the patented article or process, such a defence is raised directly in relation to the Specification itself; and the success or failure

of such a defence is dependent largely on the manner in which the Specification is properly to be construed. In such cases questions regarding the proper construction of the Specification may be not only relevant but vital. For this defence the terms of the grant are immaterial ; it is also immaterial whether the act alleged and complained of as being an infringement was committed or not.

There is also a subsidiary fourth class of defence commonly known as Lord Moulton's defence to which reference is made hereafter.

By considering what does not amount to infringement for one reason or another, this will be the most convenient way of analysing what constitutes an infringement.

#### **Various specific defences available against a claim for infringement.**

The following are the defences which may be available according to the circumstances of the particular case, for a Defendant against a claim for infringement of Patent.

##### **I. DEFENCES IN RELATION TO THE GRANT**

*(N. B. The contents of the Specification are immaterial. It is also immaterial whether the alleged act, complained of as being the infringement, was in fact done or not.)*

*(N. B. It may be possible in some cases to raise these defences as a preliminary point either on the pleadings or without calling oral evidence.)*

*Patent not in force at the date of the alleged act complained of as being the infringement.*

1. No grant has been made at all : or early enough so as to have been in force prior to (or on) the date of the alleged infringement.
2. That the alleged act complained of as being the infringement was done before the date of the advertisement of the acceptance by the Patent Office of the application for the Patent. (See Sec. 11).

*N. B.* This is a defence against a claim for damages but no defence against a claim for injunction.

3. The Patent had expired prior to the date of the alleged infringement.

4. The Patent had lapsed for non-payment of renewal fees prior to that date.
5. The Patent had been revoked prior to the date.
6. The Patent had been surrendered under Section 24 prior to that date.
7. The Patent though not revoked had been declared invalid prior to that date.
8. The Patent is a Patent of addition to a Patent which had lapsed owing to non-payment of renewal fees or had been revoked prior to the date of the alleged infringement and had not been converted to an independent Patent under Section 15A(2).
9. Where the Patent has been extended, that the alleged act complained of took place after expiry of the original Patent and before the grant of the extension or of the sealing of a new Patent.
10. Where the Patent has been revived under Section 14(2) by an enlargement of the prescribed time for payment of renewal fees, that the act complained of as being an infringement was done after a failure to pay renewal fees within the prescribed time and before any enlargement thereof : under Section 14(3).

*N. B.* This is a discretionary defence against a claim for damages only.

11. Where the Patent has lapsed through unintentional or unavoidable non-payment of renewal fees and has been subsequently restored, that the alleged act complained of as being the infringement took place after the date of the lapse of the Patent and before a date twelve months after the date of the restoration order : under Rule 28 as amended by an amendment of 1935.

*Patent in force at the date of the alleged infringement but not so as to be affected by the act complained of.*

12. The alleged act complained of as being an infringement was done outside the locality covered by the grant : being

done outside the territory of British India and British Baluchistan and the Santhal Parganas and the Shan States.<sup>1</sup>

13. (The same): being done in a foreign ship or aircraft within Section 42.
14. The alleged act complained of as being an infringement was done in a manner such as not to constitute an infringement in relation to the grant: not being such a dealing with the invention as to amount to a "making" "selling" or "using" thereof such as to constitute an infringement.

*Defendant is a person in particular relieved from liability.*

15. The defendant at the time of the alleged infringement had a license (express or implied) from the Patentee.

*N. B.* Where there are Joint Patentees it may be that a license given by one only without the express authority of the other Joint Patentee or Patentees will not be effective.

16. (The same): in particular when acting on directions given by the Patentee.
17. The Defendant at the time of the alleged infringement was a Joint Patentee with the Plaintiff.
18. The Defendant at the time of the alleged infringement was the Agent of the Patentee.
19. The Defendant at the time of the alleged infringement was the agent of a Joint Patentee with the Plaintiff.
20. The defendant acted as an innocent infringer only, not being aware of Plaintiff's Patent, and had no reasonable means of making himself aware thereof.<sup>2</sup>

*N. B.* This is a defence against a claim for damages only; and not necessarily a defence against a claim for an injunction.

21. That the Patent has been granted on certain conditions or has been extended or restored on conditions, and that the Defendant is within the conditions [See Section 16(5)].

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<sup>1</sup> See page 31 above.

<sup>2</sup> See Section 30. Such a case may arise in particular where patented goods were not properly marked.

*N. B.* There is no defence available in India that the Patent has been endorsed "licenses of right" and the Defendant is willing to take a license.

22. In a case where the defendant is the Government and the Patentee is a government servant, that the defendant is relieved from liability by virtue of particular conditions on which the grant was made (see Fundamental Rule 48A and the General Instructions thereunder and see page 349 above).
23. In a case where the defendant is the Government (or an officer or authority administering any department of the services of His Majesty, or his agent, or his contractor or some other person authorised in writing by him) no matter whether the Patentee is a government servant or not, that the particular circumstances of the alleged infringing act are such that the defendant is relieved from liability under the provisions of Section 21 of the Indian Patents & Designs Act of 1911.

*Plaintiff is a person in particular not entitled to sue for infringement at all.*

24. The Plaintiff was not the registered Patentee at the date of institution of the suit. [See Sec. 29(1) & Sec. 2(12)].
25. The Plaintiff though the registered Patentee at the date of the institution of the suit, was not the person entitled to the benefit of the Patent at the date of the alleged act complained of as being the infringement.
26. There has been no valid assignment of the Patent to the Plaintiff prior to suit though the Plaintiff is suing as Assignee.

## II. DEFENCE OF DENIAL (OR NON-ADMISSION) THAT THE ALLEGED ACT COMPLAINED OF AS BEING THE INFRINGEMENT WAS COMMITTED

27. At all.
28. By the Defendant : or by his agent : or by any person for whose act the Defendant will be liable.

(*N. B. The terms of the grant are immaterial. The contents of the Specification are also immaterial. Oral evidence will ordinarily be required.*)

(*N. B. As to a defence of denial that there was in fact any infringement because the alleged act was not committed at the material time, place, or manner in relation to the grant, see defences in relation to the grant : previous headings under "Patent not in force so as to be affected by the act complained of".*)

(*N. B. As to a defence of a denial that there was in fact any infringement because the Defendant's article or process was not within the Plaintiff's monopoly, see defences in relation to the Specification : later headings under "Defendant's Article or Process which is alleged to be an infringement is not within the Plaintiff's monopoly".*)

### III. DEFENCES IN RELATION TO THE SPECIFICATION

(*N. B. The terms of the grant are immaterial. It is also immaterial whether the alleged act complained of as being an infringement was in fact done or not.*)

*Plaintiff's Patent is invalid.*

29. Plaintiff's Patent is invalid for want of subject matter since it does not comprise a manner of manufacture. (See Chapter VI.)
30. Plaintiff's Patent is invalid for want of subject matter :<sup>3</sup> since there was in the alleged invention no inventive step. (See Chapter VI.)

*N. B.* It appears that no defence is open to a Defendant in an infringement suit on the ground that the Plaintiff's Patent is invalid for want of subject matter in that the use of the invention will be contrary to law. (See Chapter VI and see page 166). Or con-

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\* The view was definitely stated in the case of *Sundara Rajan v. Kuppusami Iyer* (1914) 27. Mad. L. J. 573, that no defence of want of subject matter at all apart from want of novelty was available under the Indian Act. Though it was held that the matter in that case was governed by the 1888 Act, yet it was also definitely stated that this view of the law would also apply under the later Act of 1911, which had by then been passed but was held not to govern that case. This view has however never been followed in any subsequent case and, it is respectfully submitted is not good law.



trary to morality. Nor on the ground that the use of the invention will be unfit for the exercise of the Crown's prerogative. (See page 166.)

31. Plaintiff's Patent is invalid for want of novelty by anticipation as common knowledge. (See Chapter VI, Part IIIA.)
32. Plaintiff's Patent is invalid for want of novelty by anticipation as public knowledge (whether by oral publication or documentary publication or by publication by prior user). (See Chapter VI, Part IIIA.)
33. Plaintiff's Patent is invalid by reason of a prior grant (See Chapter VI, Part IIIB and at p. 218).
34. Plaintiff's Patent is invalid for want of utility. (See Chapter VI, Part IV.)
35. Plaintiff's Patent is invalid for insufficiency of definition in the Specification of the ambit of the invention (See Chapter VII, Part I).
36. Plaintiff's Patent is invalid for insufficiency of description in the Specification of the nature of the invention and of the directions for the manner in which it is to be performed. (See Chapter VII, Part I.)
37. Plaintiff's Patent is invalid for insufficiency of description, in the Specification of the best means known to the Applicant for performing the invention.

*N. B.* Under Section 26(1)(g) it must be shown that such insufficiency is fraudulent or injurious to the public.

38. Plaintiff's Patent is invalid on the ground that the Applicant for Patent was not the true and first inventor. (See Chapter VII, Part II.)
39. Plaintiff's Patent is invalid on the ground that the application was made fraudulently. (See Chapter VII, Part III and see at page 266.)

*N. B.* There is no defence available to a Defendant in an infringement suit in India of "obtaining" simpliciter. See pages 263 and 267.

40. Plaintiff's Patent is invalid for abuse of the monopoly after grant by non-supply in British India or non-manufacture in British India (See Chapter VIII and see page 333).

*N. B.* This defence is only effective when four years or more have elapsed after the date of the Patent.

*Defendant's article or process which is alleged to be an infringement is not within the Plaintiff's monopoly.*

41. The alleged infringement is not covered by the claims of the Plaintiff's Specification.
42. The Patent has been amended since the date of the alleged infringement and the alleged infringement was not covered by the claims in the unamended specification.
43. The alleged act complained of as being an infringement was done in circumstances such as not to create any actionable claim for damages for infringement, since the Patent has been amended since the date of the alleged infringement (unless Patentee establishes that his original claim was framed in good faith and with reasonable skill and knowledge). (See Section 19.)

#### IV. LORD MOULTON'S DEFENCE

*(N. B. The terms of the grant are immaterial. It is immaterial whether the alleged act, complained of as being an infringement, was in fact done or not. The contents of the Specification also become immaterial; since this defence amounts to an alternative plea in relation to the Specification, that, either, if the alleged infringing article or process is within the ambit of the Plaintiff's claims, then the Plaintiff's Patent is invalid for want of novelty, or, if outside the ambit, then there is in fact no infringement. But evidence will be required.)*

44. Defendant's article or process which is complained of as being an infringement is not novel. See *Gillette Safety Razor Co. v. Anglo-American Trading Co.*<sup>4</sup>

<sup>4</sup> (1913) 30. R.P.C. 465 H. L. at p. 480. Also *Cincinnati Grinders (Inc.) v. B. S. A. Tools Ltd.* (1931) 48. R.P.C. 33 at page 58. Cf. *Hocking v. Hocking* (1886) 3. R.P.C. 291 and *Proctor v. Bennis* (1887) 4. R. P. C. 333 at page 351.

The above-mentioned defences are briefly noted here in one place, for convenience of reference. It is proposed to deal further with those defences relating to the grant and to the denial of facts (i.e. the first and second class of defence) in Chapter XV ; and to deal further with those defences relating to the Specification and with the defence commonly known as Lord Moulton's defence (i.e. the third and fourth class of defence) in Chapter XVI.

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## CHAPTER XV

### INFRINGEMENT CONTINUED—DEFENCES IN RELATION TO THE GRANT—DEFENCE OF DENIAL THAT THE ACT COMPLAINED OF AS BEING AN INFRINGEMENT WAS DONE

**No specific mention of these defences in the Act of 1911.**

The defences which may prevail in a suit for infringement are nowhere exhaustively mentioned in the Indian Patents & Designs Act of 1911. Under Section 29(2) of the Act it is provided that "every ground on which a Patent may be revoked under this Act shall be available by way of defence to a suit for infringement." Thus every ground upon which it can be claimed that a patent is invalid may be used as an answer to a claim of infringement: also the grounds upon which it can be claimed that, though the patent is not *ipso facto* invalid, yet it ought to be revoked—such as the ground that the demand for the patented article in British India is not being met to an adequate extent or the ground of manufacture outside British India. But this does not mean that such grounds are the only defences available. There are certain other complete defences to a claim of infringement, which are not grounds of revocation at all. These defences are nowhere specifically referred to in the Act of 1911.

It will be observed that of the 44 various defences briefly mentioned in the preceding chapter, the defences noted under the numbers 1 to 28, which are now being considered in the present chapter, (as well as those under numbers 41 to 44 to be considered later) have nothing to do with Section 29(2) of the Act.

**Time of the alleged infringement in relation to the grant.**

It is obvious that as the monopoly of the Patentee only extends from the date when his Patent first comes into force up to the determination of his Patent, there can be no infringement except during the currency of the Patent said to be infringed. If the act complained of as being an infringement was done either before or after

the period during which the grant was current there will clearly be no infringement. Defences referred to as Nos. 1 & 2 in chapter XIV arise when there has been no grant at all, ever, or when the act complained of took place before the grant of the Patent ; and defences Nos. 3 to 8 arise when the act in question took place after the determination of the Patent. Defences Nos. 9 to 11 arise when the act complained of took place during some intermediate period during which, for particular reasons, the Patent will not have been effective and enforceable.

### **No grant of Patent at all.**

From the fact that a grant of Patent if made will relate back so as to be operative from the date of the application for the Patent, it follows that it will ordinarily be unsafe for a person other than the Patentee to manufacture or sell or use the patented article or process even before the actual grant of the Patent at any time after the date of the advertisement of the application for the Patent. In certain circumstances however enquiry at an early date may show that it has already become impossible for any grant to materialise. If the application for Patent has been refused. If the application has been finally abandoned (before acceptance or before sealing). If on the application being heard, the grant of a Patent has been finally refused. If no sealing fee has been paid within the prescribed time.

### **Time of immunity before a Patent becomes enforceable : period between date of application and date of advertisement of acceptance of the Specification.**

It is true that after a Patentee has obtained the grant of a Patent, such grant and the term of the Patent and of his monopoly date not from the grant but from the date of his application ; renewal fees in respect of the Patent being payable from the date of the application. This is expressly provided in the first part of Section 11 of the Indian Patents & Designs Act of 1911 : which is to the effect that :—

“Except as otherwise expressly provided by this Act, a Patent shall be dated and sealed as of the date of the application.”

(See also the schedule to the act regulating the fees payable, under which the years for purposes of renewal fees are reckoned

from the date of the Patent—that is to say from the date of the application.) But it is expressly provided, also, by the latter part of Section 11 as amended by the Act of 1930 :—

“that no proceedings shall be taken in respect of an infringement committed before the advertisement of the acceptance of the application.”

Thus there is no real or effective remedy available for a Patentee against infringement committed between the date of his application for a Patent and the date of the advertisement of his Specification. This is of course only reasonable : since it would be absurd if a person could be sued for an infringement of a Patent in respect of an act done at a time when no one had any knowledge except the applicant for Patent and the Controller himself, to whom the application had been then submitted, of its potential existence. The provision regarding innocent infringement would in itself ordinarily bar any claim for damages in respect of any infringement committed before the advertisement of the specification. This provision of Section 11 goes further and its effect is that there can be no actual infringement at all before that time.<sup>1</sup>

#### **Time before which suit cannot be instituted.**

No suit can be instituted by the Plaintiff on any date prior to the grant to him of his Patent. This seems clearly to follow from the essence of his position and of his cause of action. Since he sues only as Patentee ; and cannot be a Patentee before the grant of the Patent is made.

Under the proviso to Section 7 of the Indian Patents & Designs Act of 1911 there is an express provision to the following effect :—

“Provided that an applicant shall not be entitled to institute any proceedings for infringement unless and until a patent for the invention has been granted to him.”

This is conclusive enough : and none the less so for being inserted in the act as a proviso which follows as somewhat of a

<sup>1</sup> See *Dowling Billington* (1898) 7 R. P. C. 191 at p. 201 and 205. For a case where the statement of claim was struck out because there was no statement that the alleged act of infringement was not prior to the date of acceptance of the Patent see *Schuster v. Hine Parker & Coy. Ltd.* (1935) 52. R.P.C. 345.

non sequiter to the rest of Section 7 ; which relates rather to loss of rights and monopoly than to the enforcement of them.<sup>2</sup>

This matter concerning the possible date of a suit in relation to the date of the grant of the monopoly to the Plaintiff is quite independent of any question concerning the date of the act complained of (as an infringement) in relation to the date of the commencement of the effective period of the monopoly, such as is referred to in the latter portion of Section 11 of the Act of 1911.<sup>3</sup>

### **Time of commencement of immunity after Patent ceases.**

Clearly if the act complained of has been done after the Patent in question has ceased to be enforceable, there can be no claim for any infringement. Various circumstances in which the Patent may have ceased or may have temporarily become unenforceable, have been indicated under the defences mentioned under Nos. 3 to 11. Regarding expiry, the date operates automatically. Regarding the lapsing of a Patent, this occurs under Section 14(2), also automatically. Regarding the revocation of a Patent, it would appear that it will be sufficient defence to a claim for infringement that an order for revocation has been made ; and that it is not essential that the entry of such revocation should have been made on the Register of Patents.

In practice it would seem that cases seldom arise where anything turns on the precise time when the Patent ceased to be enforceable, since the Patentee will not ordinarily have sufficient incentive at such a late stage in the life of the Patent to take any proceedings for infringement.

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<sup>2</sup> Whether a Plaintiff in India could institute a suit after grant but before the sealing of the patent or, in view of Section 2(12) before registration as patentee, is a question which may await decision till the case arises. Under the English Act of 1907 as amended in 1932 there is on this point an express provision contained in Section 10 thereof to the following effect :—"Provided that an applicant shall not be entitled to institute any proceeding for infringement until the patent has been sealed." Before 1932 the wording under the United Kingdom Act then in force was "until a patent for the invention has been granted to him" : as in the present Indian Act.

<sup>3</sup> See also at page 582 below under "Defence that the Plaintiff was not the registered Patentee at the date of the institution of the suit".

The view has been stated that a person who has infringed a Patent by manufacture during the currency of the Patent may be restrained from selling after its expiry.<sup>4</sup>

**Locality of infringement in relation to the grant.**

It has already been observed that the monopoly created by a Patent under the Indian Patents & Designs Act of 1911 only runs throughout the territory comprising British India and British Baluchistan and the Santhal Parganas and the Shan States. (See page 31 above). It follows that it is a complete defence to a suit for infringement in British India that the act complained of was done outside the territory mentioned.

**Foreign ship or foreign aircraft.**

It is provided by Section 42 of the Act as follows :—

“42(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any Court in British India, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from British India.

(2) This section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that State or in the waters within the jurisdiction of its Courts.”

It is clear from the wording of the section that exemption from liability for infringement conferred under the section will only cover cases where there would otherwise be an infringement by “use” of the invention : and that the section would be no protection if an infringing article or process were sought to be manufactured or sold on board a foreign ship in Indian waters.

It would seem that the words “use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any Court in British India” employed in the section will cover a use not on board the foreign vessel ; and that the exemption from

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<sup>4</sup> See *Fletcher Moulton* at p. 157.



liability created by the section would apply even in a case where the actual use was on land or on the water away from the vessel itself.<sup>5</sup> It would also seem that the exemption created by the section covers such use on or in connection with a foreign vessel no matter on what business the vessel may have come to India and no matter for what reasons or how frequently she may come to India and no matter for what period she may ply in Indian waters.

Since the section does not expressly refer to use on foreign aircraft a question arises whether the word "vessel" is to be construed as including aircraft. If not, then the use on a foreign aircraft within British India of an article or process patented in British India will clearly be an infringement of the Indian Patent : as the act at present stands. For it has been held in the United Kingdom in cases prior to the enactment of the English Section 48, that the use of articles patented in the United Kingdom on either a British or a foreign ship within the waters of the United Kingdom was an act of infringement ; and even that the mere presence of the article as part of the ship's equipment was sufficient to justify an

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<sup>5</sup> It will be observed from a perusal of the English Section 48 that in the United Kingdom the exemption from liability for infringement under that Section extends only to use under the following restricted conditions :—

- (i) if the foreign ship belongs to a reciprocating foreign state.
- (ii) if the foreign ship comes into the territorial waters of the United Kingdom temporarily or accidentally only.
- (iii) if the use is "exclusively for the actual needs of the vessel" and is "in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof".

On a foreign aircraft or land vehicle :—

- (i) if it belongs to a reciprocating state.
- (ii) if it comes into the United Kingdom temporarily or accidentally only.
- (iii) if the use is "in the construction or working" of the foreign aircraft or land vehicle.

A definition is also included in the English section relating to the test to be adopted in arriving at a decision to what country a vessel or aircraft or vehicle belongs. And provision is also made in the section giving power to His Majesty by Order in Council to apply the section to vessels, aircraft and land vehicles of a part of His Majesty's dominions outside the United Kingdom in like manner as to those of a foreign state.

In the United Kingdom provision has been made under Section 13 of the Air Navigation Act of 1920 to prevent the detention or arrest of foreign aircraft in cases of alleged infringement, on deposit of security.

injunction.<sup>6</sup> And it would seem clear that similar principles would necessarily apply under the Indian Act to foreign aircraft in British India if not covered by any exemption from liability created by this Section 42.

The use of an invention patented in British India on an Indian ship or aircraft outside Indian waters and outside the territory covered by the Indian grant will not constitute any infringement of that Patent.<sup>7</sup>

### **Manner of alleged infringement in relation to the grant.**

It is obvious that any act which is not of such a nature as to be a "making", "selling" or "using" of the invention or a "counterfeiting" or "imitating" of it within the meaning of Section 29(1) of the Act will not be an infringement. Assuming for the moment that the patented article or process is in all respects even identical with the alleged infringing article or process, it still remains necessary, in order that any infringement shall be established, for the act complained of in respect of the alleged infringing article or process to be such an act as to be an infringing act. Accordingly it is necessary to consider in relation to the grant itself, apart altogether from the Specification, by what manner of acts an infringement may be committed.

### **Infringement by Manufacture.**

Where the invention patented relates to an apparatus or a machine, there can be no act more positively effective as an infringement than the manufacture (it may be by a rival manufacturer) of the patented article.

It is immaterial whether the manufacture is preliminary to sale in British India or is for the purpose of exporting the goods abroad and selling them outside British India; or whether it is a manufacture only for private use. The objects and circumstances of the manufacture are immaterial. It is the act of manufacture in itself which constitutes the infringement.<sup>8</sup>

<sup>6</sup> See *Fletcher-Moulton* p. 157; *Caldwell v. Van Vlissingen* (1852) 21. L. J. Ch. 97 (C. A.)

<sup>7</sup> See *Newall v. Elliot* (1864) 10 Jur. N. S. 954.

<sup>8</sup> As to manufacture for export abroad see *Lyon v. Goddard* (1894) 11. R. P. C. 113. As to manufacture for private use, see *United Telephone Company v. Sharples* (1885) 2. R. P. C. 28.

Where the invention patented relates to a process, obviously there can be no infringement by manufacture directly of the invention, though there may well be infringement by use of the invention, in the course of manufacturing something else. How far a sale or use in British India of the final product alone may be said to be an infringement of a patent which relates to a process of manufacturing such product, is further considered hereafter.<sup>9</sup>

#### **Manufacture of replacements : Bona fide repairs.**

It has been held in effect that a purchaser of a patented article is entitled to do *bona fide* repairs to that article himself to keep it in working order and to prolong its life without becoming liable to a claim of infringement: provided such repairs do not amount to the making of a substantially new article. This principle may in some cases afford him protection even when replacing, himself, complete parts.<sup>10</sup>

#### **Manufacture for purposes of experiment only.**

Even manufacture of the patented article itself, if only for the purpose of *bona fide* experiment, is not infringement. The principle was clearly stated by Jessel M. R. in *Frearson v. Loe*<sup>11</sup> an extract of whose judgment on this point is as follows :—

“He (the defendant) said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bona fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the

<sup>9</sup> See under “Sale of product” at p. 557.

<sup>10</sup> See *Dunlop Pneumatic Tyre Co. Ltd. v. Holborn Tyre Co. Ltd.* (1901) 18. R. P. C. 222; *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons Ltd.* (1904) 21. R. P. C. 274 C. A. at p. 282; *Sirdar Rubber Co. Ltd. v. Wallington Weston & Co.* (1907) 24. R. P. C. 539 H. L.; also *Fletcher-Moulton* at p. 161.

<sup>11</sup> (1878) 9. Ch. D. 48 at p. 66.

meaning of the prohibition, and if it were, it is certainly not the subject for an injunction. But, where you see a man using a machine as this Defendant has done, under claim of a right to use it, and under that claim of right he makes a quantity of goods, even though a small quantity, I cannot call that an experiment within the meaning of the rule as to experiments. He has made a machine, and, knowing it to be an infringement of patent, he claims the right to make and use it, and his experiment is made to see how his machine works. That is the experiment, as he calls it, putting his machine to work from time to time, and then making screws with the view of trying the screws themselves. It does not appear to me, when I consider the circumstances under which the Defendant made these alleged experiments, that I ought to treat this as coming within the rule which prevents mere experiments being subject to the liability of action being brought against those who make them, and to the costs of an injunction being granted against them. In this case I consider that the Defendant was making the screws in exercise of an alleged right which has been disproved at the trial."

On the facts in that case, as is clear from the passage above cited, it was held that the manufacture was not within the principle which exempts mere experiments from liability, yet the case is clear authority, it is submitted, for the principle itself.<sup>12</sup>

### **Infringement by sale.**

Where the invention patented relates to an apparatus or a machine, an infringement is clearly committed by a sale in British India of the patented article.

Where the invention patented relates to a process, there cannot ordinarily be an infringement by sale of the invention itself, though the process may be used as a preliminary to the sale of something else. How far a sale, or use, of a final product is to be regarded as an infringement of a patent which relates to a process of manufacturing such product is further considered below.<sup>13</sup>

### **Infringement by sale : offering for sale.**

In a given case where there has in fact been no sale effected,

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<sup>12</sup> See also *Proctor v. Bayley & Son* (1889) 6. R. P. C. 106 and, on appeal, 6. R. P. C. 538 ; also *Pessers Moody, Wraith and Gurr Ltd. v. Newell & Co.* (1914) 31. R. P. C. 510.

<sup>13</sup> See under the head "Sale of product" at page 557 below.

but there can be shown to have been an offering for sale, it may be suggested that there has been an actual infringement, if not by sale, then by use ; or it may be suggested that there has been by the Defendant a threat to infringe by sale. On the one basis if actual infringement is established, the Plaintiff will be entitled to claim damages as well as an injunction : on the latter basis, an injunction only.

The principle appears to have been established that a Plaintiff is entitled to claim a permanent injunction for a threat to infringe.<sup>14</sup>

Apart from this the principle has also been established in the United Kingdom that possession of an infringing article accompanied by exposure for sale, even without proof of any actual sale is in itself an actual infringement. The law on this point has been recently succinctly stated in *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.*<sup>15</sup> by Maugham L. J. in these words :—

“Then there comes the question of the proved offer for sale specified in the Pleadings, and evidenced by the circular letter, the pamphlet and the advertisements which are mentioned in paragraph 2 of the Particulars of Breaches. On that the Plaintiffs contend that that is also an infringement. As at present advised, I do not think it is. The grant of the Patent conferred on the Patentee the sole right to make, use, exercise and vend the invention : and there have been several cases in which the Courts have considered the meaning of those words. There was a case in which it was said that to expose for sale was not to vend the invention. That case was considered by this Court in the *British Motor Syndicate Ltd. v. J. Taylor & Sons Ltd.* (1890) 7. R. P. C. 723. There the Court of Appeal decided that the possession of an infringing article, accompanied by exposure for sale, even without the proof of any actual sale, is actionable infringement. But no case has decided, and, as I understand the ground of that decision no case ought to decide, that a mere paper offer for sale of an article which, if sold without a licence from the patentee, would be an infringement is itself an infringement. Another question, no doubt, arises as to whether a written offer of a particular article, when the written offer is intended to

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<sup>14</sup> See *Frearson v. Loe* (1878) 9. Ch. D. 48 at p. 65 and see Chapter XVII under the head “Threatened infringement.”

<sup>15</sup> (1935) 52. R. P. C. 231 at 251.

relate to an article which would be an infringement, is not a threat to infringe ; and, therefore, a threat which would justify an injunction, as in the well-known case of *Adair v. Young*, L. R. 12 Ch. D. 13. It may be that the Plaintiffs could have asserted that in this case, and they might have been entitled possibly to an injunction but as in my opinion, the offer for sale by the Defendants of the Velos "Non-smoker ash barrel" was unaccompanied by proof of exposure for sale, it was not an infringement of the Patent."

It is to be observed however that the words of the grant of a Patent in the United Kingdom are "make, use, exercise and vend" and that these differ from the words of the Indian grant which are "making, selling and using." It is possible that while an offer to sell may well be held to come within the meaning of the verb to "vend", yet it cannot be held to be a sale within the meaning of the word "selling". If this distinction is correct, then in British India an offer to sell even though with possession and by means of an exposure for sale, if it is an actual infringement in itself, will be so by reason only of its being a "use" of the invention. If it is not a "use" of the invention, then it would seem to follow that an offer to sell in British India is not an actual infringement in itself at all, but merely a threat to infringe.<sup>16</sup>

### **Mere paper offer for sale.**

While it has been settled in the United Kingdom that an actual offer for sale, with possession, constitutes an actual infringement, it is clear that a mere paper offer for sale without possession of any infringing article has been held (in the case last cited) not to be an infringement. It is submitted that this will be the position in law also *a fortiori* in British India in view of the wording of the Indian grant already noted.

### **Sale of Product.**

Where the patented invention relates to a process, there is some authority in the English cases which would support the proposi-

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<sup>16</sup> For authority that an offer for sale by exhibition or exposure is an infringement by "use", see *British Motor Syndicate Ltd. v. John Taylor & Sons Ltd.* (1900) 17 R. P. C. 723 C. A. at p. 729. See also at page 562 below under "Use by exposure for sale".

tion that a sale in British India of articles which were a product of such process, even if the process itself had never been operated in British India, would constitute an infringement of the Patent.<sup>17</sup>

The reasoning by which this proposition is arrived at is somewhat obscure; however compelling may have been the motives of public policy for enforcing it.<sup>18</sup>

However it appears to have become a settled principle of patent law in the United Kingdom that a monopoly for a process includes a monopoly for articles made by that process; and accordingly even though the process is not used within the realm, yet if articles made abroad by the process are sold within the realm this is held to be an infringement of the patentee's patent for the process.

It remains to be seen to what extent the Courts in British India will adopt this proposition.<sup>19</sup>

It is submitted that where the patented invention is for an apparatus or a machine and not a process this proposition will not be applicable, and that the sale in British India of products made abroad by a machine similar to the patented machine will not constitute an infringement; though this point is not free from doubt.<sup>20</sup>

**Sale of machine through which a patented process may thereafter be worked.**

Where the patented invention relates to a process, there is authority in the English cases, which would support the proposition that a sale in British India of a machine or apparatus by which the

<sup>17</sup> See *United Horse Shoe & Nail Co. Ltd. v. Stewart & Co.* (1885) 2. R. P. C. 122; *Townsend v. Haworth* (1875) 48. L. J. Ch. 770 and (1879) 12 Ch. D. 831 (note); *Wright v. Hitchcock* (1869) L. R. 5 Ex. 37 at p. 47; *Saccharin Corporation Ltd. v. Quincey* (1900) 17 R. P. C. 337 at p. 339; *Saccharin Corporation Ltd. v. Anglo-Continental Chemical Works Ltd.* (1900) 17. R. P. C. 307 at p. 318. But see *Wilderman v. F. W. Berk & Co. Ltd.* (1925) 42. R. P. C. 79; and see *Fletcher-Moulton* at p. 158.

<sup>18</sup> See *Fletcher-Moulton* p. 158 and p. 17.

<sup>19</sup> This question in a particular case may be one not only relating to the terms of the grant but dependent on a construction of the Specification: i.e. depending on whether the monopoly is held to be for a process or not.

<sup>20</sup> See *Terrell* (8th edn.) p. 174; *Fletcher-Moulton* p. 158 note (p).

process might be operated thereafter by the purchaser, would not constitute an infringement of the Patent.<sup>21</sup>

**Sale of parts or separate integers by which a patented machine or combination may thereafter be made.**

See *Dunlop Pneumatic Tyre Co. Ltd. v. David Moseley & Sons Ltd.*<sup>22</sup>

**Infringement by use.**

Use of the patented invention may clearly be a direct infringement, whether the invention is for an apparatus, or a machine or a process or anything else.

The word "using" has been given a very wide meaning. The scope of the acts which constitute an infringement within the meaning of the term in Patent Law is large. While it is true that in the grant in operation in the United Kingdom there occur the two words "use" and "exercise", and that the word "exercise" finds no place in the Indian grant, yet it would seem that cases will be extremely rare, if any, where the two words "use and exercise" will have any materially wider scope than the one word "use". The undermentioned examples of cases decided under the English Patent Law may be noted. There is no reason why the Indian Act should be given any different meaning.

**Use without Pecuniary Advantage: use for Instruction: for Amusement.**

In order that the use may constitute an infringing act, it need not be a use for pecuniary advantage. It has been observed that in certain circumstances a use for instruction or even for mere amusement would constitute infringement. In *United Telephone Co. v. Sharples* it was sought to be argued for the Defendant that the use of certain infringing telephone machines for the instruction of pupils was no infringement. The point was dealt with in the following observations of Kay J.<sup>23</sup> :—

<sup>21</sup> See *Townsend v. Haworth* (1875) 48 L. J. Ch. 770; *Adhesive Dry Mounting Co. v. Trapp & Co.* (1910) 27 R. P. C. 341. See also *Cincinnati Grinders Inc. v. B. S. A. Tools Ltd.* 48 R. P. C. 33 at pp. 58.

<sup>22</sup> (1904) 21 R. P. C. 274 (C. A.) Contrast or distinguish *Incandescent Gas Light Co. Ltd. v. New Incandescent Mantle Co.* (1898) 15 R. P. C. 81.

<sup>23</sup> (1885) 2. R. P. C. 28.



"But suppose that was not so. Imagine that I am to believe all this extraordinary story, and that these were not bought for that purpose, were not received in England for that purpose, what is the alternative story? The alternative story is this: The witness Sharples says, "We used them for the purpose of experiment; the cost of them was so small that we could afford to allow our pupils to pull them to pieces, or experiment with them." Now they had, as he says, a number of the so-called royalty-paid instruments; they were more costly, and he says, again and again, "We could not afford to let our pupils use those; we could not afford them to be pulled in pieces or experimented with, and therefore it was that we bought those which were very much cheaper, in order that our pupils might experiment with and use those instead of using the more expensive instruments." And I am asked to say that that was not a user in this country. What does a pupil mean? They say that the pupils are persons who do not pay anything for being taught, but on the contrary, that after they have been a certain while in the business they, or certain classes of them, receive some payment; but the very word "pupil", and this evidence which is given, shows me plainly that they are young persons who are admitted into this business for the purpose of learning the business, and, whether they pay or not, it is obvious enough that they are paid very much less than an ordinary assistant would be paid who did not want to learn the business. They are admitted upon the terms that part of the remuneration they shall get for their services shall be instruction in the business. That is apparent on the very face of this statement; and to say that to buy a telephone which is an infringement of a patent in this country for the purpose of instructing your pupils who are learning the business, to let them use, to let them experiment with, to let them, if they please, pull in pieces, for the purpose of saving the expense of using the patent telephone, experimenting with that or pulling that to pieces, is not a user in this country, is a thing which I cannot accede to. It seems to me plainly to be a user. If it were nothing but this, that it was fixed between the lower room and the switch room for the purpose of being used by the pupils who could not be trusted with the use of the more costly instruments, it would be a part of the instruction of those pupils, and the person who so used it would be getting the advantage of instructing those pupils by means of these

cheaper instruments, because he did not like to put into the hands of his pupils the more expensive instruments. I am told that that is not a use of the patent. I asked Mr. Goodeve how far he carried his proposition—whether he carried his proposition thus far, that there could be no user of a patent unless it produced a direct pecuniary advantage to the person who used it? At first he seemed inclined to go so far, but I think at last he receded from that position because I put to him the very obvious case of a man buying what he knew to be a pirated Singer sewing-machine, for example. Suppose, the real thing being protected by a patent, that he buys a cheaper instrument which he knows is made in infringement of the patent, and buys it for some member of his household, who uses it in the household, let us say, for amusement simply—would that be a user or not? Of course, it could not be denied, because, although it did not produce to him one farthing, or save him the expense of one farthing, there would be no doubt whatever it would be a user in this country. Therefore Mr. Goodeve modified his proposition, and said “Oh, no, it must be a user for the purpose of advantage.” Then, is not the user which I have been describing a user for the purpose of advantage? If not, I do not know what advantage or user means. It seems to me clearly that here there was a user even if I were to accept that story, which I am loth to accept, which I do not accept, which I cannot believe to be true, that even on that alternative view of the case there was such a user of these pirated articles (pirated when they were introduced into this country, at any rate) and made in imitation of the Bell and Blake patents, as it would be impossible to maintain in this country.”

**Use even as a stand-by only, may constitute infringement.**

It has been observed that in certain circumstances the use of the patented invention even only as a stand-by might be an infringement: as in a case where the patented invention were to be one relating to a fire extinguisher. See *British United Shoe Machinery Coy. Ltd. v. Simon Collier Ltd.* 27. R. P. C. 567 at 571 and 572. It was also suggested in the same case, that where a machine was used in a factory as a spare this would also constitute actual infringement by use.

It is submitted that there would only arise actual infringement in such circumstances where the use in the manner indicated was

a use for the purpose for which the invention had been intended. It will be noted hereafter that ordinarily mere possession without actual use of the invention does not constitute actual infringement : though it may of course afford evidence of an intention to infringe so as to afford grounds for an injunction only on the basis of a threat to infringe.

#### Use by exposure for sale.

In *British Motor Syndicate Ltd. & Others v. John Taylor & Sons Ltd.*<sup>24</sup> the view of the Court of Appeal clearly and unequivocally stated that an exposure for sale was an infringement : either as a "vending" in terms of the English grant or as a "using" thereunder. Certain observations by the Court in *Minter v. Williams*<sup>25</sup> were considered and as will be seen from the judgments, in so far as such observations might be taken to express any contrary view, they were disapproved.

It is submitted that in British India possession with an exposure for sale is clearly a use of the invention such as will in itself constitute an actual infringement.<sup>26</sup>

#### Use for exhibition as samples for sale.

Since it was held in *Hudson Scott & Sons Ltd. v. Barringer Wallis & Manners Ltd.*<sup>27</sup> that exhibition as samples for the purpose of effecting sales was prior user so as to constitute an anticipation amounting to public knowledge, it has been suggested that use in that manner would, if the case were to arise, probably be held to be use amounting to an infringement also.<sup>28</sup>

**Possession alone need not constitute infringement : as where the absence of any intention to use is disproved : or possession of a bailee for repairs.**

In *British United Shoe Machinery Co. Ltd. v. Simon Collier, Ltd.*<sup>29</sup> where there was possession by the Defendant and it was shown

<sup>24</sup> (1900) 17. R. P. C. 723.

<sup>25</sup> (1835) 4 A & E 251.

<sup>26</sup> See also at page 535 above.

<sup>27</sup> (1906) 23 R. P. C. 79 at p. 87.

<sup>28</sup> See *Fletcher-Moulton* at p. 159.

<sup>29</sup> (1910) 27 R.P.C. 567 at p. 571. See also *Pessers Moody Wraith and Gurr Ltd. v. Newell & Co.* (1914) 31. R.P.C. 510 (possession without using till patent expired).

that the patented machine had not been used and would not be used it was held there was no infringement. (See the passage in that case cited below).

Similarly it would seem that mere possession as a bailee for repair will not in itself constitute an infringement: see *United Telephone Co. Ltd. v. Henry & Co.* (Below).

**Possession and lending only is not an infringement.**

In the *United Telephone Co. Ltd. v. Henry & Co.*<sup>30</sup> it was found that one Fisher trading as R. Henry & Co. allowed a person who was not a party to the suit to take away from the Defendant's shop premises on loan a certain telephone instrument which was alleged to be an infringement of the Plaintiff Company's patent. There was no other act of use or sale, established on the part of the Defendant. The Defendant stated the machine had been sent to him for repair, but he had not done and he had refused to do the repairs. It was held that what had been done by the Defendant being a mere lending of the instrument to the third party was not an infringement.

**Mere purchase and possession without more will not in itself constitute infringement.**

Possession of the invention alone may raise a presumption that the invention is used. And if there is no evidence to rebut the presumption it may be that this will be considered proof of use and accordingly of infringement.

Thus in the *United Telephone Co. Ltd. & Others v. London & Globe Telephone & Maintenance Co. Ltd.*<sup>31</sup> the Defendants had purchased and were in possession of machines the use of which, if used, would have been an infringement. A perpetual injunction was issued. The possession in that case appears clearly to have been possession with intention either to sell or to use.

But, apart from the operation of such a presumption, the actual possession alone is not such a use, ordinarily, as to constitute infringement in itself. The law on this point was clearly enunciated by Lord Duncedin in his speech in *British United Shoe Machinery Co. Ltd. v. Simon Collier Ltd.*<sup>32</sup> at p. 572 thus :—

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<sup>30</sup> (1885) 2. R. P. C. 11 at p. 12.

<sup>31</sup> (1884) 1. R. P. C. 117.

<sup>32</sup> (1910) 27. R. P. C. 567 (H.L.)

"I have no doubt that the possession of an installed machine by a manufacturer for the purpose of his business raises, as a rule, a presumption that it is used. Here that presumption has been rebutted by the admitted fact of non-user. But then it is said that the attachment here has been used because the machine is part of an equipment for the purpose of the business, although *de facto* it has not actually been employed.

I have no doubt there may be use of that character. Two illustrations have been given which were mentioned by my noble and learned friend on the Woolsack. In the one case, the case of fire extinguishing apparatus, the use, I think, consists in the actual provision of the means for extinguishment. In the other case, that of a spare steam engine, the spare steam engine is really an extra part intended in certain circumstances to be used for exactly the purpose for which the whole machine is being actually used. Here the dismantled part is meant to serve for a separate operation, namely, the making of a different shape of boot. I think that the evidence establishes two propositions: one that there was no intention on the part of the Defendants to make that shape of boot: and the other that there was no likelihood that they would be called upon to make it. That being so, I do not think it is enough to say that, if a sufficiently tempting order had come, they might have used the patented part of the machines. To say that, does not, in my opinion, stamp the attachment as an equipment for the purposes of the business."

The observations of Loreburn L. C. on the point are to the same effect: *viz* :—

"It is admitted that the Defendants had two machines, parts of which were said to be included within the Patent; and I think that there was a presumption of fact that the Defendants, being in possession of these articles, had either used them, or had them for the purpose of using them. But in point of fact it is admitted that the Defendants received these machines in a state in which the patented invention could not be used, and that they kept them in that state; and also that they never did in fact practically apply any part of the machine that was included within the Patent. But it is said that nevertheless there was a user by the Defendants, because they might at any time have connected up the patented part

of the machine with the remainder of the machine, and that they kept it as a stand-by to be made use of if occasion required.

Of course there may be a user if a patented article is kept as a stand-by. Lord Justice Moulton refers to one case in which that might happen ; and another was illustrated by a question of one of your Lordships, relating to the possible use of bottles containing liquid which would extinguish fire, if fire broke out. There may be such cases, no doubt, which I do not in the least intend either to try to specify or to try to define. But here I do not think that the patented article was used as a stand-by at all. No one of the learned Judges disputes the honesty of the witnesses who were called on behalf of the Defendants ; and I find no trace either of a disbelief in their statements on the part of any one of the learned Judges, or indeed of any argument to the effect they were undeserving of belief having been advanced in the Court below. The patented part of this machine was in fact of no use to the Defendants and was put aside by them, and they never thought of using the patented part, nor was it appropriate to their trade.

Lord Justice Moulton used language which I desire to adopt. He said "I think the fact that they never made these boots never thought of making them, never intended to make them, and that they used this machine largely for that for which they bought it, namely, for its use in other boots, clearly sets aside the ordinary inference that would be drawn from the presence of these machines on their premises. Unless we could say that the mere purchase of machines, which infringe, constitutes an infringement, I do not think we can find for the Appellants in this case."

**Merely clearing through the Customs held not an infringement.**

It has been held, in *Nobel's Explosives Co. v. Jones Scott & Co.*<sup>33</sup> that the acting merely as Customs House Agents for an importing firm was not a use of the invention so as to constitute infringement.

The following are certain of the observations made by James L.J. in the course of his judgment in the Court of Appeal in that case :—

"What is actionable, and what the Plaintiffs' rights are, is shewn by the letters patent themselves. The rights of the patentee,

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<sup>33</sup> (1881) 17. Ch. D. 721.

which nobody can infringe, are that the patentee and his assigns, and no others, may during the term make, use, exercise, and vend his said invention. Can anybody say that going to the Custom House and writing to the Custom House for Krebs & Co. for a warrant to discharge things from a ship into a barge is making the invention? Is it using it—is it exercising or vending it? It seems to me it is neither making, using, exercising, nor vending the said invention. Krebs & Co., the persons who had the control over it, or the persons who had the possession, may, in one sense, be said to be using it; having regard as Mr. Aston said, though I do not think it is necessary for us to determine the point, to the particular nature of the invention in this case, which was one by means of which every drop of the highly explosive thing nitro-glycerine is coated with some other material in such a way as to make it storeable, movable, and transportable with safety. Therefore, as the effect and utility of the patent, according to Mr. Aston's view—and he may be right in that—was the safety communicated to the nitro-glycerine by means of the particular invention, if Krebs & Co. were to bring the thing into this country for the purpose of sending it abroad, even without either opening the packages, if the packages were on board a ship or in a warehouse in England, and there stored *bona fide* with a view of being sent out of this country, it is possible that they might be held to be using it in this country nearly in the same sense as persons were held to be using Betts' Patent Capsule, because Betts' Patent Capsule was protecting the liquor in this country, which was the use of the invention. But a man who has no possession of the thing, and has no control over it, and who has no dominion or power to deal with it, to whom the safety or the want of safety is not of the slightest consequence, cannot be said to be using the invention; and that is the only way in which it could be said that these letters patent were infringed. And as of course nobody could pretend to say that he was making, exercising or vending it, it does not come within either of those. It is not necessary to go through the prohibitory words, which do not carry it any further."

In that case there was no actual transportation of the goods by the persons who were the Defendants: and as was observed by James L. J. and also by Baggallay L. J.<sup>34</sup> there was not even actual

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<sup>34</sup> See *ibid* at pages 741 and 745.

possession by the Defendants of the goods embodying the patented invention.

### Transportation.

Transportation may constitute infringement when such transportation is in such circumstances that there is a continuing use of the invention. Thus in *Betts v. Neilson*<sup>35</sup> the patented invention was for metal capsules for containing beer in bottles. The patent in suit did not extend beyond England, Wales and the town of Berwick-upon-Tweed and did not extend to Scotland. The Defendants sent capsuled bottles from Scotland into England for the purpose of exportation from England. Therefore, as it was put in the speech of Lord Westbury, "Whilst the bottles travelled through England, as soon as they passed the border there was an user of the capsules by the Defendants and the capsule was performing its proper function during the whole time of the transit of the bottles through England and their remaining in England until they were exported." As it was put in the speech of Lord Colonsay :—"No doubt the capsules were made elsewhere ; no doubt they were in the first place applied to the bottles elsewhere ; but still they were used for the benefit and profit of the Defendants all the time they were passing through England, or lying in England to be shipped to other places.....; they were performing their use and their purpose during the whole time". In those circumstances it was held in effect that by the transportation of the beer in bottles fitted with the capsules there had been an infringement on the part of the Defendants by use of the patented invention.

Similarly in *Nobel's Explosive Co. v. Jones Scott & Co.*<sup>36</sup> the Patent related to an invention for making the handling of nitro-glycerine less dangerous, by causing it to be absorbed in porous non-explosive substances. By means of the invention a substance called lithofracteur was produced which was extensively manufactured and dealt in by the Plaintiffs and was used, as it appears, in connection with the packing, storage and transportation of nitro-glycerine. On the point now under consideration Bacon, Vice-Chancellor, made the following observations :—

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<sup>35</sup> (1868) 3. Ch. App. 429 and (1871) L. R. 5. H. L. 1.

<sup>36</sup> (1881) 17. Ch. D. 721.



"Stopping at this part of the case, I have to consider the first ground on which the Defendants rely. It has been argued on their part that the manner in which the lithofracteur was dealt with does not constitute a user or exercise of the Plaintiffs' patent : that the merely procuring the delivery from the ships in which the commodity was carried, and the subsequent transshipment thereout into lighters, by which it might be carried elsewhere, such acts being done within this realm, were innocent acts by the Defendants, by which they neither used nor exercised the invention which is the property of the Plaintiffs.

Having regard to the nature of the invention, and that its most essential quality is that it acquires for nitro-glycerine "the property of being in a high degree insensible to shocks," it appears to me that it is impossible to tranship, or in any manner to handle or move the commodity made according to the invention, without at the same time using the invention.

In *Betts v. Neilson*<sup>37</sup> a case I am about to mention more particularly, the invention consisted of a method of combining metals of which capsules were made, and when made, usefully applied, to bottles of liquid, whereby external air was excluded and the contents protected from deterioration. The Defendants bottled beer in Scotland to which they applied the patentee's invention, and sent it so bottled to England, not for sale there, but for the purpose of being exported thence to foreign parts. The Defendants there insisted that doing this was no infringement ; that the beer was merely *in itinere* in England ; and that its resting there with English agents was no such active use of the capsules as could constitute an infringement. It was decided in that case, as well by the Vice-Chancellor Wood as by the Lord Chancellor, and subsequently in the House of Lords, that this was a direct infringement of the patent.

The Vice-Chancellor said<sup>38</sup> "The capsules then were in use for the very purpose for which they were invented."

The Lord Chancellor (Chelmsford), on hearing an appeal from the Vice-Chancellor, expressed himself thus : "With respect to the

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<sup>37</sup> L. R. 3. Ch. App. 429.

<sup>38</sup> N. R. 221, 222.

case of the article being brought into an English port and remaining on board the vessels, and transhipped for exportation, if the mode of transmission adopted by the Defendants amounts to the user of the capsule in England, I can see no distinction on principle between the patented article being placed in a warehouse on land, and the ship in which it is brought from Scotland being made the warehouse until it can be put on board another vessel for exportation".<sup>39</sup> And, again : "It is the employment of the machine or the article for the purpose for which it was designed which constitutes its active use ; and whether the capsules were intended for ornament, or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors."<sup>40</sup>

In the Court of first instance there was accordingly a decree passed in favour of the Plaintiff Company. On appeal by the Defendants this decision was reversed, but not on the point which has been referred to, (whether transportation in the circumstances mentioned would have amounted to a use constituting an infringement) ; but on the different point that the Defendants themselves as clearing agents only had not had possession of the goods and, in effect it is submitted, were not the persons transporting the goods. The point on which the Vice-Chancellor's observations have been referred to was not decided in the Court of Appeal : *viz.* whether if the persons who had had possession of the goods and had been transporting them had been sued, they would or would not have been liable.

It is submitted therefore that the principle enunciated by the Vice-Chancellor is a correct statement of the law on the point.

In the light of what was said in the two cases last mentioned the full meaning becomes readily understood of the passage on this point in the judgment of Lord Alverstone L. C. J. in *British Motor Syndicate Ltd. and others v. John Taylor & Sons Ltd.*<sup>41</sup> to the following effect :—

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<sup>39</sup> L. R. 3 Ch App. 429 at p. 438.

<sup>40</sup> L. R. 3 Ch. App. 429 at p. 439.

<sup>41</sup> (1900) 17. R.P.C. 723 (C. A.) at p. 730.

"The question of whether there is infringement by transporting from place to place depends entirely upon what is protected by the Letters Patent and what is the nature of the invention which has been used : and speaking for myself I should equally wish to reserve consideration of that point. There may be transportation which would be no infringement ; there may be transportation as in *Neilson v. Betts* which undoubtedly would involve infringement."

#### **Contracting in British India for sale abroad.**

It is clear it is submitted that the making in British India of a contract for sale abroad of a patented article is not an infringement of an Indian Patent. If any authority should be desired for this view reference may be made to the case of *Saccharin Corp'n. Ltd. v. Reitmeyer Co.*<sup>42</sup> where it was conceded that such a contract was not a "use" of the invention, and it was held that it was not even an "exercise" of the invention within the wording of the English grant. The decision in that case was followed in the House of Lords in *Badische Anilin und Soda Fabrick v. Hickson*.<sup>43</sup>

#### **Using for purposes of experiment only.**

It would seem that a person using the patented article purely for purposes of experiment may in certain cases be free from being held to infringe, on the same principles as have been mentioned in connection with cases of manufacture for purposes of experiment.<sup>44</sup>

#### **Defence of licence from the Patentee.**

It will be a good defence to a claim for infringement of Patent that the Defendant was lawfully entitled to do those acts by reason of a licence granted to him from the Patentee. This will be so whether his case is that the Patentee and the Plaintiff are the same person or not. In this respect the matter is on much the same footing as a defence of leave or licence granted by the owner to the Defendant in a suit for trespass. The onus of establishing such licence and the fact that the thing complained of was covered by the licence is of course on the Defendant. In connection with the

<sup>42</sup> (1900) 17. R.P.C. 606 at p. 611.

<sup>43</sup> (1906) 23. R.P.C. 433.

<sup>44</sup> See page 554 ante.

See *Scott v. Hull Steam Fishing and Ice Co. Ltd.* (1897) 14. R. P. C. 143.

question of the availability to a Defendant of the defence that he had at the time of the alleged infringement a licence, express or implied, it may not be out of place to note here certain points affecting the grant and extent and nature of licences generally.

### **Power of patentee to grant licences.**

Under the form of Letters Patent in use in Great Britain it is expressly mentioned in the grant that the patentee shall have the right to grant licences to other persons. Thus the grant of the patent by the Crown is not personal exclusively to the patentee ; and has never been so regarded.

Under the form of grant in use in British India there is no express mention of licences under that term : but (what comes to the same thing), after it is stated in the grant that the grantee shall "have the exclusive privilege of making, selling and using the invention.....", the grant goes on to add the express words "and of authorising others so to do." This power is repeated in Sec. 12(1) of the Act of 1911. The whole scheme of the Indian Patents and Designs Act is founded on the assumption that the patentee has a right to grant licences as well as to assign his patent. And by Section 63(3) in particular of the Act of 1911 it is expressly provided that he has such power. The section reads as follows :—

"63(3) The person registered as the proprietor of a patent ..... shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent .....and to give effectual receipts for any consideration for any such assignment, licence or dealing.

Provided that any equities in respect of the patent..... may be enforced in like manner as in respect of any other movable property."

### **Licence how differs from assignment.**

The difference is well stated in *Terrell on Patents* (8th Edn.) at p. 253 as follows :—

"There is a fundamental distinction between an assignment of a patent and a licence under a patent. By the former the assignee stands, when registered, in the shoes of the

assignor, and is fully entitled to deal with the patent and to sue in respect of infringement thereof. A licensee, on the contrary, is merely permitted to do acts which would, but for the licence, be prohibited, that is to say, to use the invention, as distinct from using the monopoly right which was conferred upon the patentee in respect of his invention. Other contractual rights as between the parties may be created by the licence, as in the case of an exclusive licence, where the patentee contracts not to grant other licences, but no rights can be conferred as between the licensee and the public."

**Licence personal unless agreed to the contrary.**

In the absence of agreement to the contrary, express or implied, a licence is personal only to the licensee. He is not entitled therefore to assign it or to grant sub-licences thereunder to other persons.

**Sub-licence : Licence or benefit thereunder is transferable by sub-licence when so agreed.**

The terms of the licence will depend on the wording thereof and the terms intended to be made between the contracting parties. If it is expressly stated that the licence is granted to the licensee and his assigns or that the licensee is entitled to grant sub-licences, then he is legally fully entitled to do so. There is nothing to prevent a licence being granted on these terms : the matter being entirely a matter of arrangement between the contracting parties. If the licence is merely granted "to the licensee and his assigns" this will be construed as giving the licensee a right not only to assign but to grant sub-licences. If there is anything which shows that there was an intention that the licence should not be limited exclusively to the individual the licence may be construed as carrying a right to assign or to grant sub-licences. See *Lawson v. Donald Macpherson & Co. Ltd.*<sup>45</sup>

**Sub-licence arising on estoppel.**

Even if the licence itself is not expressed to give the licensee the right to grant sub-licences, yet if the patentee accepts royalties from the sub-licensee, it would appear that he may be estopped from disputing the sub-licensee's right to the licence.

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<sup>45</sup> 14 R. P. C. 696 at 697 & see *Terrell* p. 241.

**Form of licence.**

The form of grant of the patent as used in India contains no reference to the nature of licences to be granted by the patentee and no restriction in respect of the form in which they may be granted.

An agreement to grant a licence will be effective whether verbal or in writing.

If in writing it will require to be stamped with a twelve-anna stamp as an agreement. (See the Indian Stamp Act, Art. 5).

**Registration of licences.**

Section 20 of the Act of 1911 provides for the keeping at the Patent Office of the Register of Patents and for the entry therein of licences. It is also provided under Section 63(2) of the Act of 1911 as follows :—

“63(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a patent ..... he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents ..... with particulars of the instrument, if any, creating such interest.”

It is further provided by Section 63(3) to which reference has already been made above (at page 571) that an assignment or licence can only be granted by the patentee “subject to any rights appearing from the register to be vested in any other person”, and “provided that any equities in respect of the Patent or design may be enforced in like manner as in respect of any other movable property”.

Since the effect of these two sub-sections is that if the licence is registered the patentee cannot afterwards grant any further licences or deal with the patent except subject to that licence, it is highly advisable for a licensee to obtain registration of his licence at the Patent Office as early as possible.

There is this further reason why he should do so. If the licence is in writing, it may be found to be inadmissible in evidence in Court unless registered. This is the effect of the provisions of Section 63(4) which is as follows :—

"63(4) Except in the case of an application made under Section 64, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) shall not be admitted in evidence in any Court in proof of the title to a patent.....or to any interest therein, unless the Court, for reasons to be recorded in writing, otherwise directs."

Furthermore it is provided under Section 20(3) of the Indian Patents & Designs Act of 1911 as follows :—

"(3) The register of patents shall be *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein."

Thus there is the positive advantage from registration that the entry in the register, by being *prima facie* evidence, will in most cases be sufficient evidence of itself of the licence : and the positive disadvantage from non-registration, ordinarily, of inadmissibility.

Provision is made for the supply on request of certified copies of the entry of such a licence under Section 59.

#### **Defence that the Defendant is an express licensee.**

A Defendant will of course, have a clear defence against a claim for infringement if he can show he has been granted an express licence from the Patentee which was current at the time of the alleged infringement and covers the act complained of.

Where there are Joint Patentees it may be that a licence will be not effective if not granted by all.<sup>46</sup>

#### **Implied licensee.**

It will furthermore be a good defence against a claim for infringement if the Defendant can establish that in the circumstances of the case he was at the time of the act complained of an implied licensee of the Patentee.

A class of case where such a defence will be available is where there has been a sale or manufacture by the rightful patentee or his agents abroad and a subsequent importation by the Defendant into

<sup>46</sup> See *In re Horsley & Knighton's Patent* (1869) L. R. 8 Eq. 475 at p. 477 ; see also *Terrell* at p. 276.

British India, since such original sale by the Patentee (in the absence of special restrictive clauses in the contract of sale) carries with it an implied licence generally to use or deal with the patented articles freely, including a right to import into and re-sell in British India. The leading case in which this principle of law was clearly stated is *Betts v. Wilmot*.<sup>47</sup>

If a patentee sells the patented article abroad without imposing in the contract of sale any special conditions, such sale implies the grant of authority to use and sell it co-extensive with the right of the vendor at the date of the sale.<sup>48</sup>

Accordingly the buyer is entitled to import the article into British India and sell it in British India. Should he do so and be sued for infringement his ground of defence, properly stated, is that he has been licensed to do so by the patentee.

Another class of case where the Defendant may be relieved of liability on grounds which may properly be described by stating that in the circumstances of the case he has been granted an implied licence from the Patentee, is where the act complained of as being an infringement has been done by the Defendant at the directions of the Patentee or of an authorised agent of the Patentee. The leading case which is an illustration of this class of case is *Kelly v. Batchelar* (1893) 10. R. P. C. 289. See also *Henser and Guignard v. Hardie*<sup>49</sup> where it was observed by Charles, J. as follows:—

"The particulars of breaches do not complain of the manufacture of the machines. It is quite clear Mr. Crichton meant no harm in manufacturing them, and it may not be that he was guilty of infringement by manufacturing them; but I cannot consider it because the Particulars of Breaches do not complain of the manufacture of them at all. The Particulars of Breaches complain of their use, first at Chester, and then at Birkenhead and other places, in a stage competition or stage race, and I have had described to

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<sup>47</sup> (1871) 6 Ch. App. 239. Distinguish *Societe Anonyme de Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.* (1884) 25. Ch. D.1. For an application in a passing off suit of a somewhat similar principle see *Bonnan v. Imperial Tobacco Co. Ltd.* (1923). 50 Cal. 762 and (1924) 51 Cal. 892 (P. C.) at p. 900.

<sup>48</sup> See *Terrell* p. 242. See *Gillette Safety Razor Coy. Ltd. v. A. W. Gomage Ltd.* (1908) 25. R. P. C. 492.

<sup>49</sup> (1894) 11. R. P. C. 421 at p. 427.



me exactly what occurred at Chester, when Mr. Guignard went down to Chester to see his own machine. When he got to Chester he was very much surprised and annoyed obviously at finding that Mr. Crichton had manufactured a couple of other machines, copies of his own, and he said at once, "Here is an infringement". A conversation ensued between the parties; they were on perfectly friendly terms at the time, and according to Crichton—and I see no reason to doubt him—he said "If you really object so strongly to this, I will not use them at all." "Oh, no" said the Plaintiff, "I should not like to do that; let them be used, and I will consult my solicitor when I return to London and see what shall be done for the future." Thereupon, used they were, and according to the Plaintiff on one evening, and according to the Defendant on three evenings, Mr. Guignard actually rode his own machine on the stage, and after the stage race had been given, he gave an extra performance to show the merits of his own machine, which was highly appreciated by the public, and I think he was called before the curtain on more than one occasion. At any rate, on one occasion he was certainly led before the curtain by Mr. Crichton and complimented by the audience. Under these circumstances, for the performances at Chester, it seems perfectly idle to ask me to give either damages or to grant an injunction. What on earth are the damages that I could give under the circumstances which have been proved in my hearing with regard to Chester? I should have had the greatest difficulty in giving the smallest coin, even without the evidence, because Mr. Guignard suffered no damage that I can see beyond the mere infringement of his legal right through what occurred at Chester. He cannot ask me for damages for the mere infringement of his legal right—he cannot ask me for one shilling, because, in my judgment, the whole of the proceedings at Chester were proceedings by his actual leave and licence. It is news to me to hear that that is not an answer to a claim for damages just as much as it is with regard to a claim for an injunction. Therefore, I decide, as regards the Chester performance, that there is no ground for either damages or an injunction."

It may be noted however, as is pointed out in *Fletcher-Moulton* on Patents<sup>50</sup> that in the majority of Patent cases the evidence of

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<sup>50</sup> See page 162.

infringement is a sale to an agent of the Patentee, and that no defence of any implied licence arises ordinarily in such a case.<sup>51</sup>

The distinguishing test appears to be whether the agent of the Patentee, who will have gone with the express purpose of purchasing an article which he hopes may turn out to be an infringement, has given express or clear instructions to do a particular act which amounts to an infringement or not.<sup>52</sup> In the case of *Kelly v. Batchelar* he gave explicit directions to the Defendant how to make the article (a ladder) in such a way as would otherwise have amounted to an infringement. In cases where he merely places an order for the purchase of an article and leaves it to the Defendant to choose whether he will supply the order or not, and what nature of article he will supply to meet the order, there will not be held to be any implied licence created.

**The scope of the licence must cover the alleged infringing act.**

Of course it will be open to the Patentee to refute the defence that the Defendant was a licensee by showing that, though the Defendant had indeed a licence, such licence did not cover the scope of the particular act done by the Defendant and complained of by the Plaintiff as being the infringement: or did not cover the locality in which the act was done: or that such licence was issued only on conditions which the Defendant had failed to perform. A Patentee, as to the sale which he licenses by distributors of his patented article, may impose conditions. As such a condition he may stipulate a minimum price. It will then be no defence for a Defendant to plead the general licence, if he has sold above the minimum price.<sup>53</sup>

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<sup>51</sup> There have been from time to time several pronouncements of the Courts as to the proper and improper method of placing trap-orders. See *C. C. Wakefield & Co. Ltd. v. Purser* (1934) 51. R.P.C. 167 at p. 1714 (a passing-off action); compare also *Alfred Dunhill Ltd. v. Griffiths Bros.* (1934) 51. R.P.C. 93 at p. 96 (a patent action).

<sup>52</sup> See *Dunlop Pneumatic Tyre Co. v. Neal*. (1899) 16. R. P. C. 247.

<sup>53</sup> See *eg. Huntoon Co. v. Kolynos Inc.* (1930) 47. R.P.C. 403 (C.A) and *Bussell v. Graydon* (1897) 14. R.P.C. 701 (H. L.); and see *Terrell* (8th edn.) at p. 235: as to the nature of the acts authorised by the licence. See *Fuel Economy Coy. Ltd. v. Murray* (1930). 2 Ch. 93 (CA) (as to locality); *Alfred Dunhill Ltd. v. Griffiths Bros.* (1934) 51. R.P.C. 93 (as to price).

### **Defences that the Defendant was a Joint Patentee or the Agent of the Patentee or an Agent of a Joint Patentee.**

A Joint Patentee has a right to make, sell and use the invention independently of his co-Patentee or co-Patentees. In a case therefore where there may have been a dispute between two persons as to who was the true and first inventor and finally the Controller may have made a grant of the Patent in the names of both persons, jointly, if these persons thereafter choose to do business in competition against each other, neither will be entitled to claim for infringement against the other.

Since a Patentee is not bound to do all the manufacturing or selling of his patented article himself, alone, but is entitled to employ agents and servants for the purpose of his business in connection with the exploitation of his patented invention, it follows that it would be a good defence to a claim for infringement if the Defendant be in a position to establish that in doing the act complained of he was himself acting as the Agent or servant of the Patentee. Though such a case may be seldom likely to arise, it is not impossible to visualize such a case in relation to some business where there is a world-wide selling organisation, in which it may be, on occasions, extremely difficult to define the precise legal relationship of one party with another, or to decide whether the person against whom the claim for infringement has been made was acting at the time as an agent or on his own account.

A similar defence would be available if the Defendant were to be in a position of an agent of another person who was a joint-patentee of the Plaintiff.

### **The defence of innocent infringement.**

It is provided by Section 30 of the Indian Act as follows :—

“30. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any Defendant who proves that at the date of the infringement he was not aware nor had reasonable means of making himself aware, of the existence of the patent, and the making of an article with the word “patent” “patented”, or any word or words expressing or implying that a patent has

been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent :

Provided that nothing in this section shall affect any proceedings for an injunction."

Innocent infringement within the terms of this section will thus be a complete defence against a claim for damages for infringement. It will not however be any defence against a claim for an injunction. Nor can it be said, in a case where a Defendant has acted innocently within the terms of this section, that there has therefore been no infringement committed.

It is to be observed that the only grounds of exemption from liability for damages are ignorance of the existence of the Patent.

Apart from this, neither the presence or absence of any particular intention or the possession or non-possession by the Defendant of any particular knowledge have any bearing on the question whether there has been an infringement of a Patent or not. The position as to this has been lucidly summed up in the following remarks :—

"The fact that a man may, while acting in perfect innocence, yet be guilty of infringement seems clearly recognised by S. 33 (*i.e.* of the English Act) See also *Stead v. Anderson* (1847) 2. W. P. C. at p. 156. See also remarks of Erle C. J. in *Walton v. Lavater* (1860) 29. L. J. (C. P.) at p. 279, and of Parker B., in the H. L. in *Heath v. Unwin* (1844), 5. H. L. C. at p. 537. The L. C. in *Stevens v. Keating* disapproved of the idea that intention to infringe must be proved, as appears from the judgment of Shadwell, V. C. in *Heath v. Unwin* (1844) 15 Sim. at p. 533. The contrary view, expressed in the judgment of the Court of Exchequer in *Heath v. Unwin* (1844) 2. W. P. C. at p. 227, and by some other judges, cf. *Seed v. Higgins* (1858) 27 L. J. (Q. B.) 417, *Jones v. Pearce* (1832), W. P. C. at p. 125, has never been followed in modern times, and seems utterly opposed to all principles of English civil law".<sup>54</sup>

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<sup>54</sup> *Fletcher Moulton* at p. 161 note 14.

**As to an alleged defence that the Defendant was acting merely as an agent of another.**

It is obvious that the full liability of infringement attaches to any dealer who as principal sells in British India goods manufactured by a third party, if they are of the nature of infringing goods. Thus the patentee is in no way confined to a suit against the original manufacturer. This aspect of the matter is one which it is well for merchants in India who import and sell goods of other manufacturers to bear in mind : since it will be no defence for them to plead that they were not responsible for the manufacture of the goods.

Moreover it is no defence in itself for the Defendant to plead that he was not acting in connection with the act complained of as a principal, but merely as an agent for another.

He is not exempt from personal liability for infringement no matter whether his principal is a person who resides and carries on business outside British India or within it.

The liability for an act of infringement of a Patent being of a tortious or semi-criminal character, it is inevitable (subject to what has been said above as to an innocent infringer) that the person actually committing the act must be personally liable.

It has been stated however that suits against mere workmen who innocently help in an infringement, and are not the really guilty persons, will not be encouraged.<sup>55</sup>

**As to an alleged defence that the Defendant though a principal or master at whose orders or on whose behalf the act was done, did not do the act complained of himself.**

Where the act of infringement has been done by one person on behalf of another who is his principal or master, it will be no defence for the latter to plead that he did not commit the act himself.

A person may infringe a Patent through his agents or servants.<sup>56</sup> The legal liability of the principal or master has been stated as follows :—

“Of course a principal may be liable for the infringement of his agent, and a person may also be liable for infringement if he has

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<sup>55</sup> See *Savage v. Brindle* (1896) 13. R. P. C. 266 at 267 ; also *Terrell* p. 168.

<sup>56</sup> See *Terrell* (8th edn.) p. 163.

really had a hand in the manufacture or sale of the infringing article though not actually committing these acts himself. Thus the Directors of a Company were held liable for the infringement by the servants of the company in the course of their duty, although such infringement was against their express orders. Apparently the company were also considered liable, *Betts v. De Vitrie* (1864) 3 Ch. App. 441. So where a father had allowed his sons to carry on business in his name he was held responsible for their infringements; *Day v. Davies*, 22 R. P. C. 42. See also *Anderson v. Patent Oxonite Co.* 3. R. P. C. 279; *Incandescent Gas Light Co. v New Incandescent Manlle Co.* 15. R. P. C. 81; *Same v. Brogden* 16. R. P. C. 179; *Sykes v. Howarth* (1879) 48. L.J. (C.H) 769; but of *Savage v. Brindle* 13 R. P. C. 266".<sup>57</sup>

It is submitted that the liability of a person who is either a principal or a master of the person who may have actually committed the infringing act, will be determined by the ordinary principles of the common law governing the liability of a principal for torts committed by his agent or of a master for torts committed by his servant.<sup>58</sup>

**Defence that the Patent was granted or extended or restored on certain conditions and that the Defendant is within those conditions.**

It has already been noted that the Controller is empowered to make a grant of a Patent under conditions: that is "such conditions (if any) as the Governor-General in Council thinks expedient" under Section 10(1). Reference has also been made to the usual conditions, commonly referred to as the Thompson-Houston conditions, upon which a Patent is usually extended if an order for extension is made.<sup>59</sup> In such a case if the Defendant is a person authorised to manufacture or sell or deal with the invention in any particular respect and if the act complained of as being an infringement is nothing more than his doing what he is entitled to do under the conditions mentioned, he will clearly have a good

<sup>57</sup> *Fletcher Moulton* at p. 16.

<sup>58</sup> As to which see *Salmond* (8th edn. 1934) at. pp. 25, 29, 71 & 79; *Clerk and Lindsell* (8th. edn.) at p. 64. See also *Kestos Ltd. v. Kempat Ltd. and Another* (1936). 53 R.P.C. 139 (where the question of the personal liability of a Director arose).

<sup>59</sup> See page 73 & pp. 519, 526 above.

defence to the claim made against him for infringement. Whether he can establish such a defence will be a question primarily of fact dependent on the circumstances of the particular case.

**Defences relating to rights enjoyed peculiarly by Government.**

In certain circumstances where the Defendant is a Government servant, certain defences may be available which arise under Section 21 of the Indian Patents & Designs Act of 1911, or where the Patentee is also a Government servant by virtue of the conditions on which the Patent may have been granted to him by reason of the conditions of service of a government servant under Fundamental Rule No. 48A. The circumstances in which such defences may arise have been indicated in Chapter XIV.

**Defence that the Plaintiff was not the registered Patentee at the date of the institution of the suit.**

By Section 29(1) it is provided as follows :—

“29(1). A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells, or uses the invention without his licence, or counterfeits it, or imitates it.”

And by Section 2(12) a Patentee is defined as follows :—

“2(12) “patentee” means the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent.”

From the combined provisions of these sections it would appear that it is a condition precedent to the institution of a suit for the infringement of a Patent that the Plaintiff should be the registered Patentee.

In a case where a person entitled to the benefit of a Patent desires to take proceedings in respect of its infringement but is not the patentee entered on the register of Patents, it will be advisable for him to take the necessary steps prior to the filing of his Plaint to have his name entered on the register as the Patentee and if necessary to take any proper steps for the rectification of the register.

A question arises whether the terms of Section 29(1) demand

that the Plaintiff should in all cases be the registered Patentee at the time of the institution of the suit or whether a person who was the registered Patentee at the date of the infringement may nevertheless institute a suit although he is not the registered Patentee at the date of the filing of the Plaint. Such a case will arise for example where there has been an assignment of the Patent to another person since the date of the alleged infringement. It is submitted that the person who was the registered Patentee at the date of the infringement may file a suit in his own name in such circumstances and that in doing so he is not transgressing any of the requirements of Section 29(1).

A converse of this case arises, where a person, who has by assignment become the owner of a Patent, may have come to hear of an infringement of the Patent having been committed at a time prior to his becoming the registered Patentee. He will then be in the position of being the registered Patentee at the date of suit, though he will not have been such at the date of the infringement. Can he sue? In such circumstances it may be that he will have no cause of action on which to sue; since it will be unlikely that any right to sue for prior infringement will have been transferred to him by his assignment. (Such a defence is indicated under Defence No. 25 in Chapter XIV). But it may be that by reason of the particular circumstances of the case he may be able to show that he has a cause of action for an injunction to restrain the Defendant from committing any infringement thereafter; even though not for damages.

**The defence that though the Plaintiff is purporting to sue by virtue of an assignment, there has in truth been no valid assignment.**

It has already been seen that the terms of Section 29 read with Section 2(12) of the Act restricts the right to institute a suit for infringement to the person registered as the grantee or proprietor of the patent. A person may therefore be an assignee by a full and valid assignment, but if he has not been registered on the Register of Patents as the registered assignee he will not be competent to sue.

Since it is provided by Section 20(3) that "the Register of Patents shall be *prima facie* evidence of any matters by (the) Act directed or authorised to be inserted therein", it follows that if the



Plaintiff is the person entered as the registered Patentee on the Register of Patents, this is *prima facie* proof of the validity of the assignment on which he relies.

On the other hand as the effect of Section 20(3) quoted above is not conclusive as to the validity of any assignment but merely raises a presumption that such assignment is valid, it would seem that it will always be open to the Defendant to rebut this presumption and to establish the non-validity of the assignment in the suit itself.

In some cases it may be advisable for the Defendant to take proceedings for the rectification of the Register of Patents before suit in order to have the name of the proper person entered therein as the registered Patentee.

That is however another matter. What is now being considered is the validity of the Plaintiff's alleged assignment in itself.

Certain matters affecting the assignment of patents may conveniently here be referred to in so far as they are likely to affect a defence in an infringement suit.

#### **Power of a Patentee to assign his patent.**

The grant of a patent being originally personal to the grantee, it has been held that originally at Common Law a patentee had no power to assign his patent at all unless expressly authorised to do so by the Crown.

There was at one time a condition universally inserted in the grant of all patents to the effect that it would be illegal for the grantee to assign to a body of more than 5 persons. For a case on a bond relating to such a patent, see *Duvergier v. Fellows*.<sup>60</sup> In that case one Jean Jacques Saint Mare was the patentee of a patent for a process of distillation from potatoes. He and the Defendant Fellows were carrying on together (in partnership) the business of a distillery, utilizing the patented process. Being desirous of selling the business and the patent they entered into an agreement with the Plaintiff Aime Duvergier to pay him £ 10,000 if he should obtain purchasers of the Patent and the business. This sum of

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<sup>60</sup> (1828) 5 Bing. 248 or 133 Eng. Rep. 1056 (in the Court of Common Pleas); the same (1830) 10. B. & C. 826 at p. 829 or 109 Eng. Rep. 655 at p. 657 (in Error); the same 1 Cl. & F. 39 or 6 E. R. 831 (House of Lords).

£ 10,000 was to be payable by them in instalments : £ 3,333-6-8 on the completion of the purchase by the shareholders and payment of a first call on the shares, £ 3,333-6-8 on payment of a second call on the shares, and £ 3,333-6-8 on payment of a third and final call on the shares. The bond was conditioned to become void on the payment of the full £ 10,000 after performance of his part of the agreement by the Plaintiff. The Plaintiff sued on the bond. It was held the bond was unenforceable and void, among other reasons because the Patent could never have been legally assigned. In his judgment on the hearing of the appeal, in error, Littledale J. observed :—"All monopolies are illegal unless allowed by a patent, which cannot be assigned at all unless power to that effect is given by the Crown. The plaintiff, therefore, was bound to see and ascertain that these patents might be assigned in the manner proposed."

This ancient principle of the Common Law has long since come to be of no more than academic interest : since the very terms of the grant itself, equally in the form now in use in British India as in that now in use in the United Kingdom, expressly ordains that not only the Petitioner himself but "his legal representatives *and assigns* or any of them" shall have the exclusive privilege mentioned in the grant. From this it would be clear, even apart from any further statutory provisions, that at Common Law alone the Patentee has full power to assign his Patent to whom he pleases.

Further to this there are the express provisions in the Indian Patents & Designs Act of 1911 contained in Section 63(3) which give to the registered patentee power "absolutely to assign" his patent.<sup>61</sup>

It is therefore abundantly clear that a patentee in British India has full power and freedom to assign his patent to whom he pleases.

When there is more than one co-patentee the question whether there can be an effective assignment by one patentee only, or whether all must join in the assignment may depend on the ordinary

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<sup>61</sup> For sections in the English Act providing for assignments see Section 71(3) and Section 14(1). In India there is no express provision in Section 12 for such locally restricted assignments as are provided for in Section 14(1) of the English Act.

principles of law regulating the transfer of a chose in action by co-owners.<sup>62</sup>

### **Power of assignee to re-assign the patent.**

It follows, provided the necessary formalities have been observed by the first assignee in having himself registered as proprietor of the patent and in completing his title, that this first assignee can similarly assign the patent again to a second assignee.

There can be no question in such a case, as in the case of the granting of a sub-licence, whether the original transferor to the assignee intended him to have the right to assign the patent on to a third party : for there having been an assignment in the first place the assignee stands in the shoes of the original grantee of the patent and is the proprietor in law of the patent and can deal with it as he likes. He clearly has the same rights to assign as the original patentee had. Where a question may arise however is where the first assignment was made, as it may be made, subject to certain conditions : as for example the payment of royalties. Then the first assignee cannot assign the patent so as to avoid the conditions. The question may arise in a particular case as to who is responsible for the performance of those conditions whether the legal obligations rest only with the first assignee or whether they have passed, on the second assignment, with the patent, so as to fall on the second assignee. As a defence in a suit for infringement such matters will not ordinarily arise ; the only question, if the Plaintiff sues as assignee and the Defendant disputes his title, will be whether there has been a valid assignment to the Plaintiff so as to give him a right to sue or not ; and equally, if the Defendant relies on an assignment from the Patentee to the Defendant or to a third party the only question will then be whether there has been a valid assignment from the Plaintiff so as to deprive him of the right to sue or not.

### **Writing necessary to effect a transfer of a Patent.**

Under Section 9 of the Transfer of Property Act it is provided that :—

“A transfer of property may be made without writing in every case in which a writing is not expressly required by law.”

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<sup>62</sup> See also *Terrell* (8th edn.) at pages 253 & 274.

Section 54 of that act makes writing necessary in the case of a sale of a reversion or other intangible thing ; and Section 130 makes writing necessary in the case of all transfers of actionable claims. It is submitted that a patent is not an intangible thing within Section 54. The question then is whether a patent is an actionable claim.

The term "actionable claim" as used in the Transfer of Property Act corresponds largely to the term "chose in action" used in English law. In English law movable property was said to be either in possession and enjoyment and therefore a chose in possession ; or out of possession, but realizable by action, and therefore a chose in action. A chose in action is in English Law a term used to describe all personal rights of property which can only be claimed or enforced by action and not by physical possession. In *Colonial Bank v. Whinney*<sup>63</sup> the Court pointed out that the term was used in different ways to include not only the right to obtain something not in possession or enjoyment but also certain classes of incorporeal personal property. It is also used to denote a document evidencing a right or title. Accordingly choses in action include (in English law) debts, benefits of contract, damages for breach of contract or tort, also stock, shares and debentures and even such incorporeal rights as patents, copyright and trademarks.<sup>64</sup>

From this it is clear that a Patent would be considered under English Law in the United Kingdom to be a chose in action.

Now the previous definition under Indian law of an actionable claim was contained in Section 130 of the Indian Transfer of Property Act. This was clearly intended to include all things which would have been included in the English term "chose in action" in the widest use of that term. This previous definition was as follows :—

"A claim which the civil courts recognise as affording grounds for relief is actionable whether a suit for its enforcement is or is not actually pending or likely to become necessary."

It is clear that a Patent was an actionable claim within that definition.

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<sup>63</sup> (1885) 30. Ch. D. 261.

<sup>64</sup> See *Mulla's Transfer of Property Act* (2nd edn. 1936) at p. 688.

By the amending Act 2 of 1900 the definition was amended and removed from Section 130 and placed in Section 3 of the Transfer of Property Act as thereafter amended. Since the year 1900 the definition of an actionable claim as contained in Section 3 has been (as it still is) as follows :—

“Actionable claim” means a claim to any debt, other than a debt secured by mortgage of immovable property or by hypothecation or pledge of movable property, or to any beneficial interest in movable property not in the possession, either actual or constructive, of the claimant, which the Civil Courts recognise as affording grounds for relief, whether such debt or beneficial interest be existent, accruing, conditional or contingent.”

It must be assumed that the Legislature intended that the new definition, though it does not clearly say so, should continue to include the class of incorporeal personal property (of which a Patent is an example) to which reference was made in the case of the *Colonial Bank v. Whinney* (cited above). And it is submitted that the Court would so hold : that is to say that a patent is an actionable claim within the definition in Section 3 of the Transfer of Property Act.

This being so it is necessary, for the reasons already noted, that an assignment of a patent should be in writing.<sup>65</sup>

### Registration.

An assignment of a patent is not required to be registered with any Registrar or Sub-Registrar at any ordinary Registration office under any provision either of the Indian Transfer of Property Act or of the Indian Registration Act itself.

Under the Indian Patents & Designs Act itself registration at

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<sup>65</sup> If it were to be held that this is not so, then the position would be that an assignment of a patent could be validly made orally : just as a partition of joint family property may be made orally (See *Gyannessa v. Moharakanessa* (1898) 25 Cal. 210 : *Satya Kripal* (1909) 10. Cal. L. J. 503 ; or a surrender of a lease (see *Elias Meyer v. Maroranjani* (1918) 22 Cal. W. N. 441 : *Brojo Nath v. Maheshwar* (1918) 28. Cal. L. J. 220 ; and just as it has been held in the case of the *Imperial Bank of India v. Bengal National Bank* by Rankin C. J. (1931, 58. Cal. 136.) that partitions releases and surrenders are all forms of transfer but so far as the Transfer of Property Act is concerned they come under no restriction.

the Patent office of an assignment of a patent may be effected under Sections 20 & 63 of that Act. Under Section 20(3) it is provided in effect that the register of patents shall be *prima facie* evidence of the assignment. Under Sections 63(2) and (3) it is provided in effect that where an assignment has been registered this is a safeguard against any purported subsequent unregistered assignment being relied on; since the Sections provide in effect that the patentee has power to effect an assignment only "subject to any rights appearing from the register to be vested in any other person". It is also provided by Section 63 (4) to the effect that, unless the Court for reasons to be recorded in writing otherwise directs, no assignment shall be admissible in evidence unless registered under the Indian Patents & Designs Act. The manner and form of registration is regulated by Rules 54 to 58 of the 1933 Rules. Under Rule 59 it is provided that the Registers are open to the inspection of the public at all times on which the Patent Office is open to the public (except at times when they are required for actual official use).<sup>66</sup> Thus registration is not essential for the validity of an assignment. For the reasons mentioned however it is highly advisable that an assignment should be registered as early as possible.<sup>67</sup>

### Stamp.

An assignment of a Patent is required under the Indian Stamp Act (Act 2 of 1899) to be stamped as a conveyance. There is no provision or article in the Schedule of that act specially applicable to an assignment of a patent. A definition of a conveyance for the purposes of that act is contained in Section 2(10) thereof, as follows :—

"Conveyance" includes a conveyance on sale and every instru-

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<sup>66</sup> Compare in this connection also the remarks as to registration of licences above at page 573, in respect of which the position is similar.

<sup>67</sup> English law.

Under English patent law it is essential for an assignment to create a legal transfer (for which it is necessary to convey the legal estate) that it should be by deed; since that which is created by deed can only be assigned by deed. See *Terrell* (8th edn.) p. 254; also *In re Casey's Patents, Stewart v. Casey* 1892. 1. Ch. 104 (CA) at 113, or 9 R. P. C. 9. It is unnecessary for present purposes further to consider the effect which an assignment not by deed has by reason of the doctrine of equitable estates in England. It is clear that the principle that an assignment must be by deed is not in any case, in view of the statutory provisions of the Indian Transfer of Property Act for the reasons already discussed, applicable in India.

ment by which property, whether movable or immovable, is transferred *inter vivos* and which is not otherwise specifically provided for by Schedule 1 (or by Schedule 1A, as the case may be)".

Movable property is defined under Section 3(34) of the General Clauses Act (Act X of 1897) as meaning property of every description, except immovable property. Whereas "immovable property" has been defined by Section 3 (25) of the General Clauses Act as including "land, benefits to arise out of land, and things attached to the earth, or permanently fastened to anything attached to the earth." It is clear that patent rights are property; and accordingly an assignment of a patent is a conveyance for the purposes of the Indian Stamp Act.

The amount of stamp duty payable is to be found stated in Article 23 of Schedule 1 of the Indian Stamp Act (or of Schedule 1A in cases relating to Bengal). The amount of duty increases with the value of the consideration paid and the amount fixed also varies according to different provinces and in some cases according to different municipalities. It is necessary therefore to consult that schedule for every particular case. (For convenience of reference the article and the different amounts fixed are noted in Appendix No. 5 below).

The Controller of Patents has power to impound documents improperly stamped.<sup>68</sup>

<sup>68</sup> English law.

Under English law also an assignment of a patent is required to be stamped as a conveyance on the *ad valorem* scale imposed by the English Finance Act. See for example the case of *Urban v. Commissioners of India Revenue* in (1912) 29. T. L. R. 141 and on appeal in the same volume at page 476. There the dispute was as to whether a foreign patent was chargeable or exempt from the duty payable on the basis of a conveyance: for present purposes the case is now mentioned as authority merely for the proposition above stated, that duty is chargeable in England as in India on an assignment of a patent as on a conveyance. In England under Section 17 of the English Stamp Act of 1891, the Comptroller is liable to a penalty of £ 10, if he register a document which is not duly stamped. It has also been held that he may refuse to register a document where he is not satisfied that the true consideration is stated on the face of the document. (See *Maynard v. Consolidated Kent Collieries Corp'n. Ltd.* (1903) 19 T. L. R. 448). It has been held in England that if the party is dissatisfied with such order of the Comptroller, the proper course is to refer the matter to the

**Mere agreement to assign.**

While it is essential, in order that an assignment of a Patent should be a valid transfer, that it should be in writing so as to comply with Section 130 of the Transfer of Property Act, there is no reason why an agreement to assign a Patent, in order to be a valid and binding contract, should not be made orally.

A mere agreement to assign however, in whatever form, cannot create anything in the nature of a transfer of the ownership of a Patent. Thus it cannot entitle a person, in whose favour it is made, to institute a suit for infringement.

The law in India recognises no distinction between legal and equitable estates in the sense in which this was understood when administered by the Court of Chancery in England. See *Tagore v. Tagore* (1872) 1. I. A. Supp. 47 at p. 71 : also *Webb v. Macpherson* (1904) 31. Cal. 57.<sup>69</sup>

Therefore there can be no right of property, equitable or otherwise, created by any agreement to assign which is not a full validly legal assignment. The bare agreement to assign creates personal rights only. It is true that the person to whom the assignment is to be made can claim damages against the person who has promised to make the assignment, if he does not implement the contract. But no one who is not a party to the agreement is affected by it in any way.<sup>70</sup>

It follows that a person to whom the Patentee has merely orally agreed to assign the Patent, clearly has no title to the Patent

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Commissioners of Inland Revenue for their ruling. See *R v. Registrar of Joint Stock Companies*. (1888) 21. Q. B. D. 131.

<sup>69</sup> See also *Surendra Mohan Ray Chaudhuri v. Mohendranath Banerji* (1932) 59. Cal. 781.

<sup>70</sup> English law differs.

The legal position appears to be different in England where by reason of the creation of an equitable estate it would appear that, where there has been prior to the existence of the Patent an agreement to assign, a right of property in a patent may pass in equity to an assignee as soon as the patent comes into existence or is acquired by the assignor. For a case of such a nature in England, where it was observed by Viscount Cane, L. C. that "when a person executes a document purporting to assign property to be afterwards acquired by him, that property on its acquisition passes in equity to the assignee", see *Performing Right Society v. London Theatre of Varieties* 1924. A. C. 113. As already noticed, it is submitted that the principle and decision of that case is not applicable in India.



and no right to sue. For a transfer of a Patent can only be legally effected in writing. It is submitted that the position will be the same if the Plaintiff is a person to whom the patentee has merely agreed to assign the patent, even though the agreement be in writing, if the matter rests at the stage of a bare agreement only, and if the assignment has not come into effect so as to create a legal transfer of the Patent before suit.

#### **Purported assignment of patent in futuro.**

Under Section 5 of the Transfer of Property Act (Act IV of 1882 as amended by Act XX of 1929 and by Act V of 1930) it is provided in effect that property of any kind can be transferred. It has been held however that the words "in present or in future" of that section govern the word "conveys" used in the section and not the word "property" immediately preceding them; and that property not in existence cannot be transferred.<sup>71</sup>

In India therefore, it is submitted, whether there is a purported assignment of, or a mere agreement to assign, a Patent which is not in existence but is to come into existence at a future date or is to be afterwards acquired, the effect will be the same: and the assignee will get a personal right only against the assignor which he can only specifically enforce against the assignor as soon as the property comes into existence.<sup>72</sup>

#### **Bare Assignment of a patent does not ordinarily transfer a right, previously accrued, to sue for a past infringement.**

One other point that it may be convenient to note here is that a bare assignment of a patent will not, ordinarily, in the absence of express special stipulations, effect any transfer of a right to sue for an infringement committed before the date of the assignment. This being so, a Plaintiff, even though he be a registered patentee, if he relies on an assignment for his title to the patent, will not be entitled to sue for any alleged infringement which may have taken place prior to the date of such assignment. It will accordingly, in such a case, be a complete defence for a Defendant to plead, while admitting the validity of the assignment of the patent to the Plaintiff, that the alleged infringement took place prior to the date of such assignment.

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<sup>71</sup> *Mulla's Transfer of Property Act* (2nd edn. 1936) at p. 48 but see *In re Mahomed Hasham & Co.* (1922) 24. Bom. L. R. 861 at p. 871.

<sup>72</sup> See *Mulla's Transfer of Property Act* (1936 edn.) at pp. 42 and 45.

This point, that an assignment of a patent would not *per se* carry an accrued right of action for infringement was expressly decided in *Wilderman v. F. W. Berk & Co. Ltd.*<sup>73</sup> That was a case, in which it was found as a fact that the Plaintiff was a hostile person, so that, under the Trading with the Enemy Amendment Acts, the Patent had on 20th October 1918 vested in the Custodian for England and Wales appointed under those Acts; and was so vested at the date of the alleged infringement, which was in November or December 1919. And it was held on this ground, apart from others, that though there had admittedly been a valid assignment from the custodian back to the Plaintiff by operation of the statute at a date (that is 20th July 1920) subsequent to the alleged infringement, the Plaintiff as such assignee had no right to sue in respect of an alleged infringement which had admittedly occurred prior to the assignment to the Plaintiff.

**Defences of denial that the act complained of was committed : at all : or by the Defendant : or by his agent : or by any person for whose act the Defendant will be liable.**

The nature of the liability of a principal for an infringement committed by his agent (and of a master for his servant) has already been discussed<sup>74</sup> and it has been noted that he may none the less be liable if he was responsible for the commission of the act complained of even though it was not in fact done by him.

The defences referred to under Nos. 27 & 28 in Chapter XIV relate to pure questions of fact : in effect that the Plaintiff's case is a false case. They call for no further comment here.

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<sup>73</sup> (1925) 42. R. P. C. 79 at p. 90.

<sup>74</sup> See page 580 above.

## CHAPTER XVI

### INFRINGEMENT CONTINUED—DEFENCES IN RELATION TO THE SPECIFICATION—DEFENCES OF INVALIDITY : DEFENCE THAT DEFENDANT'S ARTICLE OR PROCESS IS OUTSIDE THE MONOPOLY DELIMITED IN PLAINTIFF'S SPECI- FICATION : LORD MOULTON'S DEFENCE

#### Conditional nature of the grant of a Patent.

Ever since the Statute of Monopolies (and indeed, as that Statute was merely declaratory of the Common Law, even before that, from earliest times) the grant by the Crown of a Patent has always been but a conditional grant : conditional, that is to say, in the sense that the grant is to come to nothing in the event of its being afterwards found that the Crown had no power to grant it or that other reasons exist for the revocation of the grant.<sup>1</sup>

It is for this reason that the wording of the grant of Letters Patent in England is made conditional in the following words :—

“Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by us and the same may be revoked and made void accordingly.”<sup>2</sup>

And it is for this reason also that the Indian form for the grant of a Patent likewise contains a clause the effect of which is the same : *viz* :—

“Subject to the conditions that the validity of this patent is not guaranteed by Government.”<sup>3</sup>

In these circumstances it follows that, when a person is sued for infringement of a Patent, it becomes open to him always to take

<sup>1</sup> See pages 24, 30, 58, 109 ante.

<sup>2</sup> See page 24 ante.

<sup>3</sup> See page 30 ante.

as a defence the plea that the Patent of the Plaintiff, though it has been granted and registered, is in fact invalid. For if there is no effective Patent there assuredly can be no infringement of it.

The various objections against the validity of a Patent which may be raised at one stage or other of its currency have been already fully discussed in the earlier Chapters VI, VII and VIII. It remains however to be considered whether all or if not all, then which, of those objections may be raised by a Defendant at the stage when an infringement suit has been brought against him, as a defence to such a suit. Out of all the defences on the ground of invalidity discussed in Chapters VI, VII & VIII those which, it is submitted, are available to a Defendant in an infringement suit have been briefly noted under the Nos. 29 to 40 in Chapter XIV. Before proceeding to a consideration of any further points which may call for comment in connection with those defences and in connection with the remaining defences Nos. 41 to 44, which it is proposed to do in this Chapter, it will first be convenient to note under what authority the defences mentioned under Nos. 29 to 40 in Chapter XIV are available to a Defendant in an infringement suit and the reasons why those defences only and not other defences for invalidity are available at such stage.

### **The Defences of invalidity available to a Defendant in a suit for infringement in India.**

Under Section 29(2) of the Indian Act of 1911 it is provided as follows :—

“Every ground on which a patent may be revoked under this Act shall be available by way of defence to a suit for infringement.”

**Various grounds of invalidity made available under Section 29(2) read with Sections 22, 23 & 26.**

The grounds on which a Patent may be revoked by petition to a High Court are contained in Section 26 of the Indian Act. It is clear therefore that all the grounds of invalidity set out in Section 26 are available by way of a defence in an infringement suit.

In addition however to revocation by petition to a High Court under Section 26, revocation may also be obtained under the Act by petition to H. E. the Governor-General in Council under Sections 22 and 23. It follows equally under the terms of Section 29(2),

that such grounds as are available for the obtaining of the revocation of a Patent under Sections 22 and 23, that is to say the grounds of the abuse of the monopoly by inadequate supply or non-manufacture in British India are also available by way of a defence in an infringement suit.<sup>4</sup>

But it should be noted that, since a case based on the abuse of the monopoly of the Patent cannot be agitated as a ground for revocation on a Petition before H. E. the Governor-General in Council until the period of 4 years referred to under Section 22 and Section 23 respectively has elapsed, so also such a ground, it is submitted, cannot be raised as a defence by a Defendant in a suit for infringement unless such period of 4 years has elapsed.

**Enumeration of the defences which under Secs. 22, 23 and 26 are expressly laid down as available in British India.**

The grounds of invalidity, which are expressly mentioned under the Act of 1911 as being defences to a suit for infringement in British India when collected from Secs. 22, 23 and 26 are as follows :—

- (i) That the demand for the patented article in British India is not being met to an adequate extent and on reasonable terms : after 4 years : [Under Section 22.]
- (ii) That the patented article or process is manufactured or carried on exclusively or mainly outside British India : after 4 years : [Under Section 23.]
- (iii) That any invention included in the statement of claim is of no utility : [Under Section 26 (1) (a).]
- (iv) That any invention included in the statement of claim was not, at the date of the application for a patent, a new invention within the meaning of the Act : [Under Section 26 (1) (b).]
- (v) That the applicant was not the true and first inventor thereof or the assign or legal representative of such inventor thereof : [Under Section 26 (1) (c).]

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<sup>4</sup> For authority that such grounds (i.e. the abuse of the monopoly) have been held in the United Kingdom to be available under the English Act as a defence to an infringement suit see the cases already cited at page 333, note 25, above.

- (vi) That the original or any amended application or specification does not fulfil the requirements of (the) Act :  
[Under Section 26 (1) (d).]
- (vii) That the applicant has knowingly or fraudulently included in the application for a patent or in the original or any amended specification, as his invention, something which was not new or whereof he was neither the inventor nor the legal representative of such inventor :  
[Under Section 26 (1) (e).]
- (viii) That the original or any subsequent application relating to the invention, or the original or any amended specification, contains a wilful or fraudulent mis-statement :  
[Under Section 26 (1) (f).]
- (ix) That the whole or a part of the invention or the manner in which the whole or a part is to be made and used as described in the original or any amended specification, is not thereby sufficiently described, and that this insufficiency was fraudulent or is injurious to the public.  
[Under Section 26 (1) (g).]

#### Preliminary comments.

The wording of the grounds as stated in Section 26 is highly unsatisfactory. A comparison with the grounds mentioned in Section 25 of the English Act of 1907-1932 will show how much more precise, and more comprehensive is the wording of the grounds as stated under the current English Section.

In regard to certain of the grounds as at present worded under the Indian Section, as it stands, it is difficult to say whether a particular ground is intended to refer to an objection for want of subject matter or want of novelty or for insufficiency of description or for fraud or for what. It seems hardly likely that a sub-section was intended only to be applicable if every one of these objections in a peculiar combined degree was present. Sub-section (e) is an instance of such a mixed and ambiguous statement, of which it is extremely difficult to analyse the precise meaning.

In view of this unsatisfactory wording of Section 26 as at present framed it is not proposed here to comment individually or *seriatim* at any length on each separate sub-section. Instead of

examining each separate ground and considering its meaning it is proposed to adopt a reverse process for an analysis of the Section. Since all the several objections for invalidity which may be agitated against a Patent at any time of its life have already been reviewed individually, it is proposed here merely to consider each of those objections as stated in the earlier Chapters VI, VII & VIII, *seriatim*, and to attempt to arrive at an opinion as to whether all or if not all, then which, of those objections may be treated on a proper construction of Sections 22, 23 and 26 as being included in the nine grounds indicated above which are expressly laid down under the Act as available defences in a suit for infringement in British India.

#### Summary of grounds directly within Section 26(1).

The grounds which will on such an analysis be found to be directly within Sec. 26(1) as being open to a Defendant to take in a suit for infringement in British India are as follows :—

*Want of subject matter in that the alleged invention is not a manner of manufacture :—*

This is made available as a defence under Sec. 26(1)(b) read with Sec. 2(8).<sup>5</sup>

*Want of subject matter in that there was in the alleged invention no inventive step :—*

This objection is nowhere in Section 26(1) mentioned as a separate ground of invalidity. But it is submitted that it may be read into the Section as being covered or implied by Section 26(1)(b) read with Section 2(8), or possibly even by Section 26(1)(d). The position is however not at all clear on the face of the wording of Section 26 alone.<sup>6</sup>

*As to want of subject matter in that the use of the invention will be illegal :—*

This objection is not mentioned in Section 26(1) nor does it appear to be included by implication.<sup>7</sup>

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<sup>5</sup> See page 164 and page 543 above.

<sup>6</sup> See page 165 and page 543 above.

<sup>7</sup> See page 166 and page 543 above.

*As to want of subject matter in that the use of the invention will be contrary to morality :—*

This objection is not mentioned under Section 26(1) nor does it appear to be included by implication.<sup>8</sup>

*As to want of subject matter in that the invention is unfit to be the subject of the exercise of the Crown's prerogative :—*

This objection is not mentioned under Section 26(1) nor does it appear to be included by implication.<sup>9</sup>

*Want of novelty :—*

This is available to a Defendant as a defence in any category : under Section 26(1)(b).<sup>10</sup>

N.B. *As to invalidity by reason of a prior grant :—Section 26(1) contains no express mention of this objection. It might of course be urged at first sight that Section 26(1)(b) in its words "a new invention within the meaning of this Act" covers an objection for prior grant as well as all objections for want of novelty in the strict sense. Unfortunately in view of the definition of a "new invention" contained in Section 38 of the Act, such a construction on further investigation hardly seems accurate or possible.*<sup>11</sup>

*Want of utility :—*

This objection is expressly made available under Sec. 26(1)(a).<sup>12</sup>

*Insufficiency of description :—*

This objection is available under Sec. 26(1)(g) within the restricted conditions of that sub-section : i.e. provided fraud or injury to the public is shown.<sup>13</sup>

*The objection that the Applicant was not the true and first inventor :—*

This objection is expressly made available under Sec. 26(1)(c).<sup>14</sup>

*Fraud :—*

Fraud is expressly referred to under Sec. 26(1)(e) and

<sup>8</sup> See page 166 and page 543 above.

<sup>9</sup> See page 166 and page 543 above.

<sup>10</sup> See page 216 and page 544 (Nos. 31 & 32) above.

<sup>11</sup> See page 217 and page 544 above.

<sup>12</sup> See page 223 above : also p. 544.

<sup>13</sup> See page 247 above : also p. 544.

<sup>14</sup> See page 257 and page 544.



Sec. 26(1)(f) ; and as such is available as a defence in an infringement suit.<sup>15</sup>

**N. B.** *As to the objection that the applicant for Patent obtained the invention from the Defendant (or from a person of whom he is the legal representative or assign) :—This objection is not separately referred to either expressly or impliedly among the grounds of invalidity mentioned in Section 26(1).<sup>16</sup>*

### **Summary of grounds directly within Section 22 & Section 23.**

#### ***Objection for abuse of monopoly :—***

As already indicated the objection (after 4 years) that a Patent is invalid on the ground that the demand for the patented article is not being met to an adequate extent and on reasonable terms is expressly made available to a Defendant as a defence in an infringement suit by virtue of Section 29(2) read with Section 22.

Similarly the objection (after 4 years) that a Patent is invalid on the ground that the patented article or process is carried on exclusively or mainly outside British India is expressly made available to a Defendant as a defence in an infringement suit by virtue of Section 29(2) read with Section 23.<sup>17</sup>

**Whether any other grounds by implication may be added as being available to a Defendant as a defence in an infringement suit.**

One ground not among the summary given above which, it is submitted, is available to a Defendant as a defence in an infringement suit in British India is the objection of a prior grant. It is submitted that this objection must be available on general principles to a Defendant in an infringement suit, since it cannot be legal or feasible for the Crown to make the same grant for the same monopoly twice over.

As to the objection of "obtaining", it will doubtless be found that almost every case in which such an objection might have been raised, if the defence had been available in the form in which it is available in England under the English Section 25(2)(c), will equally afford grounds of invalidity under the more general ground that the Applicant for Patent was not the true and first inventor. The

<sup>15</sup> See pages 259, 266 and page 544.

<sup>16</sup> See page 263, page 267 and page 544 above.

<sup>17</sup> See page 333 and page 545 above.

objection of "obtaining" does not appear to be available as a separate defence under the terms of the current Indian Act of 1911.

Beyond those objections which have now been mentioned it would not appear that a Defendant can rely as a defence in a suit for infringement on any other defence as being available to him under the terms of Section 29(2) read with Sections 22, 23 and 26 either expressly or by implication, or under the Act of 1911 generally, on any proper construction thereof.

From what has been said it will be seen that the statement of the defences under Nos. 29 to 40 in Chapter XIV may be used as a workable summary of the various defences on the ground of invalidity, which may be taken to be in practice open to a Defendant in an infringement suit under the Act of 1911 as it now stands. Since all such objections for invalidity have already been discussed in Chapters VI, VII and VIII reference may be made to those chapters for what will and what will not constitute an effective objection on any particular one of the grounds enumerated.

### **Estoppel.**

A question may arise in certain circumstances whether there is an effective estoppel such as to bar the Defendant from raising the question of the invalidity of the Plaintiff's Patent.

It is well established that in a suit by a Patentee for royalties a licensee is estopped entirely from raising any question of the invalidity of the Patent against the Patentee from whom he has obtained his licence during such time as such licence is current. (See Halsbury (Hailsham edn.) Vol. 13, Art. 586 and cases there cited.)

But a person who may once have been a licensee is not, it is submitted, fettered by any such estoppel after the licence has been determined. See *Goucher v. Clayton*<sup>18</sup>. In that case the Defendant Firm on being sued for infringement in a previous suit had consented to judgment and immediately thereafter had obtained from the Patentee (who had been the Plaintiff in that suit) a licence for a certain term. The term of the licence expired. The Patentee then brought a second suit for infringement against the Defendants. In this second suit various other points were raised apart from the question of the licence: but the case appears to be authority for the

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<sup>18</sup> (1865) 34. L. J. Ch. 239.

proposition that the Defendants were entitled to take a plea that the Patent was invalid and were not estopped from doing so merely by the fact that they had at one time been licensees under a licence which had expired before suit.<sup>19</sup>

And a person who may be the holder of a licence to make or do certain things is not fettered by any such estoppel in the event of his being sued for infringement in respect of things made or done by him which are outside the licence granted to him : or, in a case where the licence is restricted to a certain geographical area, in respect of acts done outside that area. See *Fuel Economy Company v. Murray*.<sup>20</sup>

The point was moreover expressly referred to in the judgment of Luxmoore J. in the last mentioned case in the following passage :—  
 “The fact is that the action does not relate to anything which has been done under the licence, nor does the defence set up the licence as an answer to the claim for infringement. There is, of course, a well recognized rule that a licensee cannot attack the validity of a patent which is the subject of his licence, and Mr. Moritz quoted to me a passage from the judgment of James L. J. in *Adie v. Clark*<sup>21</sup> where he said this : “A licensee cannot, under any pretence whatever, bring his licensor into litigation as to the novelty of any part of the patent.” I think that statement must be read in relation to the subject-matter of the proceedings in which it was made. The action was an action for specific performance of an agreement to take a licence and for an account under such licence of the articles made by the Defendant. The reason why a licensee cannot dispute the validity of the patent in respect of which a licence is granted arises out of the relationship of the parties, the licensor and the licensee, which creates an estoppel. Estoppel can only operate in the same transaction as that in which it arises. In an action under a lease, the lessee cannot challenge the lessor’s title to property which is included in the lease, because the title to that is not in issue ; and the case of a licensee who has a licence to work a patent is to that extent analogous to that of a lessee under a lease. A licensee cannot

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<sup>19</sup> See also *Fulton on Patents, Trade Marks and Designs* (3rd edn. 1905) at page 202.

<sup>20</sup> 1930 2. Ch. 93 (C. A.)

<sup>21</sup> 3 Ch. D. 134 at p. 144.

challenge the validity of a patent in an action under the licence, the licence being admitted by the licensee, because the title is not in issue. But in an action for infringement a different set of circumstances arises altogether. It is not an action under the licence at all, and in such a case, in my judgment no estoppel arises. If this were an action under the licence, for example, to recover royalties in respect of articles made under the patent in the limited area, of course, the Defendant, as licensee, would be estopped from challenging the validity of the patent, the licence being admitted by him, no matter how obviously invalid the patent might be. But, in my judgment, such an estoppel cannot arise in an action for infringement. In the present case, so far as the infringement complained of is concerned, the licence has no bearing on the case, and is really irrelevant to the plea."

In view of the clear reasons stated and of the very definite pronouncements in this judgment in the last-mentioned case, it is submitted that the true legal position is that in a suit for infringement, a Defendant, since the claim is not made against him in any respect *qua* licensee, will never in any circumstances be fettered by any estoppel arising out of any licence, which he may have held in the past or may hold at the time of the suit, such as to prevent him from raising by way of defence to the claim for infringement the invalidity of the Plaintiff's Patent.

A question of estoppel by judgment may also arise owing to previous litigation: the question then being whether the validity of the patent is *res judicata* by reason of some decision in a previous suit so as to bar the Defendant from relying on a defence of invalidity in the infringement suit which is being heard. Where the parties and the matters in issue are the same in the infringement suit being heard as in the previous litigation there may clearly be a *res judicata* and an estoppel binding on the parties as to the validity of the Patent, where this has been in issue. The point will be governed in India by Section 11 of the Code of Civil Procedure (Act V of 1908). The principles there laid down do not, it would seem, differ from the law as to *res judicata* in the United Kingdom. For a case in which an estoppel by judgment, or *res judicata*, was held to be created in regard to the issue of the validity of the Patent in question, reference may be made to the case of *Poulton*

v. *Adjustable Cover & Boiler Co.* and certain passages in the judgments therein which are cited below.

A further point whether there was in the circumstances of the particular case an estoppel against an estoppel, also arose in *Poulton v. Adjustable Cover & Boiler Block Co.*<sup>22</sup>

In this case the facts were these. The Plaintiff in this suit sued for infringement of his patent. The Defendants took a defence of invalidity for want of novelty and prior user, but the defence failed, the patent was held valid and the Plaintiff obtained judgment with a decree for a permanent injunction and an order for an inquiry as to damages. After this decision but pending the inquiry ordered, the Defendants having come to know of further instances of prior user, filed a Petition for the revocation of the Patent. This Petition was successful and the Patent was revoked. On the hearing of the inquiry the double point then arose whether the Defendants were estopped from raising the invalidity of the Patent by reason of the decree in the suit by which it had been adjudged valid : or whether the Plaintiffs were estopped from setting up the validity of the Patent and from denying its invalidity by reason of its having been adjudged invalid and revoked on the Petition for revocation.

It was held by Parker J. in the first place, that there had been an estoppel created by reason of the decree for an injunction and for the inquiry as to damages (being an adjudication that the patent was valid) which estoppel would ordinarily act against the Defendant so as to bar him from setting up on the inquiry the invalidity of the patent. On this point the learned judge made the following definite pronouncement :—

“Now I think that on principle it is absolutely clear that a judgment for an injunction and an inquiry as to damages in an action for infringement does estop the Defendant from setting up, on the inquiry, the invalidity of the letters patent. So far as the Defendant is concerned, he is estopped from denying the validity of the letters patent at the date of the trial, which is the date with reference to which the inquiry as to damages is directed, and, of course, estopped from denying their validity at the date of the infringement in respect of which the inquiry as to damages is directed.”

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<sup>22</sup> 1908. 2 Ch. 430.

The principle enunciated was confirmed with equal force in the Court of Appeal, the following observations being made on the point by Vaughan Williams L. J. :—

"The Plaintiff in an action for infringement of a patent obtained judgment against the Defendants, and, as consequential upon that judgment, an order for an inquiry as to the amount of damages which the Plaintiff had sustained by reason of the Defendants' infringement of his patent. In my opinion the judgment so obtained by the Plaintiff made the question whether there had been an infringement by the Defendants of a patent then valid, which had been granted to the Plaintiff, *res judicata* as between the parties to the action, and, operated as a complete estoppel between them."

The matter was put by Buckley L. J. thus :—

"In this case, the Plaintiff, a patentee, brought an action against the Defendants for infringement of his patent. In that action he succeeded, and obtained an order, the substance of which was that it decided that the patent was valid, and that there must be an inquiry as to the damages sustained by the Plaintiff through the wrongful infringement by the Defendants of his valid patent. That was, in my opinion, a complete judgment, constituting the matters so decided as between the parties *res judicata*, and operating as an estoppel upon the Defendants as regards those matters for all purposes, except that, of course, the Defendants might appeal against it, and that it did not estop them from presenting a Petition for the revocation of the patent."

The next question that logically arose was whether the order for revocation, made in the Petition for Revocation had the force of a judgment in *rem* so as to act as a further estoppel, so that there being, within the words used by Lord Coke, "an estoppel against an estoppel", the matter would be at large.<sup>23</sup>

The decision of this point involved the further question how far the order for revocation was to be given effect to as a judgment in *rem*.

The Court of Appeal, affirming the decision of Parker J., held that the estoppel created by the judgment continued and was unaffected by the order for revocation.

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<sup>23</sup> See 1908. 2 Ch. at p. 432.

It was further held by Fletcher Moulton L. J., in effect, that while the order of revocation was in the nature of a judgment in *rem*, yet its effect was merely to terminate the *res*, i.e. the letters patent, at the date when the order for revocation was made; and that it had no further effect so far as estoppel was concerned.<sup>24</sup>

**No estoppel from infringement suit such as to bar subsequent Petition for Revocation filed on behalf of the public.**

The reason why in the last mentioned case the judgment did not estop the Defendants from thereafter presenting a Petition for Revocation is explained parenthetically in the judgment of Buckley L. J. where at p. 440 he points out that the Defendants in presenting the Petition were suing in the capacity of members of the public representing the public and not as private individuals which was the capacity in which they had been sued in the infringement suit.

This principle appears to be well settled that where there has been, in an infringement suit a judgment holding the Plaintiff's patent valid against the Defendant, this will not operate as any estoppel to prevent the same person who was a Defendant in that suit from thereafter filing a Petition for the Revocation of the same Patent provided he files such Petition after obtaining the fiat of the Advocate-General and as a member of the public and on behalf of the public and not in his private capacity.

For other cases in which the same point has been decided see *Deeley's Patent*; also *Shoe Machinery Co. Ltd. v. Cutlan*; also *Jameson's Patent*.<sup>25</sup>

It is submitted however that if there has been a suit for infringement and the Plaintiff's patent has in that suit been held valid against the Defendant, and if thereafter the same Defendant were to seek to file a Petition for revocation in his private capacity without obtaining the fiat of the Advocate-General (as in certain circumstances he might ordinarily be entitled to do), then the

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<sup>24</sup> See 1908 2 Ch. at p. 439; also the observations of *Parker J.* at p. 435 *ibid.* And further as to estoppel generally in patent suits see *Fletcher Moulton* at p. 208.

<sup>25</sup> i.e. (1895) 21. R. P. C. 192 at p. 199; (1895) 12. R. P. C. 530 (C.A.) at p. 533; and (1902) 19. R. P. C. 246 at pp. 248 and 252; respectively. Also see at p. 443 above.

ordinary principle of estoppel would operate. In those circumstances the position would be distinguishable from what was found to be the case in *Poulton v. Adjustable Cover & Boiler Block Co.*, and the party who had been the Defendant in the infringement suit would actually be estopped from proceeding in his Petition for Revocation.

**The defence that the alleged infringement is not covered by the claims of the Plaintiff's Specification.**

Before turning to a consideration of the principles on which a Specification is required to be construed it is convenient first to note certain subsidiary points which arise regarding the degree of similarity (or identity) which is necessary to be established between the infringing article or process of the Defendant and the invention of the Plaintiff as found to be described in his Specification. The question in each case comes to this : after it has been ascertained precisely what is the Defendant's article or process (as made or sold or used by him) and after it has been ascertained precisely what is the Plaintiff's patented article or process (as described in his Specification), is the one article or process so sufficiently similar (or identical) with the other as to constitute an infringement ?

**Question of similarity a question of fact.**

This question though dependent on preliminary questions arising on the construction of the specification is a question, finally, of fact. It comes to this : whether the invention of the Defendant is identical in essence with the invention of the Plaintiff. For this reason it is most important to observe, before entering upon any consideration of the cases on this point, that the decisions to be found in the cases on the subject are only of interest as a guide ; and as showing what decisions have actually been arrived at in different particular cases. The decision of every case will go entirely on the particular facts of the particular case. The decision in a previous case cannot be of any binding authority in any other case. At the same time it is clear that the Courts will do their best to avoid giving a decision one way on a particular set of facts in one case and a decision another way in another case where the material facts are to all intents and purposes the same. Such a state of things would bring about so much uncertainty in the administration of the Patent system as to create much unnecessary loss and difficulty both to



inventors and to the public. A consideration of the decided cases on this point is and will continue to be, therefore, of considerable practical interest.

**Similarity. Imitation seldom completely identical.**

In nearly every case it will be found that the Defendant has made some variation in one or more of the parts or elements of his product in which it differs from the precise invention of the Plaintiff. It is seldom if ever that the Plaintiff's invention is completely and slavishly copied. The question is whether that which is different is of a vital nature or not : or conversely whether that which is not different is of the essence of the invention.

As to this, the matter was well stated by Wills J. in the following words :—

“Infringement is a question of fact for the jury, if there be one ; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification : but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. What the thing invented is, must be gathered from the specification alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard, with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied ? It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits ; and the only protection the patentee has in such a case lies, as has often been pointed out by every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the Defendants that what is important and what is of subsidiary consequence, can only be gathered from the specification itself. I am satisfied that neither is, nor can be, the law. Certainly *Budgeon v. Thomson* (L. R. 3 App. Cas. 34) that which was cited as an authority to that effect, says nothing of the kind. “Additions or subtractions”, says Lord Cairns, “may exist and yet the thing protected by the specification may

be taken notwithstanding." There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention."<sup>26</sup>

**Similarity. If the essence of the invention is copied this is infringement.**

The Court will hold the Defendant to have infringed no matter what minor differences there may be, if he has taken "the pith and marrow" of the invention ; to use a phrase which has been much used in the English cases. In a passage dealing with this point Lord Cairns L. C. stated as follows :—

"One mode of infringement would be a very simple and clear one ; the infringer would take the whole instrument from beginning to end.....About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument described ; he might make an instrument which in many respects would resemble the patent instrument, but would not resemble it in all its parts. And there the question would be, either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine or ten of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four or five steps which he might not actually have taken and represented upon his machine".<sup>27</sup>

**Improvement by Defendant in such case immaterial.**

A delusion may exist that because the Defendant's article presents advantages over the Plaintiff's invention, this fact in itself negatives infringement. That is not so. As was said by Bowen

<sup>26</sup> See the *Incandescent Gas Light Co. Ltd. v. The De Mare Incandescent Gas Light System Ltd.* (1896) 13 R.P.C. 301 at p. 330.

<sup>27</sup> See *Clark v. Adie* (1877) 2. A. C. 315 at p. 320.

*L. J. in Wenham Gas Co. v. Champion Gas Lamp Co.* "if the pith and marrow of the invention is taken.....the superadding of ingenuity to a robbery does not made the operation justifiable."<sup>28</sup>

**Similarity.** When the monopolised invention concerns a new product as well as a new means.

When the Plaintiff's invention is of this nature, the Court will look with a jealous eye on infringers. In a case of this nature any other machine for effecting the same object may well be considered to be taking some of the essence of the Plaintiff's invention. (See the further remarks in the next paragraph).

**Similarity.** Where the Plaintiff's monopoly is for a new means only of attaining a well known product or object.

In this case the field of the monopoly being smaller, infringement is less easily established : the essence of the invention being confined to the particular means stated in the specification for achieving the object, there can be no infringement unless a substantial part of those means and none other find a place in the article or process used by the Defendant. The difference between what is the essence of the Plaintiff's invention in this case and in that referred to in the last preceding paragraph can be well judged from the following passage of the judgment of Wood V. C. in *Curtis v. Platt* :

"Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something, that has been known to all the world long before, has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because otherwise, that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years."<sup>29</sup>

<sup>28</sup> (1892) 9 R.P.C. 49 (C. A.) at p. 56 see also *Terrell* (8th edn.) at p. 158.

<sup>29</sup> Sec 3 Ch. D. 136 n : and see *Terrell* (8th edn.) at p. 156.

**Similarity. Doctrine of equivalents.**

It has already been observed generally how the decision whether there has been an infringement or not of a particular patent may depend largely on what standard of skill and scientific knowledge is to be imputed to the addressee of the patent. In proportion as it is assumed that the person reading the Patent will be either more or less skilled, so will the construction become more or less embracing; and so will the limits of the monopoly protected become more or less wide; and on the width of the limits of this monopoly may depend the decision whether or not that monopoly has been infringed by a particular act of the Defendant. It has been noticed that on the whole the Courts now usually assume, for the purpose of construing the patent, that the person to whom it is addressed is a person of ordinary skill as a mechanic and chemist: though in construing patents of a more than ordinarily technical and scientific nature the addressee may be taken to be a person highly skilled in the particular art under reference. It follows from this, in many cases, that where in a specification reference is made to a particular means for the fulfilling of a certain subsidiary function, the addressee of the Patent, if he is a person with the requisite technical knowledge, will be fully aware that such a function may be fulfilled, alternatively, by one or more other methods (either mechanical or chemical), which may not have been expressly mentioned by the patentee in his specification. It has been recognised also that in some cases it may be impossible for a patentee to express within his specification every conceivable parallel means by which a particular function essential to his invention may be accomplished. At the same time it has also been recognised that if the patentee is not to be allowed to have protection against persons who take the essential merits of his invention only varying the means here and there of fulfilling such subsidiary functions, this will deprive the patent of all practical value. In this way the doctrine known as the doctrine of equivalents has grown up. Without such a doctrine being applied in the construction of a specification there would be no end to the number of equivalent minor processes which it would become necessary for a patentee to mention precisely and expressly in his specification;

and in some instances it might become impossible in practice for him to be given any useful protection at all.

Naturally the doctrine arose first more in relation to mechanical equivalents : though it has since been extended largely also to chemical equivalents.

### **Scope of the doctrine of equivalents.**

It has been stated that the proper function of the doctrine of equivalents is to protect the patentee against evasions or variations which a reasonable man would either not have foreseen or not have considered it necessary to mention specifically in his specification : rather than to supplement faults of drafting by reading in claims which should have been inserted in the first instance.<sup>30</sup>

It has been pointed out that in the case of a functional claim it becomes much more easy to establish an infringement through the doctrine of mechanical equivalents.<sup>31</sup>

### **Doctrine of equivalents and the test of similarity where the patentee's invention is for a combination.**

Certain observations in some of the older cases would tend to support the view that where the patent is for a combination, the application of the ordinary doctrine of equivalents is excluded. On that view if the patent were to be, for example, for a combination of four integers, and if the alleged infringing combination was composed of three of the identical integers plus an equivalent in place of the fourth, there should be held in law to be not sufficient similarity to constitute infringement. It is submitted that this is not a correct view of the law ; and that the doctrine of equivalents may be relied on, in proper circumstances even where the patent relates to a combination as in any other case.

The law on the point was recently summarised in the following observations by the Lord Justice Clerk during the course of his judgment in *The Rheostatic Company Ltd. v. Robert McLaren & Company Ltd.*<sup>32</sup>

"It was argued to us that the rule of mechanical equivalents

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<sup>30</sup> See *Fletcher Moulton* p. 134.

<sup>31</sup> See *Fletcher Moulton* p. 136.

<sup>32</sup> (1930) 53. R. P. C. 109 at pp. 119, 125, 126.

could not be founded on where the patent said to be infringed was for a combination only. This proposition is much too broadly stated. The correct statement of the law is to be found in *Procter v. Bennis* L. R. 36 Ch. Div. 740, where Cotton L. J. at p. 757 put the matter thus :—"Where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims and the mode which he points out of effecting the improvement." *Curtis v. Platt* L. R. 3 Ch. Div. 135n is an example, for there the patentee had taken out a patent for an improved method of reversing machinery in a spinning mule, which itself was a known and patented machine, that is to say the patent was for a mechanical device within an existing patent. In such a case it was held that the inventor was tied strictly to his own mechanical device, and could not plead another mechanical equivalent as an infringement of his patent rights. But such a case has no application to the present, where the instrument as a thermostat is new and involves a novel combination producing a new and hitherto unachieved result. A novel combination of this type is as much to be protected against infringement as an invention that embodies an entirely novel principle. As was said by Parker J. in *Marconi v. British Radio Telegraph Co. Ltd.*, (1911) 28. R.P.C. 181, at p. 217 : ". . . the combination or process, besides being new, produces new and useful results, everyone who produces the same results by using the essential parts of the combination is an infringer, even though he has in fact altered the combination or process by omitting some unessential part or step or substituting another "part or step," which is in fact equivalent to the part or step he has omitted. "Applying this law to the facts of this case, I reach the conclusion that Satchwell's invention was pirated by the Defenders in their A. C. M. instrument in a hardly disguised form, although it may well be that the piracy was unintentional. I hold infringement to be proved."

**"Or counterfeits or imitates it".**

It seems that these phrases in Sec. 29(1) are not meant to suggest any different modes of infringement other than by way of manufacture, sale or use but are merely embodied in the Section to make it clear that the right of suit is not confined to cases where

a precisely similar invention is made, sold or used : but extends to cases of a sufficient similarity.

**“The invention.....or counterfeits it or imitates it” : what degree of similarity is requisite.**

One fundamental difference between a suit for infringement of patent and a suit for passing off must here be emphasised. In a passing off suit there are to be considered on the one hand the goods of the Plaintiff and on the other the goods of the Defendant : it is in regard to these that the eye of the Judge is required to operate. The question is whether the Defendant has passed off his goods as the goods of the Plaintiff : the question is therefore purely between the goods of the Defendant which are complained of and the goods of the Plaintiff. In a suit for an infringement of Patent the question is not the same. Here the question concerns, not the goods, but the invention of the patentee as described in the patentee's specification in respect of which his Letters Patent have been granted. Thus it is not difficult to imagine cases where there are no goods of the patentee in existence at all, where the patentee has not progressed as far as to manufacture any goods under his patent ; and yet he will be able to maintain a suit for infringement against a Defendant who has manufactured goods in infringement of his Patent. The fundamental distinction exists in regard to the nature of the property of the Plaintiff which is infringed in either case. In a Patent suit it is the invention of the Plaintiff ; and the whole question turns on the scope of the invention in any given case. It is fundamentally important to note that the criterion is the infringement of the invention and not of the goods of the Plaintiff. What is protected under Patent Law is the full territory of the Plaintiff's invention as described in his Specification and anything which is an encroachment of this territory is an infringement.

It often happens that under his Patent a Plaintiff manufactures an article in one form and a Defendant comes along and manufactures an article in another form. It may be that no member of the public who has seen the two articles would be led by their appearance or get up to mistake the one for the other or to believe that the second article was a product manufactured or belonging to the first manufacturer. There might be no prospect whatever of the

Plaintiff being successful in a passing off suit. Yet if the second article is one covered by the Plaintiff's specification the Plaintiff is clearly entitled to succeed in an infringement suit.

## CONSTRUCTION OF THE SPECIFICATION

It is for the reasons indicated above that it becomes essential in any given case, where there is a dispute on the question of similarity, when considering whether or not there has in fact been an infringement perpetrated, first to read and construe the Specification of the Patent said to have been infringed. It is now proposed to turn to a consideration of certain general principles on which a Patent is required to be construed.

As to "benevolent construction".

In the old cases observations occur which would tend to support a view that there is a positive principle in regard to the construction of Patent Specifications to the effect that the Specification must be construed "benevolently" in favour of the patentee. Such observations were no doubt made at a time when there was considerable prejudice against monopolies; and against patentees; and were made for the purpose of counter-balancing any tendency to construe the specification unfavourably to the prejudice of the patentee. In more recent times, since the administration of patents has been placed on a fair footing both to the public and to the patentee, and since the advantages to the public of encouraging patents for inventions have been more widely appreciated, no such prejudice remains requiring to be positively counter-balanced. At the present day it is possible if the positive principle of benevolent construction were to be recognised and habitually applied for the construction of specifications, the result would be to tip the balance between a favourable and an unfavourable construction unreasonably far in favour of the patentee. Accordingly it seems proper to observe that at the present day no positive principle of a benevolent construction of the specification can be relied on by the patentee; the only principle on the point being that the specification is to be construed like all other written instruments impartially, according to its true



meaning; and that it is not to be subjected either to a benign interpretation or to a strict one.<sup>33</sup>

The proper principles in this respect for the construction of specifications were clearly stated in *Cropper v. Smith*<sup>34</sup> in the following observations of Bowen L. J. which have been frequently subsequently approved in later cases<sup>35</sup> thus :—

“We were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been, from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepherd’s Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign. *Verba debent intelligi cum effectu ut res magis valeat quam pereat*. Now that is only a caution against excessive formalism, it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is, as expressed in their language you must not allow yourself to be drawn away from the true view of the document by over-

<sup>33</sup> See *Harrison v. Anderston Foundry Co.* (1876) 1 App. Cas. 574; *Clark v. Adie* (1875) 2 App. Cas. 436; *Needham v. Johnson* (1884) 1 R.P.C. 58 at p. 271; *British Thomson-Houston Coy. Ltd. v. Corona Lamp Works Ltd.* (1922) 39 R.P.C. 49 (H.L.) at p. 89; and See *Frost* (4th edn.; 1912) Vol. 1 at p. 270.

<sup>34</sup> (1884) 1 R. C. 89.

<sup>35</sup> See *Benno Jaffe and Darmstaedter Lanolin Fabrik v. Richardson & Co.* (1894) 11 R.P.C. 271.

nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole document. It is almost always coupled with another maxim, which seems to be nearly the same thing in another shape. *Verba intentioni debent inservire*. You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly can never be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing a document".

To this extent only may the doctrine of benevolent construction be said to survive at the present day, that the court, where the language is ambiguous will lean towards that construction which will make sense of the specification rather than that which will make it useless, and towards that interpretation of an ambiguous phrase which will support its validity rather than its invalidity. In this however, in truth, there is no application of any special principle for benevolent construction peculiar to patent specifications but merely an application of the ordinary rule as to construction, which is applicable indiscriminately to all documents.<sup>36</sup>

Particularly may the court lean towards a construction which will support the validity of the Patent in a case where the Defendants have adopted the invention and used or dealt in it extensively and then turn round and attack its validity on all points hoping perchance, with luck, to have it upset on one at least out of all the technical objections taken. Such a case and the proper tendency of a Court to lean towards the validity of a patent in such a case was eloquently referred to by the Master of the Rolls in *Edison Bell Phonograph*

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<sup>36</sup> See *Plimpton v. Spiller* (1877) 6 Ch. D. 422; *Otto v. Linford* (1881) 46 L.T.N.S. 39.

*Corporation Ltd. v. Smith and Young*<sup>37</sup> in the following vigorous words :—

“The patent refers to a phonographic machine. If the patent is a good one, there is no doubt about the infringement ; but the Defendants who have infringed, and who have taken the full benefit of the invention if the patent is a good one, finding that they are guilty of an infringement, and that therefore there is a great check to their business, do that which is common in such cases—they turn round and attack the patent. They have used the exact thing that has been patented ; they have used it to a considerable extent, but they say “Your patent is a bad one ; you cannot sue upon it” ; and they have taken, by way of objection, every one of the ordinary objections which are taken under such circumstances—that is to say, they spell every paragraph and every line in the patent, and try to persuade the Court that some one line, or some one sentence in it is so bad that it makes the whole of the patent bad, and prevents the inventor from having the benefit of his invention however useful or however great it may be. I do not hesitate to say myself, that when that is the sort of defence in such a case, the Court ought to look carefully to see whether any one of those objections can be sustained. The Court certainly under those circumstances ought not in any way to favour the objection. Those who take such objections as that must prove them strictly. That is my view.”

What has been said above refers of course to questions affecting the benevolent construction of the specification only ; and does not affect at all any question whether or not the terms of the grant itself should in itself be benevolently or non-benevolently construed. The form of grant in use at the present day in the United Kingdom still contains a clause directing that it should be benevolently construed.<sup>38</sup> But since the form of grant in use in British India contains no such words, no question arises in British India of considering

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<sup>37</sup> (1894) 11. R.P.C. 389 at p. 395.

<sup>38</sup> See also *Frost* (4th edn. 1912) Vol. 1 at p. 273.

what would be the proper interpretation to be put on any such express direction if embodied in the grant as affecting the construction of the grant itself.

**The Specification is to be construed as understood by the addressee.**

It is well settled that the Specifications of Patents are addressed to those skilled in the art to which the particular Patent relates and must be construed by the Courts as they would be interpreted by such addressees.<sup>39</sup>

This aspect of the matter has already been referred to in connection with the topic of insufficiency. The standard of knowledge, skill and intelligence of the addressee may vary according to the nature of the invention. In the case of certain inventions, as already noted, it may be necessary that the Specification will be required to be construed as it would, for various parts, be understood by more than one addressee with different qualifications. Thus while this canon of construction is universal for all specifications, the precise effect of its application may differ considerably in different cases.<sup>40</sup>

The standard of knowledge, skill and intelligence taken to be that of the addressee, will be the standard of such a man at the material date. That will be at the date of the application for the patent to which the particular Specification relates. All later knowledge is required to be eliminated: and all knowledge of a kind which would not be possessed by such addressee.

Both in order that the Court may have the positive standard of knowledge possessed by the addressee who may be a specialist to some extent, since the Court will not ordinarily be expected to be in possession of such specialised technical knowledge, as also in order that the Court may be instructed as to what field of knowledge, acquired since the date of the application, has to be eliminated, it usually becomes necessary that evidence should be given to show the precise state of the common knowledge in the prior art.<sup>41</sup>

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<sup>39</sup> See *British Dynamite Co. v. Krebs* (1879) 13. R. P. C. 192 (H. L.) *Scott's Patent* (1903) 20. R. P. C. 257 at p. 262.

<sup>40</sup> See at p. 241 above.

<sup>41</sup> See further, as to the application of this canon of construction, *Fletcher-Moulton* at p. 122; also *Frost* (4th edn: 1912) at pp. 276, 277 & 282.

**The Specification is to be construed as a whole.**

It is well settled that the Specification is to be read as a whole. The proper rule of construction as to this was clearly stated by the Master of the Rolls in *Edison Phonograph Corporation Ltd. v. Smith and Youny* :<sup>42</sup> in the following passage :—

“Now, then, the first question raised upon those sets of objections, taking them all together, is, what is the true construction of the patent, or rather what is the proper rule of construction of a patent. There are certain rules as to the effect of patents, when you have construed them, which are different from other instruments ; but as to the rule of construction of a patent, when the question is what is the true construction, I cannot doubt myself that the same rules of construction or the same canons of construction are to be applied to the construction of a patent, or to any part of it, as are used with regard to any other instrument. Therefore, when objection is taken to the claim, or to any one of several claims, it is not using the true canons of construction to read that alone and to say that, without regard to what there is in the rest of the patent, that means so-and-so or that means what is stated as the objection, and therefore, reading it in that way, you must hold that the patent is bad. You must look at the whole of the Specification, and then, having looked at the whole, if it is an objection to the claim, see what the claim, on the true construction of it is, having regard to the whole of the instrument. It is with regard to that rule, and only as an instance of it, that one finds certain things said in some of the cases. Now, in the case before Lord Hatherley, of *Arnold v. Bradbury*, L. R. 6. Ch. App. 706, the parties argued very much as was attempted yesterday. They took one of the claims and said : “Read that alone, and then the language is such that you ought to say that, according to “the ordinary grammatical construction of it, it claims a great deal, and it claims so much that a part of it to which that applies is

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<sup>42</sup> (1894) 11 R. P. C. 369 at p. 395.

too large ; that is, it includes something which cannot be patented, and therefore, it is bad". Now, that was doing exactly what Mr. Bousfield attempted to do, to read the claim by itself, and then say, upon the ordinary grammatical construction of it, it means a great deal, and a part of that great deal would include something which was old, and, therefore, it is bad. But Lord Hatherley, in *Arnold v. Bradbury*, as an instance of what I have been saying, that you must look at the whole instrument, says you ought not to look at the claim in that way ; you ought to read the Specification first to see what it is the man says he has invented, and what it is, therefore, that he proposes to patent, and having got that, then read his claim—read it fairly—and see whether then you find that the claim claims more than that which he has declared that he desires to patent, and which he describes as the thing to be done, and which he has invented. Lord Hatherley says at page 712, "I do not think that the proper way of dealing with this question is to look first at the claim, and then see what the full description of the invention is, but rather first to read the description of the invention in order that your mind may be prepared for what it is the inventor is about to claim. He tells you that he has now described and particularly ascertained the nature of his invention, and the manner in which it is to be performed, and then in the claim we do not find anything asserted or claimed as his invention beyond what is found in the previous part", that is, in that particular case. "Now, I am invited to consider that, as a general claim of all machinery that ever may be invented hereafter which can perform the operation which he here describes, but he introduces the claim by saying that his object is to state what he considers novel in his invention". Then he afterwards says that the claim is simply to point out what he considers to be novel in what he has already stated. Therefore, if you wish to construe the whole instrument, when the question arises on the claim, and to construe it fairly, you must look at the description of the invention, and then, having looked at that, see whether, upon a fair reading of the

claim, it goes further than to claim what is thus described. Lord Justice Lindley in the case of *Edison and Swan United Electric Co. v. Woodhouse and Rawson* 4 R. P. C., 107, says :—"It remains to consider the objections to the Specifications and claim. One is that the expression 'carbon gas or liquid' in the claim is ambiguous and too wide and misleading. It was urged that the expression includes carbonic oxide and carbonic acid, neither of which will do." Then he says :—"But every claim in every patent must be read and construed with reference to the Specification and not as if the claim was an isolated sentence having no connection with or reference to what precedes it." Well, that is the rule which I think is the right one, and it is the same rule as you would apply to the construction of any instrument. Read the whole of it before you determine upon an objection to any particular part of it. When you have read the whole of it, you must come back to that which is objected to, and see what is the fair construction of it, having regard to what you read before. You must not distort it ; you must not add to it ; you must not take from it ; you must construe it as it is, but construe it fairly. You must say what construction you put upon it".

### **Everything not claimed is disclaimed.**

It is essential in construing any patent Specification to recollect the well established canon of construction that everything which is not claimed is disclaimed.

The leading case in which this principle was established was *Harrison v. Anderston Foundry Co.*<sup>43</sup> It has been repeatedly and consistently followed.<sup>44</sup>

The result of the application of this canon of construction is that where a patentee has limited his invention for which he claims a monopoly by the description given by him in his claims, he cannot thereafter seek to enlarge the effect of his claims because he has described something wider in the body of his Specification.

<sup>43</sup> (1876) 1. A. C. 574.

<sup>44</sup> See *Fletcher-Moulton* at p. 119 to p. 122 where the principle is discussed.

It is immaterial whether the enlargement sought to be obtained of the claim is for the purpose of widening the net of the monopoly so as to catch an infringer who would otherwise escape, or for the purpose of including in the invention claimed some additional element which has the effect of making the invention new, in order to prevent the patent, without it, being bad for want of novelty. In either case the claims cannot be enlarged so as to add anything which is not in the claims themselves when fairly read.

Thus in *Ingersoll Sergeant Drill Coy. v. Consolidated Pneumatic Tool Coy. Ltd.*<sup>45</sup> where the patent was for a certain mechanism and it was sought to add to the claims by importing into them certain features of novelty described in the body of the Specification, it was held that the claims could not be made to carry a gloss imported from the Specification, when there was no indication in the claims themselves by which, even when construed in the light of the Specification, they could be said to include the elements in question.

The point was dealt with in the following passages in the judgment of Lord Loreburn L. C. in that case :—

“There can be no dispute about the law. Each Claim in a Specification is independent and a Plaintiff in an action for infringement must show that there has been an adoption of some new invention adequately described in a Claim when fairly construed. I am not aware that any special canons of construction are applicable to Specifications, nor am I able to accept, if indeed I rightly understand them, certain formidable generalisations presented to us in argument as to the principles on which they are to be interpreted. Obviously, the rest of the Specification may be considered in order to assist in comprehending and construing a Claim, but the Claim must state, either by express words or by plain reference, what is the invention for which protection is demanded. The idea of allowing a patentee to use perfectly general language in the Claim, and subsequently to restrict, or expand, or qualify what is therein expressed by borrowing this or that gloss from other parts of the Specification, is wholly inadmissible. I should have thought it was also a wholly original pretension. The point in this case is whether or not Claims 13 and 14 describe a new invention. The Defendants

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<sup>45</sup> (1908) 25. R. P. C. 61 at p. 82.



admit that they have adopted a mechanism which falls within the description properly read, but say that the mechanism there described is an old mechanism. The Plaintiffs say, on the contrary, that the description, properly read, is a description of a new mechanism. What, then, is it that is described? That is the first inquiry.".....  
....."According to Mr. Bousfield the piston means the piston with the circumferential groove and projecting stem described on page 3 of the Specification, or as altered in accordance therewith. The piston chamber also, it seems, means one complying with the description on page 2 of the Specification. So as regards the passages, because the Specification at page 4 describes the two passages as opening into the piston chamber at about the same point in its length, the Claim must also, we are told, be read as conveying that they are to be at about the same point. Again, because, at page 6, the Specification informs us that the rearward movement of the piston closes both the passages, we are to read that also into the Claim. And the reason urged for so qualifying the language of the Claim is that these things are essential to the success of the Plaintiffs' hammer as a working hammer. That would have been a good reason for inserting them expressly or by plain reference in the Claim had it been thought safe or wise to do so, but is no reason at all for reading them into the Claim when they are not there. One or two more glosses are sought to be added by Mr. Bousfield, but they are all on the same footing and need not further be discussed. Mr. Walter put it a little differently. He attributed a very special meaning to the words "independently of the piston", and said they were put in to show that no part of the live air passage is to be in the piston, meaning by the live air passage the whole distance from the source of supply to the valve. All I can say of this is that I can extract nothing of the kind out of the words used, even when illuminated by the rest of the Specification.

(The learned Lord Chancellor then considered the arguments in the case and proceeded.)

Accordingly it comes to this. We are asked to construe the Claim with reference to the Specification, not in order to understand what the former says, but to make it say things which in fact it does not say at all.

If such a process were admitted all certainty would vanish. No

one in construing a Claim would know how far he could rely on the words used or how to pick from the Specification the qualifying phrases. Patents are not unconditional grants of a monopoly. The patentee must, in return for his privilege, say plainly what is the invention for which he asks protection, so that others may learn that and its limits. And if he chooses separately to claim a subordinate invention he must make plain the metes and bounds of that also. I think the Patentee has made it plain in Claim 13, if it be fairly construed, and there is no novelty if the interpretation be as I think it is".

Accordingly the patent was held invalid for want of novelty.

As was said also by Jessell M. R. in *Hinks & Son v. Safety Lighting Co.*<sup>46</sup> :—

"I am anxious, as I believe every Judge is who knows anything of Patent Law, to support honest *bona fide* inventors who have actually invented something novel and useful, and prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of their specification so as to deprive the inventor of the benefit of his invention. This is sometimes called a "benevolent" mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention if it can be supported on a reasonable construction of the patent. Beyond that the "benevolent" mode of construction does not go. It never was intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him, whether or not it was an invention unknown to himself. It is for the patentee to tell the world that of which he claims a monopoly, to tell them, "You may do everything but this ; but this you must not do, this is my invention." With the view of getting this into a narrow compass, it has long been the practice of patent agents to insert in specifications the distinct claim of what they say is comprised in the patent, meaning that nothing else is comprised, that everything else is thrown open to the public, or, to put it in other words, if a man had described in his specification a dozen

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<sup>46</sup> (1876) 4. Ch. D. 607 at p. 612.

new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven, and he has no right to be protected as regards any one of the other eleven if he wishes to recall that gift which he has made by publishing the specification."

In certain circumstances claims may be construed as including matter essentially involved even though not specifically described.

On the other hand in certain circumstances it may be that though some element is not expressly mentioned in the claims of the Specification yet it is so essentially involved in the matter which is mentioned that it will be held to be included in the claim on a fair reading of the claim in the light of the rest of the Specification. In this case, it may be observed, the claim is not added to by the importation from the body of the Specification of a gloss which was not present in the claim itself: the words of the claim itself are on the other hand interpreted so as to carry their full meaning.

Thus in *Tweedale v. Ashworth*<sup>47</sup> the claim was construed as including an element of stretching in regard to cloth even though there was no specific mention of this in the claim. The Lord Chancellor on this point observed:—

"Now, my Lords, looking to the patent itself, and the Specification, I am unable to give any other construction to the patent here than that which involves the particular thing, with its own particular incidents, which is therein described; and I think that the fallacy of the argument which has been ingeniously suggested to us is this—it is said that there is no claim for the stretching. If by that is meant that there is in the claim no such word as "stretching", I agree the word "stretching" does not occur; but what there is in the claim is this: there is a claim for a thing which is described and illustrated by the description in the letterpress, and the drawings describe a machine, and describe the mode of manufacturing the machine, which of itself necessarily involves as one of the merits of the invention the power of stretching the material, at the same time and by the same operation as completing the machine. That, I believe, is the merit of the invention, and a very material merit of

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<sup>47</sup> (1892) 9. R.P.C. 127.

the invention, and it appears to me that being one of the important elements forming the substance of the invention, it is one which the Defendants have in no way invaded."<sup>48</sup>

Thus in that case, through the claim being given the wider of the two meanings in dispute, it was construed as monopolising an invention which was not infringed.

The distinction between these cases and such as the *Ingersoll Sargeant Drill Co.*'s case is a real one : though it may be difficult in certain circumstances to say which side of the line a given case may be, for the purposes of construction.

**Effect of the application of the canon that everything not claimed is disclaimed in cases where the claim is for a combination.**

It is as well to note one further important result which follows automatically from the application of the principle that everything not claimed is disclaimed, which is this. If his patent is for a certain combination only, then unless the Patentee has made separate claims for the separate integers or for the subordinate combinations which go to make up the combination claimed, the Specification will have to be construed as giving to the Patentee no monopoly for these ; even though they may be new in themselves. And if another person makes, sells or uses, as the case may be, one or more of such separate integers or one or more of such subordinate combinations, provided he does not infringe the whole combination claimed (*e.g.* by equivalents for certain parts), then there is no infringement and the Patentee has no redress<sup>49</sup>.

**Remaining defences referred to in Chapter XIV.**

There now remain for further consideration only those defences which were referred to in Chapter XIV under the numbers 42, 43 & 44.

**The defence based on an amendment of the Plaintiff's Specification. (No. 42 in Chapter XIV.)**

It may be worth emphasising that it may be a matter of vital importance to either party when a claim of infringement is put forward to investigate carefully precisely what manner of amend-

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<sup>48</sup> See also *Muirhead v. Commercial Cable Co.* (1895) 12 R.P.O. at p. 52.

<sup>49</sup> See *Consolidated Car Heating Co. v. Came* (1903) 20 R.P.O. 745 (P. C.).

ments may have taken place at any time during the life of the Patent and to ascertain precisely how the matters in issue may have been affected by such amendments. Such an investigation may in a particular case result in most useful and possibly unexpected discoveries.

Clearly if it be found to be the fact that the Plaintiff's Patent has been amended since the date of the alleged infringement in such circumstances that the act complained of was not covered at the time by the claims in the unamended specification, this will be a clear answer to any claim of infringement which may, by error, be sought to have been based on the Specification amended.

Clearly in such a case there will have been no infringement since there was no monopoly existing at the time of the alleged infringing act such as to cover the act complained of. This defence is merely noted for purposes of reference : and calls for no further comment. It is merely a specific instance of the defence already considered (and noted under number 41 in Chapter XIV) in a case where the alleged infringement is not covered by the claims in the Plaintiff's specification. It is however also in a sense the converse of a defence under Section 19 which is considered below.

**The defence under Section 19 : in certain cases where the Plaintiff's Specification has been amended.**

It is provided by Sec. 19 as follows :—

"19. Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act, no damages shall be given in any suit in respect of the use of the invention before the date of the decision allowing the amendment unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge."

Accordingly a statutory defence, as against a claim for damages only, is made available to a Defendant in a case of which the circumstances fulfil the conditions of this Section. A defence under the section will however be no answer to a claim for an injunction.<sup>50</sup>

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<sup>50</sup> The corresponding Section in the current English Act is Section 23. See *Terrell* (8th edn.) at p. 247. The same phrase "that a.....claim was framed in

The onus of proving that the original claim was framed with reasonable skill and knowledge will clearly, under the Section, be on the Patentee.

### Lord Moulton's defence.

In the defences to a claim for infringement which have hitherto been considered in this Chapter, it has been essential to look into the Plaintiff's Specification all these defences being based on matter contained in the Specification. The defence now under consideration, known as Lord Moulton's defence, is also based essentially on matter contained in the Specification, but owing to the peculiar dilemma created when this defence is raised, it becomes entirely immaterial to look into the contents of the Plaintiff's Specification at all.

The defence, as already indicated,<sup>51</sup> consists of an alternative plea in relation to the Plaintiff's Specification, that, either if the alleged infringing article or process is within the ambit of the Plaintiff's claims, then the Plaintiff's claim is invalid for want of novelty, or, if outside the ambit, then there is in fact no infringement. This alternative plea is raised indirectly in relation to the Plaintiff's Specification by means of referring directly only to the article or process, not of the Plaintiff, but, of the Defendant himself. The actual plea is that the Defendant's article or process which is complained of as being an infringement is not novel.

The defence was first notoriously originated and enunciated by Lord Moulton in the speech delivered by him in the House of Lords on the decision of the case of *Gillette Safety Razor Co. v. Anglo-American Trading Co. Ltd.*<sup>52</sup> It will be of interest to quote the *ipsissima verba* used by him on that occasion : which were as follows :—

"I now turn to the Defendants' razor, the alleged infringement. In it I find a razor blade, fixed transversely to a handle. This is effected by its being clamped tightly between two cheeks, the three

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good faith and with reasonable skill and knowledge" also occurs in Section 32A of the current English Act ; where the burden is imposed on the patentee of proving this in relation to an invalid claim when he desires relief on other valid claims.

<sup>51</sup> See page 545.

<sup>52</sup> (1913) 30. R.P.C. 465 at p. 477.

being screwed together by means of a screw out in the handle. The near cheek has its edge extended and cut into teeth, so as to form a guard, precisely as in Butler's safety razor. On comparing the two, I have come unhesitatingly to the conclusion that there is no patentable difference, no inventive step, between Butler's safety razor and that sold by the Defendants. To establish this, I will proceed to examine the precise difference in detail."

(The learned lord then proceeded to consider the qualities of the Defendants' razor in relation to a Specification of one Butler (not the Plaintiff) which was a Specification relating to an American Patent which had been published in England before the date of the Plaintiff's Patent sued upon in the action : and proceeded.)

"I am of opinion, therefore, that there is no patentable difference between the Defendants' safety razor and that shown and described by Butler. If the blade used by the Defendants be put into Butler's handle (and this, as I have said, involves no invention) you have a safety razor which is indistinguishable from the Defendants' razor in anything which bears on the question of invention. It follows, therefore, that no patent of date subsequent to the publication of Butler's Specification could possibly interfere with the right of the public to make the Defendants' razor. If the claims of such a Patent were so wide as to include it, the Patent would be bad, because it would include something which differed by no patentable difference from that which was already in possession of the public. Such a Patent would be bad for want of novelty. If the Claims were not sufficiently wide to include the Defendants' razor, the patentee could not complain of the public making it. In other words, the Defendants must succeed either on invalidity or on non-infringement.

I am, therefore, of opinion that in this case the Defendants' right to succeed can be established without an examination of the terms of the Specification of the Plaintiff's Letters Patent. I am aware that such a mode of deciding a Patent case is unusual, but from the point of view of the public it is important that this method of viewing their rights should not be overlooked. In practical life it is often the only safeguard to the manufacturer. It is impossible for an ordinary member of the public to keep watch on all the numerous Patents which are taken out and to ascertain the validity

and scope of their claims. But he is entitled to feel secure if he knows that that which he is doing differs from that which has been done of old only in non-patentable variations, such as the substitution of mechanical equivalents or changes of material, shape, or size. The defence that "the alleged infringement was not novel at the date of the Plaintiff's Letters Patent" is a good defence in law, and it would sometimes obviate the great length and expense of Patent cases if the Defendant could and would put forth his case in this form, and thus spare himself the trouble of demonstrating on which horn of the well-known dilemma the Plaintiff had impaled himself, invalidity or non-infringement."

This defence will be as good in British India to-day as it was in the United Kingdom in 1913 when it was so ably delineated by Lord Moulton.

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## **CHAPTER XVII**

### **ENFORCEMENT OF MONOPOLY RIGHTS BY PATENTEE LETTERS OF DEMAND—SUITS—PRACTICE AND PRO- CEDURE IN SUIT FOR INFRINGEMENT WHO CAN SUE—WHO CAN BE SUED—JURISDICTION— INTERLOCUTORY MATTERS—EX PARTE —INTERIM INJUNCTION—INTERIM INJUNCTION ON NOTICE—RELIEFS OBTAINABLE IN SUIT—PLEAD- INGS—ONUS—EXPERTS— ASSESSORS—FORM OF ORDERS—COSTS— APPEALS**

## **PART I**

### **PRELIMINARY OBSERVATIONS**

This chapter has for convenience been divided into five parts. This part is confined to certain observations of an introductory nature as to the enforcement of Patent rights generally. In the subsequent parts it is proposed to deal more in detail with various matters which arise in connection with the procedure in an infringement suit.

#### **Enforcement of monopoly rights by Patentee.**

Having previously considered for what, and by whom, and how a valid patent may be properly obtained and what are the requisites of a valid patent, (See Chapters 6, 7, 8 & 9), a consideration of which matters will have enabled a patentee to judge that his patent is valid and his monopoly is good and inviolable, and having considered in effect (in Chapters 14, 15 & 16) what may be adjudged to be an infringement of the monopoly, it now remains to consider the means by which and the procedure by which the patentee can enforce his monopoly rights against infringers.

**Enjoyment of patent rights is entirely dependent upon legal remedies.**

It has long been recognised that the rights and benefits of a patent would, both, be negligible if the law did not provide some remedy for the patentee against those who may invade those rights. The right to any species of corporeal property may, to a great extent, be vindicated by the physical means at the command of the owner and in physical possession. But with respect to an incorporeal right such as a patent monopoly, which is a mere creature of the law, the proprietor must depend almost entirely upon the law itself for vindication and support.<sup>1</sup>

**Ancient remedies in England in the Court of the Star Chamber.**

Originally the infringement of patent rights in England was a wrong for which neither the ordinary common law nor the early statute law of England provided any remedy.<sup>2</sup> It was however cognizable by the Court of the Star Chamber: either as a contempt of the royal authority<sup>3</sup> or under its general jurisdiction for the repression of "cozenage": cozenage being defined as "*an offence whereby anything is done guilefully in or out of contracts which cannot fitly be termed by any special name*".

It may be noted in passing that the manner in which the Star Chamber used to exercise its jurisdiction was by inflicting punishment on the wrongdoers both summarily and with severity: thus "apprentices or servants of the patentee attempting to reap the fruits of his ingenuity.....were to be treated as first rogues and then whipped".<sup>4</sup> Such exercise by the Star Chamber of its jurisdiction over the infringers of patent rights was found to be objectionable not only on account of its severity, but because, being a creature of the Crown itself, it supported any grant which the Crown thought fit to make; and considered every infringement of letters patent as a contempt. It was no doubt the unreasonable oppression with which, prior to the passing of the Statute of Monopolies, those monopolies were enforced against the public, that

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<sup>1</sup> See *Edmunds* p. 246 citing *Hindmarch* p. 248.

<sup>2</sup> See *Edmunds* p. 147 citing *Coryton* p. 262.

<sup>3</sup> See *Edmunds* p. 272 citing *Webster on Letters Patent* p. 42 n (y).

<sup>4</sup> See *Edmunds* p. 247 citing *Coryton* p. 262 and authorities there cited.

for long retarded in the United Kingdom the proper development of the patent system.

In this respect the following observations of Hindmarch may be of interest :—

“In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies, which was engendered by the monstrous oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That Statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies ; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the judges began to determine questions respecting patent rights fairly between the patentees and the public.”

#### **Jurisdiction removed from the Court of Star Chamber to the Court of Common Law.**

In 1623 in England by the Statute of Monopolies it was provided that all questions affecting the force or validity of letters patent should be heard, tried and determined in the Courts of Common Law, according to the common laws of the realm and not otherwise ; and an action at law in England was declared and recognised to be the proper remedy for infringement of patent rights.

#### **Former dual remedies under English law at common law and equity.**

From the time of the Statute of Monopolies there followed a period up to the passing of the Judicature Act in 1873 when in England there were, in varying degrees, dual remedies available for the infringement of patents ; for which the patentee might invoke respectively, the Common Law and Equity.

The change of forum from the Star Chamber to the Common Law Courts was no doubt a big advance towards the determining

of questions fairly between the patentee and the public. The restricted nature of the remedies which were at that time available to a litigant in an action on the case in the Common Law Courts should not however be lost sight of.

The Common Law gave him the right, through an action on the case in a court of law to damages : but damages only and no injunction. A court of law could only give the patentee damages for any actual injury he had sustained by the violation of his rights ; and had no power to prevent future infringements. What is more, it had no power to order discovery and inspection or the taking of accounts or any such matters by way of interlocutory procedure in the action on the case as would provide any adequate machinery, by which the full extent of any infringement which had been committed could be ascertained.

The remedies available at the time in the Courts of Equity though they could not grant a decree for damages were not so restricted. These could grant injunctions which would relate to the future and would often prove a more valuable remedy than damages for acts done in the past. What was more, a Court of Equity could order discovery and inspection and the taking of accounts.

It must have become obvious at once that if the jurisdiction of the Courts of Equity could be invoked by a patentee this would be to his very great advantage. The observations of Hindmarch as to these advantages in a Court of Equity are of interest :—

“The Court of Chancery by means of its process of injunction, could protect the patentee against the future invasion of his privilege. It could command a person who had once violated a patent right to refrain from committing any repetition of the offence, on pain of rendering himself liable to be punished by attachment, and imprisonment for contempt at the discretion of the Court”.....

“(Again) the infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is in consequence very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to

show by legal evidence in a Court of law, the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has the power, not possessed by a Court of law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff's bill and to make a full discovery of everything which is necessary to enable the court to do justice between the parties."

The question then was, the Statute of Monopolies having given recourse to the Courts of Law only, how means could be devised by which a patentee might have recourse also to the Courts of Equity: that is to say the Court of Chancery as it existed at the time.

Equity, according to its maxim, followed the law. According to the strict theory of this maxim, therefore, it could claim no independent jurisdiction in respect of the privilege, or the infringement of the privilege, created by letters patent.<sup>5</sup> However in spite of this maxim (or partly to a limited extent at first because of it) the Court of Chancery did come to interfere for the purpose of assisting patentees to enforce their patent rights; and as time went on it tended to do so in an increasing degree. The history of the growth of this equitable jurisdiction though curious and instructive, as was remarked by Edmunds, is not required for present purposes to be gone into in detail; since it has little direct importance at the present day even in England and still less in India. It is sufficient here to note that as a beginning the jurisdiction of the Court of Chancery was confined to interference on principles similar to those which determined its action in cases of nuisance, breach of contract, waste, the invasion of copyright, or of the property in trade secrets or trade marks, that is to say for the purpose only of protecting the property of the patentee until his legal right could be ascertained by the jurisdiction to which it properly belonged. That it also showed itself ready to interfere to lend its equitable remedies to assist a patentee, whose legal rights had been established, to enforce those legal rights; but in doing so it exercised its jurisdiction only in aid of a patentee whose legal right was clear and undoubted, and refused to enforce a claim under any letters patent until their validity had been tested by an action

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\* See Edmunds p. 249 citing *Calcroft v. West* (1845) 2 Jones & Lat 128.

(in the Common Law Court) at law. And that, by a logical and historical coincidence, some of the principles which underlie the decisions of cases at the present day have their origins not only in their mere reasonableness in logic but in this historical development of the jurisdiction of the Court of Chancery.

**Survivals in present patent Law partly traceable to the history of the development in England of these dual remedies.**

Thus the reluctance of a Court at the present day to grant to a Plaintiff an *interim* injunction when the validity of the Patent is denied by the Defendant, or when the Plaintiff has not previously obtained a certificate of its validity, is in the direct line of sequence with the fact that at one time the Court of Chancery, by which alone injunctions could be granted, was considered to have no jurisdiction to grant any injunction or to interfere at all in any case where the patent rights of the Plaintiff had not been previously validly established in a common law court. Today in England, though all such distinctions between the equitable and the legal remedy have vanished, yet because of the reasonableness of the principle that an *interim* injunction should not be granted in a case where the Plaintiff has not established the validity of his patent, this principle is still enforced in the Courts in the decision of current cases. It is submitted that the same principle will be enforced in the courts in India ; both on account of its good sense and on account of its having become now in India as in England an inseparable part of the current patent law. It is submitted that in the construction of the Act, where there is no difference in wording between the English and the Indian provisions, when it is established that certain principles are enforced in England, those same principles will be enforced in India ; the English cases being taken as a guide and as authoritative on similarly worded passages. It would otherwise be necessary in considering the English cases in some instances to eliminate those principles in them which are the outcrop merely of an historical development in England which has not had its complete counterpart in India ; and to retain for Indian law only those principles which have been evolved strictly from a process of pure logical construction in regard to the wording of the Indian Statutes in question. This would for practical purposes be a well nigh hopeless task. The choice will then be of taking the principles in their entirety or not

at all. Since India has had little patent law development and England has had much, and since it has often been observed that in England the Act by itself would not supply a proper working system without the supplementary case law, it is submitted that it is preferable, in cases where the questions for decision are similar, to take as good Indian law the principles embodied in the decisions of the English cases, for the most part as they stand.

After all, in all legal history it has always been the case, that when any part of the system of the law of one country has been imported by another, certain of the legal fictions of the country of origin have also perceptibly or imperceptibly been imported too. It is inevitable : in many cases, the bare system of law in question would not be found to work at all in practice if some of its fictions—long buried in the past—from which it has been evolved were not used in conjunction with it. But it will not be every legal fiction which will be imported. The subject is a difficult one, and one more to be treated fully in a work on historical jurisprudence than in the present work. The subject does however, for the reasons noted, have a positive bearing in relation to the principles of law to be applied in the disposal of patent cases in India.

To return to the example which gave rise to this discussion, it is submitted that in India in deciding whether or not to issue an *interim* injunction in a patent suit, reliance may be placed in an Indian Court on such decisions in the English cases as those enunciating the principle that an injunction should not be granted unless the validity of the patent has been established. And it is submitted that the decisions in these cases may be relied on as they stand without attempting to strip these English cases of those parts or passages in them which may represent the outcome of the peculiar English fictions—long since buried—which only arose through the peculiar English history of the English Equity Courts.

It is unnecessary here to speculate further how far in certain respects the present patent law in India owes its origin to the historical development in the past of the law and of the law courts across the seas ; or to take other examples of this growth. An understanding however of the origins and growth of the remedies which were formerly available in England to a patentee in protecting himself from infringement and in enforcing his patent rights

must be, even on a cursory discussion such as this, not without interest in considering the modern methods and remedies which are applicable in India today.

### **All remedies of a civil action now available.**

In 1873 when the fusion of law and equity was effected in England by the Judicature Act, both remedies for damages and for injunction became available in England in the same Court and in the same action. Moreover all the machinery of the two procedures both of law and equity which had been available till then only in either an equitable or a legal court, became available in one and the same court to the patentee-litigant in his action. Since then the patentee has in England continued to have at his disposal, for the purpose of enforcing his patent rights, all the very adequate remedies which are available in an ordinary civil action ; (no matter whether his action is instituted in the Chancery Division or the Kings Bench Division of the Court).

In British India similar remedies, equally effective, are available to the patentee today in a civil suit. Ever since the grant of the earliest monopoly or patent, the redress of the monopolist against infringers has been through the Civil Courts. It has never been sought even under the most recent Patent legislation either in England or in India, notwithstanding the technical complexity of many Patents and of the questions which arise in a case concerning their alleged infringement, to give the Patent Office or the Controller the power of deciding an infringement claim. Nor has it been sought to make the infringement of a Patent by any legislation either in England or in India a crime.\*

### **Reconnaissance.**

In one important practical feature the position of a patentee in regard to the enforcement of his remedies against an infringer differs considerably from the position of most other persons against whom a tort has been committed. In a running down case the person run down is, from the very nature of the circumstances of the tort, bound to be present in person when the tort is committed. In a case of trespass and damage to land it is likely that the owner of the land while walking round his estate may see with his own

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\* See page 536 above.



eyes either the trespass being committed or at least the scene of the trespass and the damage. And so in varying degrees of proximity with other torts. But in the case of an infringement of patent, where the patentee may be resident in Calcutta and the infringer may commit his infringement in Delhi or Peshawar or Madras, places several days distant from each other by express train, where the patentee may not even have an agent or correspondent, it may well be that the patentee will have had no knowledge at all even of the fact of any infringement having been committed, much less of its precise nature, unless he has taken special precautions to keep himself informed.

It need hardly be emphasised that as a matter of business and for selling purposes, just as a good organisation of sales agencies, with an efficient system for the distribution of a wide knowledge of the goods sold among prospective purchasers is most useful for promoting sales, so a good system of reconnaissance in all competitive markets with an efficient system for the collection of knowledge as to what goods are being sold by competitors is equally essential. No one except the patentee is interested to prevent the sale of such goods by others as are an infringement of his monopoly. Therefore if he does not care to make the necessary enquiries to ascertain when and where and by whom infringing goods are being sold, no one else in all probability will do so. If the infringement of patents were a crime, he might have the assistance of the police (as has to some extent the owner of a registered English trade mark). As it is nothing but a civil private wrong, in which neither the state nor anyone but himself is concerned, he must act as his own policeman : or at least as his own intelligence service.

One thing is certain : if he takes no steps to keep himself supplied with the proper intelligence he will not know when infringements are being committed, and if he does not know of them, he obviously cannot take any steps to stop such infringements or to enforce his own monopoly rights. And if he does not do this, he will lose all benefit from his monopoly ; and might as well have no Patent at all. Even if he only allows some infringements to be effected with impunity, for every sale lost he will certainly suffer a corresponding loss of profit : but he may also suffer loss and damage

beyond such mere loss of profit by reason of damage to his reputation or to the good name of his patented article.

What steps he will take for keeping himself supplied with the necessary intelligence is a matter of business for every manufacturer and patentee to consider and decide for himself; and hardly calls for any discussion here. If he has a wide system of sales agencies, he will no doubt use this as his intelligence service. If not he may be well advised to employ a reputable patent agent who is in a position to be kept in touch with the competing markets and to bring any infringements to the patentee's notice promptly.

There has been in India lately a large quantity of importations from abroad (and in particular from Japan) of an infringing nature. As it often happens, where an imported article is actually an infringement of an Indian Patent, that it is also in other respects an act in breach of the Merchandise Marks Act, it is possible that in some cases the watchful patentee, or his patent agent, may be able to receive useful information from enquiries made from the Customs authorities.

#### **Letter of demand.**

When information has been received of an infringement, it is important that a letter of demand should be sent, preferably by a Solicitor or responsible Patent Agent, on behalf of the Patentee, to the infringer without delay. The consequences of undue delay may be serious. At the same time it is most advisable that full enquiries should be made to confirm not only the fact of the infringement but the fact that the person proposed to be addressed in the letter of demand is in fact the person responsible for it, before any such letter of demand is despatched. The consequences of making an unwarranted threat against an alleged infringer who has in fact committed no infringement, may also be serious.<sup>7</sup>

In very many cases a properly couched letter of demand may in itself effect a complete remedy; and effectively put a stop to all further infringement and any further trouble. It may be that the infringer has been acting *bona fide* and has no desire to infringe the patent and is only too ready to desist as soon as the real state of affairs is brought to his notice. Or it may be that while not acting entirely in ignorance, and while ready enough to infringe if he can

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<sup>7</sup> See Chapter XIX.

do so with impunity and without interruption, yet the infringer has no wish to continue after being found out; and has no desire to waste any money defending an expensive and defenceless suit for infringement. In either case such persons will readily come to terms: the precise terms being a matter of negotiation for each individual case.

#### **Contents of the letter of demand.**

It is important to make sure that the claim for infringement is being made against the right person. It is often found in practice, where the infringement is a wilful infringement, that a baffling sequence of Firms and Companies, together with the requisite consecutive series of assignments of the business from one to another of these, is created. These serve as a screen behind which certain individuals may seek to continue their infringing activities. In such a case it may become a matter of some difficulty to obtain all the necessary information as to the different concerns, such as the date when each commenced or ceased business and the different personnel and ramifications of each; and it may become a matter of some nicety to affix the liability for particular acts of infringement on the correct concerns or individuals. Even in more innocent infringements questions will arise, as between principals and agents or dealers, on whose shoulders the responsibility for the infringement should fall.<sup>8</sup>

The demands to be made in the letter of demand should with advantage correspond with the rights to relief which the Patentee hopes to establish in his infringement suit in the event of its becoming necessary to proceed with such a suit; though it is of course possible for the parties when attempting to settle the matter at this stage without going to Court to stipulate for any preferred terms or conditions which may be suitable to the individual case, even though such terms might embody conditions or reliefs which it may not be open to the Patentee to obtain as of right in a suit in Court. The following points may be referred to in such letter:—

(i) The patentee may state who he understands the addressee of the letter to be, and how concerned in and how legally liable for the infringement complained of. This may call forth a denial or explanation from the addressee which, if he is in truth free from

liability, may relieve the Patentee of the useless expense of proceeding with a useless suit ; or which in other cases may be of use in giving the Patentee useful information regarding the true position.

(ii) The letter may then give Notice of the precise nature of the Patent or Patents held by the Patentee.

(iii) The letter may also give Notice of the precise nature of the infringements complained of.

(iv) The Patentee may then request the addressee to comply with the following demands :—

- (a) to admit in writing the Patentee's monopoly (as previously described).
- (b) to discontinue the infringing acts.
- (c) to give an undertaking (in terms to be approved by the Patentee) not at any future time to commit the infringing acts complained of.
- (d) to give full particulars of all infringing goods or of all dealings therewith : with figures of stocks etc.
- (e) to furnish full accounts of all profits.
- (f) to pay over a sum to cover all such profits when ascertained.
- (g) to furnish the names and addresses of all persons from or through whom the infringing goods have been received.
- (h) to furnish the names and addresses of all persons to whom the infringing goods may have been sold or delivered.
- (i) to deliver up to the Patentee all of the infringing goods themselves and also all articles used in connection with the infringing acts : including any Advertisements, Catalogues, Price-Lists, Wrappers, Boxes, Cartons or other packages or packing materials, Marks, Labels, Dies or whatever be the articles that may be used in the particular case.
- (j) (if suitable) to advertise, or to allow the patentee to advertise (at the expense of the addressee) in certain specific papers in the manner of some specified and

approved advertisement which will have the effect of notifying the public that the addressee has no exclusive right of the nature which might otherwise have been indicated by the infringing acts complained of; and withdrawing certain specific claims if any such have been previously made in any respect by the addressee.

(k) to pay all costs, if any, which may have been incurred by the Patentee (including the costs of the advertisements mentioned.)

(v) The letter should give a reasonable time for the addressee to comply with the demands made : and should definitely give notice that unless such demands are complied with within such time the Patentee will take such steps without further notice as he may be advised, by suit or otherwise to enforce his rights.

#### **Remedy by civil suit in court.**

Where the letter of demand is not effective in leading to a sufficient remedy or settlement, the Patentee can enforce his rights by a civil suit in court. This is his final and effective remedy : it is also, where the infringer is obstinate, his only one.

#### **Final reliefs obtainable in the suit.**

It is important here to note the various forms of relief which it is open now-a-days to the Plaintiff finally to obtain by means of such suit for infringement. These may be here summarised as follows :—

- (a) Final injunction.
- (b) Damages.
- (c) Account of profits (as an alternative to (b) ).
- (d) Order for delivery up or destruction of infringing stocks.
- (e) Certificate of validity questioned.
- (f) Costs.

It is advisable from the outset to bear these matters in mind since the attainment of one or more of these final reliefs will be the sole object of the whole suit.

It is proposed however, to postpone the fuller consideration in detail of these matters to a later portion of this chapter.<sup>9</sup> It

• See Part V.

being convenient first, to make certain observations regarding matters preliminary to the suit and regarding the interlocutory procedure in the suit, since various matters of such nature will in practice arise at an earlier stage of the proceedings.

**Preliminary matters, Interlocutory reliefs and other subsidiary matters connected with the disposal of the suit.**

Before the institution of the suit and between the filing of the Plaint and the hearing of the suit, to enable the more certain acquisition finally of the main reliefs abovementioned, certain preliminary and interlocutory and subsidiary matters will call for early consideration. It will also in all probability, become necessary to ask for certain interlocutory reliefs from the court. It is proposed next here to consider such matters of procedure under certain main heads dealing with various sub-heads *seriatim* as follows :—

**Matters relating to the institution of the suit such as may arise prior to the filing of the Plaint.**

**1. Parties—Who can sue as Plaintiff.**

As to Assignees.

As to Licensees.

As to Aliens.

As to who may sue after the death of the Patentee.

As to joinder of Plaintiffs—where there is more than one patentee—whether all must join as Plaintiffs.

As to who may sue after the death of one of several co-patentees.

**2. Parties—Who can be sued as Defendant.**

As to joinder of Defendants—where there is more than one infringer.

**3. Joinder of causes of action.**

As to where there is more than one patent.

As to joinder of breach of patent rights with other causes of action.

As to the result of non-joinder or mis-joinder of Plaintiffs or Defendants.

As to the result of mis-joinder of causes of action.

4. Court in which the suit may be brought—jurisdiction—  
“District Court”.

5. Limitation.

6. Questions of estoppel and *res judicata*.

As to where there have been previous proceedings  
between the same parties.

As to where there have been previous proceedings  
between different parties.

7. Inspection of Defendant's machine before filing of Plaintiff.

As to inspection of Documents before filing of Plaintiff.

8. Service of the Writ of Summons in the suit.

These matters will be dealt with in Part II of this chapter.

Other preliminary matters such as may arise prior to the hearing of the suit itself.

1. The Plaintiff.

As to contents.

As to particulars of infringement (particulars of breaches).

As to English practice and Indian practice.

As to whether Plaintiff may give evidence outside his  
particulars of breaches.

2. Interim injunction.

As to an *ex parte* application.

As to an Application on Motion after notice to Defendant.

As to the undertaking as to damages.

As to other terms.

As to an alternative order : an undertaking by Defendant  
to keep accounts.

As to costs.

As to a compromise of the suit with the motion.

As to appeal from an order granting or refusing an  
interim injunction.

3. Appearance of the Defendant in the suit.

4. The remaining pleadings—The Written Statement.

As to time for filing.

As to contents.

As to a counter-claim for revocation in the written statement.

As to particulars of objections.

As to a Written Statement by plaintiff in reply.

5. Further and better particulars.  
(As to appeal)
6. Notice to admit facts and documents.  
(As to an admitted Brief of correspondence).
7. Amendment of pleadings.  
(As to amendment of particulars of breaches or of particulars of objections).  
(As to amendment of the specification).  
(As to appeal).
8. Obtaining directions : generally.
9. Application for discovery and inspection of documents.
10. Application for inspection of apparatus.
11. Application regarding the making of experiments : and for appointment of experts to make experiments and report.
12. Application for limiting number of scientific witnesses.
13. Application for administering interrogatories.
14. Application for commission.  
(As to appeal).
15. Application for hearing with assessors.  
(As to costs).
16. Application for hearing of the suit in camera.
17. Application for consolidation of suits.  
(As to appeal)
18. Application for stay of the suit.
19. Application for an early date to be fixed for the hearing.
20. Application for judgment on admissions.
21. Application to have the suit placed on the undefended list.
22. The Special List.  
(As to appeal).



As to right to file fresh suit after dismissed on Special List.

23. Questions arising regarding the settlement of the suit.

The abovementioned matters will be dealt with in Part III of this chapter.

**Matters which may arise at or in connection with the hearing of the suit.**

1. Trial of preliminary point first.
2. Application for adjournment.
3. Onus.
4. The right to begin and the right to reply.
5. Inspection by the Court.
6. Whether a party is entitled to a decision on all points.

The abovementioned matters will be dealt with in Part IV of this chapter.

**Matters relating to the final reliefs obtainable in the suit.**

1. Final injunction.

As to the nature of the remedy : its extent : not perpetual.

As to the form of the final injunction.

As to a stay of the injunction where the Defendant appeals.

2. Damages.

As to the option of the Plaintiff to have either damages or an account of profits.

As to the distinction between damages and profits.

As to the circumstances in which a decree for damages may be obtained.

As to the extent of the period before suit over which damages or profits may be claimed and calculated.

As to the measure of damages if the Plaintiff does not himself manufacture.

As to the measure of damages if the Plaintiff is himself a manufacturer.

As to the effect of a decree for damages in respect of the infringing goods.

3. Account of Profits.

4. Order for a Reference to ascertain either Damages or Profits, as the case may be.

As to the form of the order.

As to inspection for the purpose of the reference.

As to a stay of an enquiry as to damages or an account of profits where the Defendant appeals.

5. Order for delivery up or destruction of stocks.

As to the nature of the remedy : additional to damages.

As to the form of the order.

As to a stay of the order for delivery up where the Defendant appeals.

6. Certificate of validity questioned.

As to the nature of this relief : and the effect of a certificate.

As to the practice regarding the grant of the certificate.

As to cases where the Defendant does not appear or abandons the defence.

As to the discretion of the Court.

As to appeal.

7. Costs.

As to costs between Attorney and Client.

The above mentioned matters will be dealt with in Part V of this Chapter.

**Matters relating to further proceedings subsequent to the decree in the infringement suit.**

1. Application for stay of execution.

2. Appeal.

3. Execution proceedings.

4. Contempt proceedings by motion for breach of an injunction granted in an infringement suit.

As to cases where the second mode of infringement is not the same as the original infringement which gave rise to the injunction.

As to proceedings against a person who was not a party to the original suit.

As to the liability in contempt of Directors personally.

As to cases where the Patent has been amended since the injunction.

As to the form of the order to be made.

The above-mentioned matters will be dealt with in Part VI of this Chapter.

## PART II

### AS TO MATTERS RELATING TO THE INSTITUTION OF THE SUIT, SUCH AS MAY ARISE PRIOR TO THE FILING OF THE PLAINT.

These matters are now discussed in this part of this chapter separately under the headings already indicated at page 645, such different headings being consecutively numbered merely for convenience of reference.

#### 1. Parties—who can sue as Plaintiff.

By Section 29(1) of the Indian Act of 1911 the right of suit is given only to the patentee. By Section 2(12) the term patentee is defined as meaning "the person, for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent". Since the cause of action arising for infringement is wholly dependent on, and created by, statutory law and since the right to sue on such cause of action is limited accordingly to such right only, as is within the Indian Patents and Designs Act of 1911, it follows that no one not in the position of a person to whom the right to sue is given under Section 29(1) of that Act can bring any suit for infringement. It would follow then that no mere equitable owner of the monopoly rights of a patent is entitled to bring a suit in his own name.

The statutory definition in Section 2(12) which was inserted in the Indian Act of 1930, now precludes any person suing except the person whose name is on the register. If any person though not registered, should consider that he is rightfully entitled to the patent,

the proper course will now be for him first to bring an application for rectification of the register.<sup>10</sup>

### As to Assignees.

From what has been said it follows that where an assignment of a Patent has been perfectly effected except that the name of the assignee has not been entered on the register of patents, such person would not be entitled to sue in his own name.

Even where there has been a registration of the assignee as patentee, questions may arise as to the validity of such assignment and as to the right of such assignee to sue for infringement. It is unnecessary here further to discuss these matters which have already been considered in Chapters XV and XVI in connection with the question what constitutes an infringement and the defences thereto.<sup>11</sup>

Where there has been an assignment after the date of the institution of the suit, there appears to be nothing to prevent the original Plaintiff from continuing the suit in his own name. But it has been held in England that the assignee may be added as a party.<sup>12</sup>

It is submitted that in India also such assignee may be so added as a Plaintiff if not as coming directly within Order 1, Rule 1, since it may be said that in such circumstances there is no right to relief in the Assignee, yet as being within Order 1, Rule 10 of the Civil Procedure Code.

### As to Licensees.

It follows also from what has been said above that a licensee, since he is not the registered patentee, cannot sue in his own name. It is manifest that no mere personal agreement, such as is the licence between the patentee and the licensee, can confer rights on the licensee against the public.<sup>13</sup>

It may be that his agreement with the patentee under which he obtained his licence contains a clause making it obligatory for the

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<sup>10</sup> See remarks at pages 542 (No. 24), 582, and 494.

<sup>11</sup> See pages 542, 582 and 583.

<sup>12</sup> See *Bates Valve Bay Co. v. B. Kershaw & Co.* (1920) *Ltd.* (1933) 50. R. P. C. 43.

<sup>13</sup> See *Heap v. Hartley* (1889) 6. R. P. C. 495 (C. A.) at p. 500: *Wingquists Patent* (1923) 40. R. P. C. 261 at p. 268. See *Terrell* p. 254.

patentee to institute suits himself or to allow suits to be instituted in the name of the patentee when required so to do by the licensee. Otherwise it is to be observed that the licensee may be without adequate remedy against infringers.<sup>14</sup>

It has been held in a recent case<sup>15</sup> that a licensee might be joined as a co-Plaintiff with the patentee in a suit for infringement.

#### As to Aliens.

It has been held in England that an alien enemy cannot institute or maintain an action in the Courts as Plaintiff; nor in the case of joint ownership of a patent as co-Plaintiff.<sup>16</sup>

There is nothing to prevent an alien from making application for and obtaining a patent. There is equally nothing to prevent an alien who is not an enemy-alien suing as Plaintiff for infringement in his own name.<sup>17</sup>

<sup>14</sup> There is one class of case which forms an exception in England to this general rule that a licensee is not entitled to sue. This class of exceptional cases arises purely under Section 27 and Section 24 of the English Act which refer to the rights of persons obtaining licences of right or licences on grant from the Controller in cases where there has been an abuse of monopoly on the part of the patentee. Under Section 24(1)(d) and Section 27(3)(b) such a licensee is given a statutory right of bringing a suit which will enable him fully to protect the monopoly of the patent in which he is interested. There are certain provisions, crudely stated, in the Indian Patents & Designs Act of 1911 in Sections 22 & 23, which give certain powers to the Governor-General in Council in certain cases, where an abuse of monopoly on the part of a patentee is established, to grant compulsory licences to applicants. But no details are formulated in the Act as to the rights of such a licensee after he shall have obtained such a compulsory licence. There appears to be no provision in the Act to enable him either to compel the patentee to bring a suit or to bring a suit in his own name in such a case. In view of the express provisions of Section 29(1) of the Indian Act (above, already referred to) it would seem clear that such a compulsory licensee in British India has no right to sue in his own name any more than any other licensee, and accordingly no power to take any adequate steps to protect the infringement of the patent in which he is interested.

<sup>15</sup> *Trico Products Corpn. and Trico-Folberth Ltd. v. Romac Motor Accessories Ltd.* (1934) 51. R. P. C. 90.

<sup>16</sup> See *Porter v. Freudenberg* 1915. 1. K. B. 857; *Actiengesellschaft für Anilin Fabrikation in Berlin v. Levinstein Ltd.* (1915) 32. R. P. C. 140 (C. A.); compare *Mercedes Daimler Motor Co. Ltd. v. Maudslay Motor Co. Ltd.* (1915) 32. R. P. C. 149.

<sup>17</sup> See also what has been said above as to applications for patents and applications on a communication from abroad : see page 336, also page 347.

**As to who may sue after the death of a patentee—devolution of the patent as his personal estate—survivorship of the right to sue.**

In view of the terms of the grant being expressed as being to the patentee himself and to his legal representatives, it is clear that the patent rights created by the grant do not cease on the death of the patentee.

It is well settled that the property in a patent passes by devolution of law on the death of the patentee, as his personal property.

It appears also to be settled even under English Law in the United Kingdom that a right to sue for infringement which has accrued in the lifetime of the patentee survives after his death to his legal representatives.<sup>18</sup>

The general doctrine "*actio personalis moritur cum persona*" does not apply in British India, in view of the express provisions of the Section 306 of the Indian Succession Act (Act XXXIX of 1925) which are as follows :—

"306. All demands whatsoever and all rights to prosecute or defend any action or special proceeding existing in favour of or against a person at the time of his decease, survive to and against his executors or administrators ; except causes of action for defamation, assault, as defined in the Indian Penal Code, or other personal injuries not causing the death of the party ; and except also cases where, after the death of the party, the relief sought could not be enjoyed, or granting it would be nugatory".<sup>19</sup>

Thus it has been held that even where a suit for malicious prosecution was instituted by the deceased, the right to sue did not abate with his death.<sup>20</sup>

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<sup>18</sup> See *Fletcher Moulton* pp. 6 and 7 and see *Batey & Sons v. Dalton* (1887) 35. Ch. D. 700 (as to infringement of a trade mark) also *E. M. Bowden's Patents Syndicate Ltd. v. Herbert Smith & Co.* (1904) 21. R. P. C. 439. Contrast the position where the patent has passed not by death but by assignment : see page 592 above.

<sup>19</sup> *c.f. Sharifa v. Munekhar* (1901) 25. Bom. 574.

<sup>20</sup> *Krishna v. Corporation of Calcutta* (1904) 31 Cal. 993.

Similarly, it is submitted, it is clear that in British India a right to sue for infringement of a Patent, where the Patentee instituted a suit before his death, will clearly survive under the section.

Equally it seems clear that in British India a right to sue for infringement will also survive to his legal representatives even if no suit was instituted before the patentee's death ; in view of the clear terms of this section.

**As to joinder of Plaintiffs—where there is more than one patentee—whether all must join as Plaintiffs.**

When there are two or more persons who are co-owners of a patent and it is desired to institute a suit for infringement of that patent, it may become necessary to decide whether it is essential under Indian Law that all the co-owners should be joined as Plaintiffs or not. It is submitted that the only safe course is to join all co-owners of the patent as Plaintiffs.

It is true that the contrary view is adhered to in *Terrell* (1934 : 8th edn.) at p. 369 where it is suggested that according to the law in England one co-owner may sue for infringement without joining the others. But as to the law in England, of the two cases cited there, the one *Turner v. Bowman* (1925) 42. R. P. C. 29 hardly appears to be a strong authority for the proposition mentioned ; though it does appear that Astbury J. did in that case grant an injunction when there was only one of two co-owners of the patent before the Court. There appears to have been no argument on the point in the case : see the report at page 41. The other case, *Sheehan v. Great Eastern Railway Co.*, (1880) 16. Ch. D. 59 was a claim by one of several co-owners, suing alone as Plaintiff, not for infringement but for payment of royalties. For the contentions raised in that case reference may be made to the arguments at pages 60-62 of the report. The judgment is certainly very distinct and definite on the point that the one co-owner was entitled to sue alone for his share of royalties. Actually in that case it was not necessary for the Court to decide that point ; in view of its being found as a fact that for the period during which the patent had been used by the Defendants the Plaintiff had in fact been sole owner of the patent ; the assignment of shares which was relied on by the Defendants not having taken place until after that period. It may be said therefore that the absence of an appeal against that decision is not conclusive as to the value of the reason-

ing on which the decision was purported to be based. It is to be noted too that case ended in a compromise by consent. Nevertheless it must equally be conceded that Vice Chancellor Malins stated his decision on the point in question with all the force and definiteness possible and that his decision on that point appears never to have been since definitely overruled or criticised as being an incorrect statement of the law in England. Passages of his judgment which are material are as follows :—

“The Defendants take this objection, that the Plaintiff cannot sue alone—that he ought to have made his co-owners parties to the action, and they therefore object to the action proceeding in its present form. There are three defences to this objection. I will take the second first, which is, that one of several owners of a patent is at liberty to sue alone, and if that is a valid answer, then the other two defences will be needless. My opinion is that one person interested in a patent is entitled to sue, without making his co-owners parties to the action, either for an injunction or for an account. I might put a case of this kind : Suppose a person is entitled to an estate jointly with others, and a wrongdoer insists upon cutting down timber upon the estate, what is there to prevent one owner from suing without his co-owners being parties to the action ? He certainly would be entitled to sue to prevent the wrong being done. It is in principle the same case. Then as to authority, we have a passage from Mr. Justice Lindley’s book on Partnership<sup>21</sup> Vol. I, pp. 68, 69, where he says “cases may nevertheless arise in which justice may be done by allowing each co-owner (of a chattel) to make what he can and to keep what he may get. This may occur where the chattel is such that each co-owner can, in fact, enjoy his rights to the full extent without the concurrence of the other owner (*e.g.*, where the chattel is a patent for an invention). In the case of a patent belonging to several persons in common each co-owner can assign his share and sue for an infringement. That is very distinct, but there is a still stronger authority in the case of *Dent v. Turpin*.<sup>22</sup>

<sup>21</sup> 4th edn.

<sup>22</sup> 2 J. & H. 139.



There the Plaintiff and another person carried on distinct trades at different places of business, both having derived from a common predecessor the right to use the name of Dent as a trade-mark. The Defendant infringed the right of the Plaintiff, and it was held on demurrer that the Plaintiff, without averring special damage, might sue alone for an injunction, and for the delivery up of the articles to have the name erased; and it was further held that he might sue alone for an account of profits made by the Defendant out of the articles so marked, and for payment to the Plaintiff of such part of such profits as the Plaintiff should be entitled to. Therefore both on principle and authority I am justified in saying that the Plaintiff is entitled to sue alone. ....I wish it to be distinctly understood that my opinion is that one of several co-owners of a patent of this sort is entitled to sue by himself alone."

A similar principle that one of several co-owners can sue alone, has also been applied in certain circumstances as to copyright and as to a trade mark.<sup>23</sup> But it is of interest to note that in another English case<sup>24</sup> it was held that a grant of Patent to two or more persons, their executors, administrators and assigns creates a joint interest of the nature of a joint tenancy in the Patent and not an interest in common. On this point the following passage of the judgment of Cozens-Hardy J. in that case was as follows:—

"On the construction of this grant I think the two patentees took a joint interest, which passed by survivorship to Gibbs on the death of Gaulard. It was scarcely disputed that a grant, whether by the Crown or by a private individual, of any ordinary species of property to A. B. and C. D., their executors, administrators, and assigns, would create a joint tenancy or joint interest, and not an interest in common. This is not a rule of tenure or of real property

<sup>23</sup> See *Lauri v. Renad* (1892) 3. Ch. 402 (though as to this case see the comments in *Copinger on Copyright* (7th edn: 1936) at p. 191; and *Dent v. Turpin* 30. L. J. Ch. 495; and *Terrell* (ibid) at p. 370.

<sup>24</sup> *National Society for the Distribution of Electricity by Secondary Generators v. Gibbs*, (1899) 2 Ch. 289 at p. 299 (a case decided prior to the operation of Sec. 37 of the English Act of 1907) also see (1900) 2 Ch. 280, or 16. R. P. C. 339 and 17. R. P. C. 302.

law. It applies to an assignment of a policy of assurance as much as to an assignment of a term of years. But it was urged that letters patent are of such a peculiar quality and nature that different principles of interpretation ought to be applied. I am unable to follow this argument. The right or privilege granted by the Crown by the letters patent is an exception from the general prohibition contained in the Statute of Monopolies. It is for all purposes to be regarded as property. It passes on bankruptcy as part of the assets of a bankrupt. On the death of a patentee, duty is payable on it as part of the assets of the deceased, and I can see no justification in principle, nor has any authority been produced for holding that a grant of letters patent to two persons, their executors, administrators, and assigns, creates anything more than a joint interest which will survive on the death of one of them, unless there has been a severance of the joint interest. An elaborate argument was addressed to me with a view of persuading me that survivorship between joint tenants is unreasonable, and cannot have been intended by the Crown. It is no doubt true that courts of equity have laid hold of slight circumstances to turn a joint tenancy into a tenancy in common, and there was at one time an idea that in equity all joint tenancies would be construed as tenancies in common. This, however, is clearly not so. I may refer to the judgment of Sir William Grant in *Aveling v. Knipe*.<sup>25</sup> (1) It must not be forgotten that it is at any time open to two to terminate the joint interest and to create a tenancy in common. A patent can be owned by tenants in common: see *Smith v. London and North Western Ry. Co.*<sup>26</sup> and *Steer v. Rogers*.<sup>27</sup> It follows therefore that in my judgment Gaulard's representative is not a proper party to the action in so far as it seeks an order for the assignment of the patents, inasmuch as the whole interest in the patents is vested in Gibbs as the survivor of the two joint patentees".

Under Section 37 of the current English Patents & Designs Act it is expressly provided that "where a patent is granted to two or more persons jointly, they shall unless otherwise specified in the

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<sup>25</sup> (1815) 19 Ves 441. Cf. also *Walton v. Lavater* (1860) 29. L. J. C. P. 273 at p. 280.

<sup>26</sup> 2. E. & B. 69.

<sup>27</sup> (1893) A. C. 232.

patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence otherwise than with their consent or in accordance with directions given under this section, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate." (Then follow under sub-sections (2), (3), (4) & (5) of the same section various provisions for giving relief to a joint patentee in cases where his co-patentees refuse to co-operate with him). The section however does not expressly touch upon the question whether such a co-patentee can bring a suit for infringement alone or not.

The legal position of co-owners in British India when a Patent is granted to two or more persons jointly is similarly expressly referred to in Section 37 of the Indian Patents & Designs Act of 1911, the provisions of which are in the following terms :—

"37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his legal representatives."

It is to be noted that both in this Indian Section, equally as in the corresponding English section, it is only expressly provided that the joint tenancy is to exist "for the purpose of the devolution of the legal interest" in the patent. The section does not positively go further than that. On the other hand there is nothing in this section or elsewhere in the Act to negative such co-owners holding the Patent as joint tenants in other respects also apart from the devolution of the legal interest. Accordingly it is submitted that in the absence of any express provisions to the contrary the position will be that such co-patentees do hold as joint tenants ; and must be treated as such in regard to any question that arises concerning the

necessity of their being all joined as parties in a suit for the infringement of their patent.

If, then, the interest of the co-owners of a Patent is, as directly held in the judgment now cited, to be ordinarily the case, a joint interest, it follows, it is submitted, that in any suit for infringement of that Patent, all the co-owners of that patent must sue together.

At the same time it is to be noted that it has been also held as was confirmed in the same case, that in certain circumstances as when there has been a clear alteration of the position into that of a tenancy in common, a Patent may be held by co-owners as tenants in common.<sup>28</sup> If then in any given case the position could be clearly established that the co-owners held as tenants in common, it would follow, it is submitted that in such a case at least, a single co-owner could sue alone for infringement.

In view of the difficulty of being able to establish affirmatively that in a particular case the co-owners hold the patent as tenants in common and not as joint tenants and in view of the decision already referred to that an ordinary grant of a Patent will in the ordinary way create not an interest in common but a joint interest, it appears clear that in most cases the only safe course, at least, is for all the co-owners of a Patent to be joined as Plaintiffs in any suit for its infringement.

In India this proposition will apply with equal force. Where, as ordinarily, the co-owners of a Patent hold their interest as a joint interest it would appear to be just as necessary for reasons not of procedure but of substantive law that all the co-owners are parties to the suit as in a case regarding joint family property where it is necessary that all the members of the joint family are required to be joined.<sup>29</sup>

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<sup>28</sup> See page 657 above.

<sup>29</sup> See *Mulla's Civil Procedure Code* (10th edn. 1934) at p. 451. See also Section 106 of the Indian Succession Act of 1925; and A. C. Dutt's Indian Succession Act at page 236. Also see, for certain general remarks, the comments of the late Sir Dinshaw Mulla on Section 45 of the Indian Transfer of Property Act (Act IV of 1862) (the section itself refers only to immovable property). See also *Fletcher-Moulton* at p. 12 note (i), (where however, it is suggested that whether the co-owners are in the position of joint tenants or of tenants in common they ought in either case all to be joined).

Since it is not possible to join a person as co-plaintiff unless he consents, in the event of any of the co-owners of the Patent refusing to be joined as co-plaintiffs, then they should be joined as Defendants<sup>30</sup>, so that the primary object may still be attained of having before the Court in the suit all the co-owners and of putting the Court thus in a competent position to pass an effective decree in regard to the patent rights in suit, which it otherwise would be unable to do.

**As to who may sue after the death of one of several co-patentees—devolution by survivorship.**

From the terms of Section 37 of the Indian Patents & Designs Act of 1911 above cited, it seems that there will be a survivorship to the surviving co-patentees or co-patentee on the death of one co-patentee, since such survivorship is one of the essential elements of the joint tenancy mentioned in the section. On this footing it would seem that the surviving patentee or patentees would be entitled to sue alone without joining as co-plaintiffs the legal representatives of the deceased co-patentee.

On the other hand the further provisions of the section make it clear that the estate of the deceased co-patentee does not lose all rights in the Patent on his death, but that, on the contrary, his legal representatives will be entitled to the beneficial interest in the Patent. The result of this is, that the surviving patentee or patentees must be considered in law to hold the joint interest formerly owned by the deceased co-patentee in trust for his legal representatives. In these circumstances it is submitted that such legal representatives, though not necessary parties to a suit for infringement (in the sense that the suit would be bad for non-joinder without them) are nevertheless persons, who may be joined, if this be desired for any reason, as co-plaintiffs also.

## **2. Parties—who can be sued as Defendant.**

The question of the liability of a particular person for an infringement has already been considered in Chapter XV ; and need not here be further discussed.<sup>31</sup>

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<sup>30</sup> See *Maphabala v. Kunhanna* (1898) 21. Mad. 373.

<sup>31</sup> See page 570 to 582 above ; also Chapter XIV at page 541 (Nos. 15 to 23).

**As to joinder of Defendants—where there is more than one infringer.**

By Order 1, Rule 3 of the Civil Procedure Code it is provided as follows :—

“All persons may be joined as Defendants against whom any right to relief in respect of or arising out of the same act or transaction or series of acts or transactions is alleged to exist, whether jointly, severally or in the alternative, where if separate suits were brought against such persons any common question of law or fact would arise.”

The question arises, where a Plaintiff is owner of one patent in respect of which he claims that various persons have committed separate infringements, whether he may join them all or at least more than one of them in a single suit. Since he has to prove his patent and that he is the patentee thereof, it is clear that this is a “common question of law or fact” within the scope of the rule. But the other test laid down in the rule must also be fulfilled “that his right to relief in such case must arise” out of the same act or transaction or series of transactions. This being so it is submitted that it would probably be held that even though the infringements complained of by the Plaintiff were all in respect of one and the same patent yet the common factor that the patent was the same in each instance would not, of itself be enough to bring the different infringements within the rule so as to enable the Plaintiff to sue therefor in one and the same suit. The result is then that where entirely unconnected infringements of one and the same patent have been committed by different infringers, it is not open to the Plaintiff to join them as Defendants ; but if a case arises where the various complaints of the Plaintiff are based on things done, whether jointly or severally by different persons so as to comprise what is really the same act or transaction or series of transactions, such persons may be joined as Defendants in the same suit. Such a case may arise where the Plaintiff desires to sue both the importer and the selling agent or distributor of the importer ; it will be open to him to sue both in one suit.

It is to be noted that under Order 2, Rule 6 of the Code of Civil Procedure it appears that the Court has power, in spite of the

joinder, to order separate trials if it should consider this more convenient.<sup>32</sup>

### 3. Joinder of causes of action—where there is more than one infringement of the same patent.

By Order 3, Rule 1, of the Code of Civil Procedure it is provided as follows. :—

“Save as otherwise provided, a Plaintiff may unite in the same suit several causes of action against the same Defendant, or the same Defendants jointly.....”

It is clear therefore that where there is more than one infringement of the same patent by the same Defendant, the Plaintiff may sue in respect of all such infringements in one suit.

As to where there is more than one patent.

It not infrequently happens that a Plaintiff is the holder of several patents relating to one product; and that a single article complained of as an infringement may be claimed to be an infringement of more than one patent of the Plaintiff. In such a case where the proposed Defendant is one and the same person the Plaintiff may properly sue for the infringement of all or several of his patents in the same suit.

In certain of the cases mentioned in the note below as many as 23 different patents have been sued upon in the same suit. In such a case it may be that the Plaintiff will sue in the alternative for infringement of one or more of the patents, since it may be that in the circumstances of the case it will be found in the end that only some of his patents, though he may not at the time of the filing of the suit be in a position to know which, have been infringed.<sup>33</sup>

Where either there is more than one patent of the Plaintiff in respect of which he complains and infringement by different persons or if there is more than one unconnected infringement of the same

<sup>32</sup> For consideration of the joinder of different causes of action against the same defendant see further below.

<sup>33</sup> See for example a series of cases in which the *Saccharin Corpn. Ltd.* was the Plaintiff: reported in (1902) 19. R. P. C. 169 (C.A.) (1903) 20. R. P. C. 454 (C.A.); (1903) 20. R. P. C. 611; (1905) 22. R. P. C. 246. As to consolidation of separate suits see Part III of this chapter below.

patent by different persons it seems clear that the Plaintiff will be required to bring separate suits for his separate causes of action.

**As to Joinder of breach of patent rights with other causes of action.**

Cases in which it may be desired to join a cause of action for infringement or other breach of patent rights with some totally different cause of action independent of any question of patent rights seldom in practice arise. The wording of Order 3, Rule 1 (abovementioned) would however seem wide enough to allow of such joinder of such causes of action in one suit against the same Defendant : for example a cause of action for infringement of patent with a cause of action for passing off or with a cause of action for breach of some contract subsisting between the parties.

**As to the result of non-joinder or mis-joinder of Plaintiffs or Defendants.**

Prospective litigants or their advisers should not be misled into any careless optimism by the words of Order 1, Rule 9 of the Code of Civil Procedure : the wording of which is as follows :—

“No suit shall be defeated by reason of the mis-joinder or non-joinder of parties, and the Court may in every suit deal with the matter in controversy so far as regards the rights and interests of the parties actually before it.”

Though the actual wording of that rule at first sight appears wide enough to protect the litigant from losing his suit in the event of almost any mistake of mis-joinder or non-joinder, it must be borne in mind that this rule of the Civil Procedure Code is a mere rule of procedure and cannot and does not affect the substantive law. Thus where an omission to join a party goes to the substance of the suit so that a decree cannot be made without his presence as a party before the Court, this rule of procedure will avail nothing and the suit will be lost. The following illustrations of such cases may be noted.

**Non-joinder of Plaintiffs.**

A suit by executors, trustees, co-owners or partners (when in the individual names of such partners) for the recovery of property in which they are jointly interested, will not lie unless all



such persons are joined as co-plaintiffs. It is impossible, for reasons of substantive law, for the court to make any decree in regard to such property in question, whether it be a patent or patent rights or anything else, in their absence from the suit. Unless therefore the suit is amended before decree so as to join all such persons as parties, the suit is bound to be dismissed. On application being made, the Court will in ordinary cases of course allow the plaint to be amended and the parties to be joined as Plaintiffs: but if the Plaintiff in spite of objection raised persists in the suit without joining the other parties, the suit is bound to be dismissed. And it has been held that he will not be allowed to remedy the defect on appeal.<sup>34</sup>

### Non-joinder of Defendants.

Similarly in a suit against joint executors, all must be joined or the suit will be dismissed.<sup>35</sup>

### Mis-joinder of Plaintiffs.

Where more persons have been joined as Plaintiffs than are legally interested so as to be properly entitled to be so joined, the result may be that the suit may be dismissed as against such persons with costs. Such mis-joinder will seldom, if ever, result so as in any respect to affect the other Plaintiffs or to lose them the suit or any rights.

### Mis-joinder of Defendants.

Similar remarks apply. In practice the risk of joining more than what may turn out to be the proper persons as Defendants in a suit is of course the very serious risk that the Plaintiff may be ordered to pay all the costs of such persons who may be found to have been improperly joined. Though it is no doubt quite commonly, and very rightly, a good defence in a criminal case for one of several accused persons to object, on appeal, that he should not have been tried together with the other co-accused—it may be for reasons through which he was deprived of the benefit of certain evidence

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<sup>34</sup> See (1921) 44. Mad. 43 ; (1923) 44. Mad. L.J. 249 ; (1922) 42. Mad L.J. 133 ; (1933) 65 Mad. L. J. 290 ; *Naba Kumar v. Radhashyam* (1931) 35. C. W. N. 977.

<sup>35</sup> And compare as to waiver of objection. See *Kantichandra v. Radha Raman* (1930) 34. C. W. N. 275 ; see also (1932) 63. Mad. L. J. 369.

which might otherwise have been available to him—yet it is seldom, if ever, that a Defendant can obtain the dismissal of a civil suit or obtain any result affecting anything beyond the costs of the suit by taking a point of mis-joinder of Defendants.

### Waiver.

In regard to non-joinder and mis-joinder of parties Order 1, Rule 13 may also here be noted :—

“All objections on the ground of non-joinder of parties shall be taken at the earliest possible opportunity and in all cases where issues are settled, at or before such settlement, unless the ground of objection has subsequently arisen, and any such objection not so taken *shall be deemed to have been waived.*”

This rule it is true has often been relied on in cases where such an objection has been sought to be taken for the first time on appeal.<sup>34</sup>

But it is submitted that the same remarks as already made in regard to Order 1, Rule 9 will also be applicable in regard to this rule ; and that if in fact the position is such that according to the substantive law a decree cannot properly be made and such that no waiver by the mere parties of their objection could affect that position, then this rule also may not avail to prevent the suit being lost for non-joinder in such cases, even though the objection be taken on appeal and not before.

### As to the result of mis-joinder of causes of action.

Reference should be made to the following provisions of the Code of Civil Procedure :—

Order 2, Rule 1.

Order 2, Rule 2.

Order 2, Rule 3.

Order 2, Rule 5.

Section 99.

Order 2, Rule 6.

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<sup>34</sup> See (1882). 8. Cal. 277 ; (1891) 14. Mad. 498 ; (1902) 26. Bom. 301 ; (1891) 16. Bom. 119 at 122 ; *Adjai Coal Co. v. Punna Lal* (1930) 57. Cal. 1341 (P. C.).

If the Defendant objects to the frame of the suit on the ground of mis-joinder and makes an application, the Court may direct the Plaintiff to make the requisite amendment under Order 6, Rule 16. Then if the Plaintiff does not amend in the requisite manner, the Court may order the stay of the suit.

The Court also has power it seems in an extreme case, if necessary, under its inherent powers, to direct the Plaintiff to elect on which cause of action he will proceed. Such a case is seldom likely to arise unless there has been mis-joinder of Defendants as well as of causes of action where the question would be, principally, for the Plaintiff to elect against which defendant he wishes to proceed. The Court may stay the suit, presumably, if the Plaintiff refuses to exercise his election.

### **Waiver.**

There is a rule in regard to objections to causes of action almost precisely similar to that already mentioned in regard to objections to parties. It is Order 2, Rule 7 which reads as follows :—

“All objections on the ground of mis-joinder of causes of action shall be taken at the earliest possible opportunity and, in all cases where issues are settled at or before such settlement, unless the ground of objection has subsequently arisen, and any such objection not so taken shall be deemed to have been waived.”

It will be seldom, if ever, that mis-joinder of causes of action will interfere with the Court's capacity to pass a decree ; and there is little likelihood of any case arising where the provisions of the Code of Civil Procedure in regard to joinder of causes of action as apart from joinder of parties will come in any respect into conflict with any principles of substantive law. Any objections to mis-joinder of causes of action will be merely matters of procedure. Accordingly delay under Order 2, Rule 7 in making such an objection will clearly under the Rule be fatal to the objection.

There is no express rule in the Civil Procedure Code in regard to mis-joinder of causes of action similar to Order 1, Rule 9 in regard to mis-joinder or non-joinder of parties. The reason is presumably because it is inconceivable that any suit should be dismissed or lost

for mis-joinder of causes of action. The general provisions of Section 99 are however applicable.

The reason why it may be important for a Plaintiff to take thought not to file his suit without including claims for all the reliefs open to him is not because there is any risk of the suit which he does file being dismissed or prejudiced in regard to the claims made in the suit ; but because of the risk that he may be shut out at a later stage from making those claims which he has omitted to include in the original suit at a later stage in other proceedings. Reference may be made to Order 2, Rules 1 and 2. But it will be noticed that provided that the claims omitted from the suit are entirely separate causes of action from those included, there will be no risk of his being shut out from later pursuing them in a separate suit. It is only when he neglects to sue for all the reliefs to which he is entitled as may arise from the same cause of action as that forming the subject matter of his claim made in the suit, that he will be in any danger of being shut out from claiming such reliefs in another suit or proceeding. However, as it may in many cases be a moot point whether the other claims not included in the suit are in their nature different causes of action or whether they may properly be described as different reliefs dependent on the same cause of action, it will in most cases, where any claims are not desired to be included in the one suit, be advisable to include a prayer in the plaint for such leave of the Court as is contemplated under Order 2, Rule 2 (3) ; that is to say for leave to reserve the right to sue afterwards for such reliefs as have not been sued for in the suit which is being proceeded with.

**As to appeals.**

Before passing from the question of non-joinder and mis-joinder of parties and of causes of action it may be as well here to note the provisions of Section 99 of the Code of Civil Procedure in regard to appeals. This section is worded as follows :—

“99. No decree shall be reversed or substantially varied, nor shall any case be remanded, in appeal, on account of any mis-joinder of parties or causes of action or any error, defect or irregularity in any proceedings in the suit, not affecting the merits of the case or the jurisdiction of the Court.”

This gives statutory support to what would in any event be the natural tendency of any Court of Appeal—not to upset a decision of the lower court merely for an objection of mis-joinder or non-joinder unless the effect of the decision of the lower court affected matters more serious than mere questions of the relative convenience of different possible procedures for disposing of the case.

#### 4. Court in which the suit may be brought—jurisdiction—"District Court."

The wording of Section 29(1) by which the right to bring a suit for infringement is conferred to the effect that :—"a Patentee may institute a suit in a District Court having jurisdiction to try the suit".....

It should be noted that under Section 2(6) of the Act of 1911 the expression District Court has the meaning assigned to that expression by the Code of Civil Procedure 1908 (Act V of 1908). And that under Section 2(4) of the Code of Civil Procedure the term "district" means "the local limits of the jurisdiction of a principal civil court of original jurisdiction (thereinafter called a "District Court") and includes the local limits of the ordinary original civil jurisdiction of a High Court."

Therefore a suit for infringement can be brought in a High Court in any case where a High Court has jurisdiction under its ordinary original jurisdiction to entertain the suit.<sup>37</sup> It will be essential before filing the Plaint to consider the question of the extent and limits of the jurisdiction of the Court in which it is proposed to sue.

#### Jurisdiction of the High Courts.

In the case of the High Court of Calcutta its ordinary original civil jurisdiction, which is the jurisdiction under which any suit for the infringement of a Patent will be brought in that Court, is defined in Clause 12 of the Letters Patent for the High Court of Judicature at Fort William in Bengal dated 28th December 1865. Though this clause is one of the best known clauses of that well-known charter it may nevertheless be convenient to set it out here in full. It reads as follows :—

"12. And We do further ordain, that the said High Court of

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<sup>37</sup> See also *Kedernath Mondal v. Gonesh Chandra Adak* (1907) 12. C. W. N. 446 (under the old Act of 1888).

Judicature at Fort William in Bengal, in the exercise of its ordinary original civil jurisdiction, shall be empowered to receive, try, and determine suits of every description, if, in the case of suits for land or other immoveable property, such land or property shall be situated, or in all other cases if the cause of action shall have arisen, either wholly, or, in case the leave of the Court shall have been first obtained, in part, within the local limits of the ordinary original jurisdiction of the said High Court, or if the Defendant at the time of the commencement of the suit shall dwell, or carry on business, or personally work for gain within such limits; except that the said High Court shall not have such original jurisdiction in cases falling within the jurisdiction of the Small Cause Court at Calcutta, in which the debt or damage, or value of the property sued for, does not exceed One hundred rupees."

The precise effect of the terms of this clause and the precise meaning of the wording thereof has been the subject of much argument from time to time. It is convenient therefore to note what is now the generally accepted reading of the clause. The class of cases triable may be paraphrased thus :—

**A. Suits for land or other immovable property :—**

1. If.....such land or property shall be situated.....  
wholly.....within the local limits of the ordinary  
original jurisdiction of the said High Court.

*Or,* 2. If.....such land or property shall be situated.....  
in case the leave of the Court shall have been first  
obtained in part within such limits.

**B. All other cases (that is to say including suits for the infringement of a Patent) :—**

1. If the cause of action shall have arisen.....wholly.....  
within the local limits of the ordinary original jurisdiction  
of the said Court.

*Or,* 2. If the cause of action shall have arisen.....in case the  
leave of the Court shall have been first obtained, in part,  
within such limits.

*Or,* 3. If the Defendant at the time of the commencement of the  
suit shall dwell.....within such limits.

Or, 4. If the Defendant at the time of the commencement of the suit shall.....carry on business or personally work for gain within such limits.<sup>38</sup>

For authority that the Defendant's residence within the jurisdiction is enough, without more, to found jurisdiction, see *Srinivasa Moorthy v. Venkata Varada Ayyangar*.<sup>39</sup>

As for the exception in regard to cases falling within the jurisdiction of the Small Cause Court at Calcutta in which the debt or damage or value of the property sued for does not exceed one hundred rupees, there is no need to trouble for present purposes with this exception, since the Calcutta Small Cause Court has no jurisdiction to try infringement suits; it being expressly provided by Section 19(n) of the Presidency Small Cause Court Act (Act XV of 1882) that the Small Cause Court shall have no jurisdiction in "suits for compensation for the infringement of a patent....." and by Section 19(i) that the Small Cause Court shall have no jurisdiction in "suits to obtain an injunction."

The corresponding ordinary original civil jurisdiction of the High Court of Bombay is defined by a precisely similarly worded clause being Clause 12 of the Letters Patent granted to the High Court of Bombay.

So also is the corresponding ordinary original civil jurisdiction of the High Court of Madras: by clause 12 of the Letters Patent granted to the High Court of Madras.

No other High Courts in British India except only those of Calcutta, Bombay and Madras, have any ordinary original civil jurisdiction. Accordingly a suit for infringement of a Patent cannot be originally instituted in any High Court except in Calcutta or Bombay or Madras.

It is possible however, when a suit for the infringement of a Patent has been instituted in a District Court, if it is desired that the suit should be heard in the High Court under whose supervision

<sup>38</sup> For an authority for reading the words "In case leave of the Court shall have been first obtained, in part" as governing suits for land as well as non-land suits, see *Balaram Bhaskarji & Another v. Ramchandra Bhaskarji & Others* (1898) 22. Bom. 922 at p. 925, *Bachoo v. Nagindas* (1914) 16. Bom. L. R. 263 at p. 269 and 40 Bom. 270, *Govindlal Bansilal v. Bansilal Motilal & Others* (1922) 46 Bom. 249; but see also *Hatimbhai v. Framrox* (1927) 51. Bom. 516.

<sup>39</sup> (1905) 29. Mad. 239 and (1911) 15 C. W. N. 741 (P. C.)

that District Court is situated, to have the suit transferred for hearing to a Bench of that High Court instead of its being heard in the District Court. It may be that unusually complicated issues arise in the suit, involving abstruse scientific questions of mechanical or electrical engineering or of chemical research and entailing the attendance from a distance of specialists and experts to give evidence or it may be that the case raises various questions of law of unusual occurrence. For one reason or another it may be found desirable in the particular instance for the case to be disposed of by a High Court.

This course was recently adopted by consent of the parties in the suit of *Ghanshayam Das Jagnani v. Ramnarayan Ganeshnarayan*<sup>40</sup> which was originally instituted in the Court of the District Judge of Patna but was taken up as an original suit under Clause 9 of the Letters Patent of the Patna High Court and heard by a Bench consisting of the Chief Justice the Hon'ble Sir Courtney Terrell and the Hon'ble Mr. Justice Jwala Prosad in the High Court at Patna.

**Leave to sue : under the Letters Patent (i.e. under Clause 12, of the Letters Patent for the Calcutta, Bombay & Madras High Courts respectively).**

With regard to the institution of a suit for the infringement of a Patent originally in any one of the High Courts of Calcutta, Bombay or Madras, this may be done, as already indicated in any case where the Defendant at the time of the institution of the suit resides (dwells) within the jurisdiction of that Court : or in any case where the Defendant carries on business within that jurisdiction : or in any case where the whole of the cause of action has arisen within that jurisdiction. In addition to this a suit for the infringement of a Patent may be instituted in any one of those three High Courts if a part of the cause of action has arisen within the jurisdiction of the Court in question, provided the leave of the Court shall have been obtained to file the Plaint in the Court in question.

In cases where the Defendant does not reside or carry on business within the local limits and where it cannot be safely said that the whole cause of action has arisen within the local limits, it is therefore advisable that the Plaint should be filed with the leave of

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<sup>40</sup> Unreported case being Title Suit No. 1 of 1931 in the High Court of Patna ; though reported on appeal to the Privy Council in (1936) 53. R. P. C. 160.



the Court obtained under Clause 12 of the Letters Patent which has been given above.

Questions will often arise whether particular events which may have taken place within the jurisdiction can be held to be "a part of the cause of action" so as to afford grounds for obtaining leave under the clause (already referred to) of the Letters Patent of the particular High Court in question.

In regard to the Calcutta High Court, the position, it is submitted, is this :—

The Patent Office for British India being situated in Calcutta within the local limits, it would seem that in every case of infringement, unless in a very exceptional case, some part of the Plaintiff's cause of action will inevitably arise within the local limits of the Calcutta High Court. As the Plaintiff in order to establish his right to sue has to show that he is the "Patentee"—and to do this has to show that he is the registered proprietor of the Patent sued upon—registered, that is to say, on the Register of Patents kept at the Patent Office in Calcutta—it would seem that he cannot succeed without establishing the fact of such registration. It is submitted then that this fact, the registration, is "a part of his cause of action" within the meaning of the Clause of the Letters Patent. If this is so, then as in every suit for the infringement of a Patent such registration must inevitably have taken place within the jurisdiction of the Calcutta High Court, it follows, it is submitted, provided leave under Clause 12 of the Letters Patent is obtained, the Plaintiff will in every such case, be able to bring his suit in the Calcutta High Court if he so desires.

In regard to the other two High Courts of Bombay or Madras also, if any part of the cause of action has arisen in either of those Courts, the Plaintiff will in every such case, with leave, be able to bring his suit in either of those Courts if he so desires.

#### **Assignment within the jurisdiction.**

On the same principles as those on which it has been held that the mere assignment alone of a debt or the endorsement alone of a negotiable instrument is a part of a Plaintiff's cause of action sufficient to be the basis of a grant of leave to sue under the clause referred to of the Letters Patent, it is submitted that the assignment alone within the jurisdiction of a Letters Patent constitutes a part of

the cause of action affording grounds to the Plaintiff to ask for, and power to the Court to grant, leave to sue ; so that there will be good jurisdiction if a suit is instituted with leave in one of the three High Courts mentioned, in a case where the assignment only of a Patent and no more takes place within the jurisdiction in question.<sup>41</sup>

**Formal grant of leave in the first place not final : but may in certain circumstances be revoked.**

In several recent cases in the Calcutta High Court where leave under Clause 12 of the Letters Patent of that Court has been granted by a judge at the time the Plaint has been filed, the grant of such leave has subsequently been revoked when the Defendant has appeared and made an application for its revocation.

The point must be borne in mind therefore by a Plaintiff and his advisers that the formal leave to sue which may be obtained in the first instance as a matter of course, may not necessarily be final and conclusive ; and that there may be a risk, in a case where the part of the cause of action relied on as arising within the jurisdiction is very small and where there may be reasons of inconvenience or hardship against the Plaintiff's choice of forum, that the jurisdiction of that Court may still at a later stage be denied to him.

It is true that the consequent period of uncertainty between the date of filing the Plaint and the date of any application for the revocation of the leave may entail a loss of time and money to the Plaintiff, which he would have been saved if no formal leave had ever been granted to him by the Court, but under the present system as pointed out by Panckridge J. in the recent case of *Kalooram Agarwalla v. Jonistha Lal Chuckroberty & Anr.*<sup>42</sup> it appears to be impossible to avoid this. In that case the learned judge said :—

“Various arguments have been advanced by the learned Standing Counsel on behalf of the Plaintiff. He points out that under the Civil Procedure Code a suit can be instituted in any Court within whose jurisdiction any part of the cause of action arose, and

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<sup>41</sup> See *Harnathrai Binjraj v. Churamoni Shah and Ors* (1933) 37. C. W. N. 1139 (as to leave after assignment within the jurisdiction of a debt) ; but see the further comments and cases cited below.

<sup>42</sup> (1936) 40. C. W. N. 161 at p. 162.

that there is no question of the granting or refusal of leave. This is true, but I do not think that the fact that in a Mofussil Court there is no way of preventing unnecessary hardship in a case like this is a reason for allowing the discretionary jurisdiction of this Court to be used to inflict a similar hardship.

Next it is said that the leave having in fact been granted it must be assumed that the learned judge granting it has exercised his discretion, and that I cannot or ought not to interfere with such exercise.

With regard to this the difficulty is that my mind refuses to make an assumption which I know is contrary to facts. I believe, that the practice of all Judges dealing with interlocutory matters on the Original Side is the same. The Master examines the plaint and if there is an allegation in it showing that a part of the cause of action arises within the jurisdiction, the Master endorses the plaint "Leave granted under Clause 12" and submits it to the Judge for his signature. The Judge then signs the plaint as a matter of course and leaves it to the Defendant to take such steps as he may be advised. This system may not be wholly satisfactory, but it is not easy to think of a better one, because at that stage whatever is done must in the nature of things be done *ex parte*. I therefore feel no difficulty in reviewing (I use the term in its popular sense) the decision, if it can be called a decision of Remfry J., in signing the endorsement of the Master and granting leave."

The result is that the formal leave which is granted by a Judge at the time of filing the Plaint on the *ex parte* application of the Plaintiff, should be regarded in truth as having the limited effect of a provisional grant only : subject to revocation thereafter in certain circumstances on application by the Defendant.

Cases where formal leave has been provisionally granted in the first place but where it is afterwards shown that no part at all of the cause of action arose within the jurisdiction.

The foregoing remarks apply only to cases in which it is possible to show that some part, however small, of the cause of action arose within the jurisdiction. In other cases where it is shown that in fact no part of the cause of action arose within the jurisdiction, the position is different. In these cases the position is that the Court

never had jurisdiction to entertain the suit even with leave. It is not then so much a question whether there should or should not be revocation of the leave granted, since this question is immaterial, but a question simply of showing that the Court has not and cannot give itself jurisdiction. In these cases therefore it will be immaterial for purposes of jurisdiction whether the Defendant has applied to have the Plaint taken off the file or the leave revoked at the earliest possible moment or not : that is to say immaterial whether the Defendant has made any interlocutory application in the matter by way of objection to the jurisdiction or whether he has simply waited until the hearing of the suit to make his objection. For in any event in these cases the Court will at no point of time have the requisite jurisdiction to entertain the suit : and any order or decree purported to be made by it for reliefs in the suit will be a nullity.

**Fresh leave may be necessary on amendment.**

Since the leave under Clause 12 is the very foundation of the jurisdiction of the Court to entertain the suit, such leave must be obtained before filing the Plaint. If further parties or further causes of action necessitating leave are added, fresh leave is absolutely necessary.<sup>43</sup>

**As to the principles and grounds on which in practice leave to sue may be refused ; or, when previously granted, revoked.**

In the very great majority of cases once leave to sue has been granted, even though *ex parte*, the Court does not afterwards revoke the grant of such leave. There has been some difference of opinion in the recently decided cases of the Calcutta High Court as to the principles or grounds on which such leave should be refused to be granted or if granted revoked. The cases have mostly arisen in circumstances, where the Plaintiff has relied, for the part of his cause of action giving jurisdiction, on an assignment of a negotiable instrument within the jurisdiction, and no other part of the cause of action has arisen within the jurisdiction.

In *Harnathrai Binjraj v. Churamoni Shah & Ors.*<sup>44</sup> Ameer Ali J. held :—

“The argument in support of the application may be summarised as follows. That under Clause 12 of the Letters Patent the Court

<sup>43</sup> See Mulla's Civil Procedure Code (10th edition) p. 1343.

<sup>44</sup> (1933) 37. C. W. N. 1130 at p. 1140.

has discretion to grant or refuse leave in a case where part of the cause of action arises in Calcutta, and reference is made to the case of *Seshagiri Row v. Oskur Jung*.<sup>45</sup> In that case, although it was not necessary for the decision of the Madras High Court, since it did not appear that any part of the cause of action had arisen in Madras, it was held that the question of convenience and prejudice was a matter which could and ought to be considered in granting or refusing leave.

As regards the facts, it is suggested (and not without some reason) that this assignment was made not only in anticipation of the insolvency of the assignor firm which was imminent and has, I understand, supervened, but for the purposes of creating jurisdiction in Calcutta so as to put pressure on the Defendant firm by compelling the latter to contest the suit in Calcutta where they have no business house or connection. The latter point seems to me the more relevant to the application.

The first aspect of the matter is purely a matter, in my opinion, which must be gone into in the suit, and it is not possible for me in granting or refusing leave to investigate matters which must be and can only be investigated on evidence, although there may be grounds of suspicion.

The second aspect of the matter is one which appeals to me far more, especially having regard to the fact that I have either at the Bar or on the Bench, come across cases where assignments have been made away from the scene of action in order to (obtain) an advantage over the matter.

It has always been assumed, however, that in a suit by an assignee the assignment is a part of the cause of action, and upon that cause of action leave, as far as I know, has invariably been granted. For practical purposes it is impossible before the hearing of the suit to decide whether an assignment is or is not bona fide. I do not think that the Court would be justified, on a mere suspicion that the assignor might not have acted in the ordinary way of business, in depriving the Plaintiff of the right to bring a suit in the place where the assignment was made, which right has always been recognised by this Court.

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<sup>45</sup> (1907) 30. Mad. 438.

It might have been more satisfactory if the rule were otherwise, i.e., that an assignee in taking an assignment of a debt should take such assignment with only such right of suing as the assignor had, and could sue where the assignor could sue and nowhere else. I do see difficulties in the present system under which an assignor can create jurisdiction in any place where the Civil Procedure Code applies, but I do not think it would be right for me to attempt to change it."

On the other hand in *Kalooram Agarwalla v. Jonistha Lal Chuckroberty & Anr.*<sup>46</sup> Panckridge J. revoked the leave to sue which had been granted stating his view of the matter as follows :—

"In my opinion, on the facts as set out in the plaint, leave ought not to have been granted. The sum at stake is not a large one, nor prima facie is there likely to be raised any issue which the tribunal within whose local jurisdiction the Defendants reside is not competent to try satisfactorily. The assignment was admittedly executed on the last day before the expiry of the period of limitation and one cannot help feeling a suspicion that it was collusive in the sense that it was executed mainly for the purpose of giving this Court jurisdiction which it would not otherwise possess. The Defendants are described in the plaint as landholders residing in the District of Manbhum, and in my opinion it is no hardship on a person who sees fit voluntarily to take such an assignment as the present to be compelled to institute any proceedings which may be necessary to realise his debt in the Courts, which would have jurisdiction, apart from the assignment. On the merits I think that the case is not one on which leave should have been granted."

It was on these grounds that in that case the learned judge made an order for revocation of the leave.

Then in *Daulatram Rawatmull v. Maharajlal & Ors.*<sup>47</sup> Panckridge J. made the following observations bearing on the question of the grounds on which leave should be refused or, if granted, revoked :

"I should not feel justified on the materials before me in holding as I did in the former case, that the assignment is prima facie collusive, in the sense that the circumstances indicate that it was effected in Calcutta largely for the purpose of giving juris-

<sup>46</sup> 1936 40. C. W. N. 161 at p. 162.

<sup>47</sup> 1936 40. C. W. N. 164 at p. 165.

diction to this Court and thereby embarrassing the defence. At the same time, I am of opinion that usually it is not right to grant leave in a case where the part of the cause of action on which the jurisdiction depends is a matter with which the Defendants have had nothing to do. I do not lay this down, by any means, as a hard and fast rule, but generally speaking, it appears to me that when people take an assignment of a promissory note they should be prepared to enforce their claim either in the Court within whose jurisdiction the makers reside or in a jurisdiction where a part of the cause of action with which the makers are directly concerned has arisen.

The branch of the argument advanced by Mr. Bose which has attracted me most is his submission that if people choose to execute a negotiable instrument, they must be held to contemplate the possibility of its passing from hand to hand by endorsement and delivery and of its eventually getting, in the ordinary course of affairs, into the hands of some one who may elect to institute proceedings in a Court which does not suit the convenience of the makers of the note. Were the Defendants in this case a mercantile firm, I am not sure that this argument would not have turned the scale in favour of the Plaintiffs, but they are described as land-owners and it appears from the plaint that the consideration for the note took the form of advances of cash and the supply of goods for personal consumption. In these circumstances the argument as to negotiability does not apply with the same force as it would in the case of parties engaged in mercantile transactions... ..”

In *Harnathrai Binraj v. Sew Prosad Sing and others* and in *Mahadeo Lal Nathmull v. Rani Sonabati Kumari*<sup>48</sup> Panckridge J taking into account the fact that there would be no hardship to the Defendant if the case proceeded in the Calcutta High Court refused to revoke the leave.

In *Rai Radhika Mohan Roy Bahadur v. Bhobani Prosanna Lahiri & Others*.<sup>49</sup> Cunliffe J. in an observation during argument observed :—“I am beginning to think that when a holder for value brings a suit the entire cause of action is the assignment and as such no leave of the Court is necessary.” In the course of his judgment in that case the learned judge observed :—

<sup>48</sup> (1936) 40. C. W. N. 165 at p. 166. and (1936) 40. C. W. N. 719 (note).

<sup>49</sup> (1936) 40. C. W. N. 717.

"It is for me now to make up my mind as to whether the facts in this case are in the same category as those with which my learned brother was dealing, and to decide also whether I can agree with his view of the law with regard to the principle involved.

I am not at all convinced that on the facts before me, scanty as they are, this assignment, admittedly for value, was brought about simply for the purpose of embarrassing the Defendants and for the purpose of bringing the case within the jurisdiction of the Original Side of this High Court, although, no doubt, the question of convenience was considered by the persons who eventually decided upon buying and parting with the note. Nor am I satisfied that there was hardship upon the Defendants, more especially because the note was executed quite close to Calcutta, as I have already pointed out, and therefore there would not be this question of difficulty of bringing witnesses up to give evidence here if they wished so to do as there appears to have been in the case before my learned brother. Holding this view therefore on the facts, it seems necessary for me to say very little about the view of the law expressed by my learned brother. I can only say this that I have the misfortune to differ from what appears to have been the general trend of his observations with regard to his treatment of the holders or assignees of negotiable instruments who are suing in this Court under the jurisdiction dealt with in Clause 12. It seems to me that if you are going to discriminate between Plaintiffs and Defendants who are interested in negotiable instruments on the grounds of hardship or humanity, or even on the ground of legitimate collusion to assign, you are striking at the whole root of the law of negotiability as laid down not only in the Negotiable Instruments Act but in the time-honoured principles of the Law Merchant.

I am not satisfied in my own mind that because a person happens to be a private individual and the holder of, let us say, a simple bill of exchange, he should be treated on a different footing in law to a commercial man through whose hands instruments of negotiability are daily passing."

The learned Judge accordingly refused to accede to the application of the Defendant for revocation of the leave to sue.

There would appear therefore to be some doubt whether what is referred to by Cunliffe J. as "legitimate collusion" in relation to the



making of an assignment in the case of a negotiable instrument, will be held to afford a good ground for revocation of leave or not. It would seem however to result from these cases that in the case of a Patent, since this is not a negotiable instrument, if the only part of the cause of action relied on as having taken place within the jurisdiction is the assignment of the Patent and if it were to be shown that the assignment had been made simply to create jurisdiction, there would be some risk, at least, of the leave to sue if granted being revoked on objection being taken by the Defendant.

All that can definitely be said is that the confirmation or revocation of leave in such cases is a matter in the discretion of the Judge in each individual case.

The advisability must also be borne in mind by the Defendant and his advisers, should they desire to question the propriety of the grant of the leave to sue in the particular High Court chosen by the Plaintiff, of making any application for revocation of the leave at the earliest possible moment. For if this is not done, it is more than likely that on account of the delay alone, the Court will reject any application by the Defendant to have the grant of leave revoked. The following observations made recently in the Calcutta High Court in different cases may be referred to. In *Kalooram Agarwalla v. Jonistha Lal Chukroberty and Anr*<sup>50</sup> *Panckridge J.* said on this point (after considering the two previous cases of *the Secretary of State for India in Council v. Golabrai Paliram*<sup>51</sup> and *Harnathrai Binjraj v. Churomoni Shah*<sup>52</sup> :—

"I do not think that either of these cases can be taken as an authority for the proposition that the proper course for the Defendant to take in a case where he maintains that the discretion of the Court has been wrongly exercised is to abstain from making any application to remove the suit from the file and wait until the hearing to make his submissions. On the contrary, I think in many cases the Defendant should bring this aspect of the matter to the notice of the Court at the first possible moment, and that his failure to do so, if it in any way prejudices the position of the Plaintiff, is a matter which may prevent success of his application."

<sup>50</sup> (1936) 40. C. W. N. 161 at p. 163.

<sup>51</sup> (1931) 59. Cal. 150 or 35, C. W. N. 930.

<sup>52</sup> (1933) 37. C. W. N. 1139.

And in *Harnathrai Binraj v. Sew Prosad Singh*<sup>53</sup> Panckridge J. also observed :—"This is a border line case.....If the suit had not reached the stage which it has in fact reached I should probably have considered that the circumstances justified me in revoking the leave.....In this case on the other hand not only has there been discovery but the suit has appeared in the Prospective List and also in the Warning List on several occasions. It appeared on the Warning List on the 18th July 1935, and on the 22nd August 1935 and on those occasions it was adjourned by consent, the adjournment on the last occasion being over the long vacation. It is said that the Defendants consented to the adjournment to accomodate the Plaintiffs and that it is, therefore, inequitable, that they should be in a worse position because they have treated their opponents with courtesy. I think there is something in that argument but at the same time where the Defendant feels aggrieved at the manner in which the Court has exercised the discretion which it admittedly has, I think that he should apply at the earliest moment and not allow what is prima facie a perfectly bonafide suit to proceed through the normal stages of litigation up to the stage of being ready for hearing and appearing in the Warning List before he makes his application. In these circumstances I refuse the application with costs." Cunliffe J. also in *Rai Radhika Mohan Roy Br. v. Bhobani Prosana Lahiri & Ors.* in which case several preliminary steps had been taken in the form of the issue of a commission for the examination of a witness and applications for adjournments before the application by the Defendant for revocation of leave to sue was made, refused to revoke the leave granted.<sup>54</sup>

### Practice.

The present practice of the Calcutta High Court for the obtaining of such leave is that such leave is asked for from the Master at the time of presentation of the Plaint for filing. The Master either grants or refuses the leave subject to the papers being signed by the Judge who is taking interlocutory matters. Thereafter, probably on the same or the next day, the Plaint with an endorsement of leave having been granted is put before the judge by the Master for signature : no one on behalf of the Plaintiff being required to make any

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<sup>53</sup> (1936) 40. C. W. N. 165.

<sup>54</sup> (1936) 40. C. W. N. 717.

personal application to the Judge either in Chambers or otherwise. The necessary leave is then granted by the Judge signing the endorsement on the Plaint to the effect that it has been granted.

Should the Master indicate his refusal to grant the leave, then an application may, if desired, be made to the Judge in Chambers praying for the leave to be granted : this being done as an *ex parte* Chamber application.

**As to appeal :—**

If the Plaintiff applies to the Judge for leave under Clause 12 and such leave is refused, he may appeal from such refusal as being a judgment within Clause 15 of the Letters Patent which expressly gives a right of appeal in every case from a "judgement" of a single judge of the High Court.

It is only by way of appeal from the order that the order of one judge refusing leave under clause 12 can be superseded.<sup>55</sup>

If leave is granted, no appeal will be open to the Defendant from the order granting it, since such order does not constitute a "judgment" under clause 15 of the Charter and is not otherwise appealable.<sup>56</sup> The Defendant has however other remedies which may now be considered.

**Defendant's remedies where leave wrongly granted.**

The Defendant may apply to have the *ex parte* order granting the Plaintiff leave set aside ; making a separate application for this purpose. But if questions of difficulty are involved he may in some cases wait until the hearing and raise an issue at the hearing of the suit ; for the questions involved may be dependent on the evidence in the suit and on the decision of matters to be decided in the suit ; and may not be able to be properly dealt with on an application to revoke leave which will have to be decided merely on affidavit.<sup>57</sup>

<sup>55</sup> See *De Souza and Anr. v. Coles*. (1887) 3, M.H.C. 384.

<sup>56</sup> As to the principles sought to have been laid down as to what does not constitute a "judgment" within Clause 15 of the Letters Patent so that an appeal will lie from it see *Mulla's Civil Procedure Code* (10th Edn.) p. 1349 ; *Rules of Calcutta High Court* (3rd Edn) p. 94 to 97.

<sup>57</sup> See *Secretary of State v. Golabrai Paliram* (1932) 50. Cal. 150 ; *Kessowji Domodar Jairam v. Luckmidas Ladha and Anr.* (1889) 13. Bom. 404 ; *Nagamoni Mudaliar v. Janakiram Mudaliar* (1895) 18. Mad. 142 ; *Mahomed Haji Hayyed v. Jute and Gunny Brokers Ltd.* (1931) 33. Bom. L. R. 1364.

## Appeal.

If the Defendant adopts the former course and the decision of his application to have the order granting leave set aside is adverse to him, he may appeal from that decision.<sup>58</sup>

## Waiver

It has been held that where the Plaintiff seeks to base the jurisdiction of the Court on the ground that the whole cause of action has arisen within the jurisdiction, if it is thereafter found that in fact his whole cause of action did not so arise, then it is immaterial whether the Defendant has taken any step in the suit or done anything which might be called a waiver of his objection for want of jurisdiction; the ground of the decision being that the defendant cannot be bound by the doctrine of estoppel and presumably that no act of the parties such as waiver can confer on the Court a jurisdiction which it has not got. This was the effect of the decision in *Shama Kanto Chatterjee v. Kusum*.<sup>59</sup> This decision is completely understandable: in fact it is difficult to imagine a Court arriving at any different decision.

In cases when the Plaintiff bases the jurisdiction of the Court on the ground of part of his cause of action having arisen within the jurisdiction completed with his having obtained leave under Clause 12, there have however been conflicting decisions.

For present purposes it is enough to note that the Calcutta High Court takes one view: viz. that the defendant may be held to have waived his objection to the want of jurisdiction so that the result is that the Court may proceed with the hearing of the suit: while the Bombay High Court takes the diametrically opposite view: viz. that in such a case no waiver by the Defendant can confer jurisdiction on the Court.<sup>60</sup>

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<sup>58</sup> See *Vaghaji Kuverji v. Comaji Bomanji* (1905) 29. Bom. 249; *Hadjee Ismail Hadjee Hubbeeb v. Hadjee Mahomed Hadjee Joosub*. (1874). 13. Beng L. R. 91.

<sup>59</sup> (1917) 44. Cal. 10.

<sup>60</sup> For the various conflicting decisions on the point reference may be made to *Mulla's Civil Procedure Code* (10th Edn.) pp. 1245 and 125.

### **Importance of the Local limits of the respective High Courts of Calcutta, Madras and Bombay.**

In regard to suits for infringement of Patent sought to be instituted in one or other of the three High Courts of Calcutta, Madras or Bombay in the first instance in the original jurisdiction of that Court, such jurisdiction can only be invoked as already indicated, in circumstances when some material factor (whether the factor relied on be the dwelling or the carrying on business of the Defendant, or the whole cause of action, or some part of the cause of action) has existed or occurred within the local limits of the particular High Court in which the suit is sought to be instituted. It is of interest therefore to note what are the local limits of the ordinary original civil jurisdiction of each of those High Courts respectively.

#### **Local limits of the Calcutta High Court.**

The local limits of the ordinary original civil jurisdiction of the Calcutta High Court today stand as they were declared and prescribed in the Calcutta High Court (Jurisdiction Limits) Act being Act XV of 1919 passed by the Indian Legislature. The act itself, which is short, and the Schedule thereto in which the boundaries are prescribed in detail are set out for convenience of reference in Appendix No. 5 of the present work. The boundaries there mentioned may be perused and noted as necessary when considering whether the Calcutta High Court has jurisdiction in any given case.

For the earlier history of previous boundaries and for the alterations in the boundaries which were previously made before the present boundaries were prescribed by the Act of 1919, reference may be made to the rules of the Calcutta High Court (3rd edition 1930) at Appendix U from page 631.<sup>61</sup>

It may be noted that under Clause 11 of the Charter for the Calcutta High Court of 1865 it was also provided as follows :—

“11. And we do hereby ordain, that the said High Court of Judicature at Fort William in Bengal shall have and

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<sup>61</sup> See also Calcutta High Court Rules (3rd Edition 1930) p. 86 & 87.

exercise ordinary original civil jurisdiction within such local limits as may from time to time be declared and prescribed by any law made by competent legislative authority for India, and until some local limits shall be so declared and prescribed, within the limits declared and prescribed by the proclamation fixing the limits of Calcutta issued by the Governor-General in Council on the Tenth day of September in the year of Our Lord One thousand seven hundred and ninetyfour, and the ordinary original civil jurisdiction of the said High Court shall not extend beyond the limits for the time being declared and prescribed as the local limits of such jurisdiction."

It is thus clear that the Indian Legislature has ample power to extend the local limits of the ordinary original civil jurisdiction of the High Court of Calcutta.<sup>62</sup>

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" The position today is highly anomalous. The question whether a litigant has the right to file his suit in the Calcutta High Court or whether he is compelled to resort to the protection of other Courts in the mofussil with totally different mofussil procedure, as at Alipore or elsewhere, may depend on such illogical absurdities as whether the Defendant lives on one side of Lower Circular Road or the other. It will be found that Lansdowne Road, Lower Rawdon Street, Elgin Road, Lee Road and such places are all in the mofussil. So is the French Motor Car Co.'s office. The petrol station on one side of the road is in the town of Calcutta, while that on the other is in the mofussil. The Bishop's College is in the mofussil, while the Martiniere School is in Calcutta. It will be found that Entally is mostly, though perhaps not all, outside Calcutta. Also the whole of the new area adjoining the Lakes, though created and administered by the Calcutta Improvement Trust, is similarly outside Calcutta. It is to be conceded that a boundary line must be placed somewhere and that at one point or another will fall the division: but it is submitted that under present conditions and in view of the great expansion of Calcutta within recent years, to place the so-called limits of the town of Calcutta where they are now placed is absurd.

The inconveniences of the present demarcation are considerable and will become greater as the shifting of important houses and buildings in Calcutta from the Northern quarter southwards increases. Some of the very real differences which affect any prospective Plaintiff are these: if he has to file his suit in the Alipore Courts he will be compelled to pay a very large ad valorem duty on filing his suit. He may by circumstances be compelled to file a suit in order to protect his rights but unless the opponent is a man of means he will be inevitably out of pocket to the extent of the whole of the large initial expenses of filing the suit; and this will be so whether the suit is ever heard or

### Local limits of the Madras High Court.

The local limits of the ordinary original civil jurisdiction of the Madras High Court are those prescribed in the Madras High Court (Jurisdictional Limits) Act, being Act IV of 1927 passed by the Madras Legislature. The Act and the Schedule thereto in which the boundaries are prescribed in detail are set out for convenience of reference in Appendix No 5.

The boundaries there mentioned may be perused and noted as necessary when considering whether the Madras High Court has jurisdiction in any given case.

### Local limits of the Bombay High Court.

In regard to the local limits of the Bombay High Court, it appears that no limits have been fixed by any Act. In practice, owing to Bombay being an island, it would seem that the need for the fixation of the limits is not so insistent as in the cases of Calcutta and Madras. The Bombay High Court has however by a Rule of that High Court prescribed the extent of the limits of the area over which the Sheriff of Bombay is to execute process. That is by Rule 391 of Chapter XXV, Part II of the Rules and Forms of the Bombay High Court, Original Side, 1936, which is to the following effect :—

“The Sheriff shall ordinarily execute the process of the High Court in the Island of Bombay, Cross alias Gibbet and Butcher’s Islands and the coasts and harbours thereof, respectively, and shall not be compellable to execute process beyond the said limits.”

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not. In the High Court he need pay no ad valorem duty on filing the suit, but fees are incurred chiefly if and when the suit is heard and in proportion to the time taken in its hearing. Thus if the suit is not contested or is settled, the expense will not be great. Besides this the Plaintiff will be unable to have the advantage in the mofussil court of the procedure available in the High Court for suits marked as Commercial Causes : and the consequent delay, and probably the final expense, after many adjournments, may be a very big disadvantage. It is submitted that a short bill on lines similar to the Act of 1919 but prescribing different boundaries is required to be introduced and passed at the earliest opportunity effecting the necessary extension. And that the fact that Government may consider that it draws a bigger revenue from Court fees under the present anomalous and inequitable arrangement of court boundaries is no reason why the citizens and tax-payers of Calcutta proper should be denied recourse in necessary litigation to their own High Court.

### District Courts, Method of division of British India for the administration of justice.

British India is divided for purposes of the administration of civil justice into areas under the superintendence of certain High Courts, a certain Chief Court and certain Courts of Judicial Commissioners. These divisions correspond in most instances but not altogether with the Provinces and other administrative areas into which British India has been divided also for the purposes of executive government. The areas under the superintendence of the High Courts, the Chief Court and the Courts of Judicial Commissioners mentioned are sub-divided for the purposes of the administration of civil justice into Districts, each of which has a District Court. These judicial Districts which comprise in each instance the area of the jurisdiction of each District Court, by no means always correspond with the revenue Districts into which British India is divided for purposes of collection of revenue and executive administration.

It is to these District Courts that the jurisdiction of hearing and deciding suits for the infringement of Patents is given under Section 29 of the Indian Patents & Designs Act of 1911.

Today; since the passing of the Government of India Act of 1935 whereby, among the other provisions made for the alteration of the constitution of India, provision was made that Burma and Aden should cease to be part of India;<sup>63</sup> the position in regard to the division of British India proper for the purposes of the administration of civil justice would appear to be that there will be 7 High Courts, 1 Chief Court, and 5 Courts of Judicial Commissioners<sup>64</sup>. In the several areas demarcated for the superintendence of those superior courts there are several scores of District Courts spread over the whole territory of British India.

It may be convenient to record here a list of the various superior courts consisting of High Courts, Chief Courts and Courts of Judicial Commissioners existing in British India, since it is round these units, as already explained, for purposes of practical superin-

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<sup>63</sup> 26 Geo. 5 Ch. 2. Section 46(2) and Section 94(2).

<sup>64</sup> Under Section 219 of the Government of India Act of 1935 it is provided substantially that those courts mentioned "shall in relation to British India be deemed to be High Courts for the purposes of this Act."



tendence and administration, that the District Courts throughout British India are grouped.

*High Courts :—*

- (i) Calcutta (created by Letters Patent dated 28th December 1865). Having superintendence over all District Courts in the Presidency of Bengal and in the province of Assam.<sup>65</sup>
- (ii) Madras (created by Letters Patent dated 28th December 1865). Having superintendence over all District Courts in the Presidency of Madras.<sup>66</sup>
- (iii) Bombay (created by Letters Patent dated 28th December 1865). Having superintendence over all District Courts in the Presidency of Bombay.<sup>67</sup>
- (iv) Allahabad (created by Letters Patent dated 17th March 1866)<sup>68</sup> Having superintendence over all District Courts in that part of the province known as the United Provinces which comprises the old province of Agra.
- (v) Patna (created by Letters Patent dated 9th February 1916).<sup>69</sup> Having superintendence over all District Courts in what is now the province of Bihar ; also, at present those in the new province of Orissa.
- (vi) Lahore (created by Letters Patent dated 9th February 1919). Having superintendence over all District Courts in the Province of the Punjab.<sup>70</sup>
- (vii) Nagpur (created by Letters Patent dated 2nd January 1936). Having superintendence over all District Courts in the province known as the Central Provinces (& Berar).<sup>71</sup>

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<sup>65</sup> See Calcutta High Court Rules (3rd. edn : 1930) p. 78.

<sup>66</sup> See Civil Court Manual (5th edn : 1936) p. 2210.

<sup>67</sup> Ibid.

<sup>68</sup> For convenient reference to which, see the Civil Court Manual (5th Edn : 1936) p. 2199.

<sup>69</sup> Ibid p. 2234.

<sup>70</sup> Ibid p. 2246.

<sup>71</sup> Ibid p. 2198a. This High Court is not mentioned by name in Section 219 of the Government of India Act of 1936 but is included within the general descriptive words of that section.

*Chief Courts :—*

There is now only one Chief Court in British India, being the Chief Court of Oudh at Lucknow: having superintendence over all District Courts in that part of the province now known as the United Provinces which comprises the old province of Oudh.

*Courts of Judicial Commissioners :—*

- (i) Sind.
- (ii) North-West Frontier Province.
- (iii) Coorg.
- (iv) Ajmer-Merwara.
- (v) Delhi.<sup>72</sup>

*Additional territories :—*

Besides those parts of British India which are for purposes of judicial administration under the superintendence of those superior courts above-mentioned, there are certain additional areas making up the full territory of British India which do not appear for purposes of civil judicial administration to fall directly under the control or supervision of any superior civil court such as a High Court or a Chief Court or a Court of a Judicial Commissioner. These are :—

- (i) British Baluchistan.
- (ii) The Andaman & Nicobar Islands.
- (iii) Panth Piploda.<sup>73</sup>

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<sup>72</sup> None of the above-mentioned Courts except only the High Courts of the three Presidencies of Bengal, Madras & Bombay have any ordinary original civil jurisdiction. Consequently there is no jurisdiction which allows any suit for the infringement of a Patent to be filed in the first instance in any of those Courts except in the three Presidency High Courts. The complete list of these superior courts (which function primarily as Appellate Courts) is given here merely for general interest and because for purposes of administration each of these superior courts forms the nucleus round which a number of the District Courts presently to be considered are grouped.

<sup>73</sup> Panth Piploda, a Thakurat in the Malwar Agency, is peculiar among the minor holdings of that Agency, being held directly from the British Government without the intervention of any Indian State. See the Imperial Gazetteer of India (1908 edn.) Vol. XVII p. 98 and Vol. XIX p. 405. It is in these circumstances that it has been designated a Chief Commissioner's Province for purposes of executive government under the Govt. of India Act of 1935 : Sec. 94.

### District Courts throughout British India.

The following are the District Courts in British India. Each one of these, provided the particular court has jurisdiction in the particular case, has power to entertain, hear, and decide a suit for the infringement of a Patent.

#### *DISTRICT COURTS UNDER THE CALCUTTA HIGH COURT IN THE TERRITORY COMPRISING THE PRESIDENCY OF BENGAL AND THE PROVINCE OF ASSAM:—*

*N. B. Though the territory of the province of Assam is a separate Governor's Province for the purposes of executive administration, there is no High Court or Chief Court or Court of a Judicial Commissioner for Assam. Under present arrangements the District Courts throughout the province of Assam are administered under the superintendence of the Calcutta High Court.<sup>14</sup>*

*In Bengal :—*

#### **Location and name of District Courts.**

##### *(In the Burdwan Division)*

- |            |  |
|------------|--|
| 1. BURDWAN | 4. MIDNAPORE                             |
| 2. BIRBHUM | 5. HOOGHLY (includes the area of Howrah) |
| 3. BANKURA |  |

##### *(In the Presidency Division)*

- |  |                |
|--|----------------|
| 6. 24 PARGANAS (includes the areas of Alipore and Sealdah) | 8. MURSHIDABAD |
|  | 9. JESSORE     |
| 7. NADIA   | 10. KHULNA     |

##### *(In the Dacca Division)*

- |                |               |
|----------------|---------------|
| 11. DACCA      | 13. FARIDPUR  |
| 12. MYMENSINGH | 14. BAKARGANJ |

##### *(In the Rajshahi Division)*

- |   |                   |
|---|-------------------|
| 15. RAJSHAHI & MALDA                          | 17. RANGPUR       |
| 16. DINAJPUR—<br>JALPAIGURI AND<br>DARJEELING | 18. PABNA & BOGRA |

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<sup>14</sup> There has for some time been a considerable body of opinion in Assam in favour of the creation of a separate High Court or Chief Court for Assam. The chief difficulty against the scheme is lack of finance.

*(In the Chittagong Division)*

- |                       |                |
|-----------------------|----------------|
| 19. TIPPERA (COMILLA) | 21. CHITTAGONG |
| 20. NOAKHALI          |                |

*In Assam :—*

- | Location and name of<br>District Courts :—                     | Having jurisdiction over the<br>Revenue Districts of :—                  |
|--|--|
| 1. ASSAM VALLEY DISTRICT COURT.<br>(at Gauhati and on circuit) | 1. Darrang ; Goalpara ; Kamrup ;<br>Lakhimpur ; Nowgong and<br>Sibsagar. |
| 2. SURMA VALLEY DISTRICT COURT.<br>(at Sylhet). <sup>75</sup>  | 2. Sylhet and Cachar.  |

**DISTRICT COURTS UNDER THE BOMBAY HIGH COURT  
IN THE TERRITORY COMPRISING THE PRESIDENCY  
OF BOMBAY.**

*(EXCLUSIVE OF SIND)*

- |                               |                         |
|-------------------------------|-------------------------|
| 1. AHMEDABAD                  | 10. WEST KHANDESH       |
| 2. AHMEDNAGAR                 | 11. KOLABA              |
| 3. BELGAUM                    | 12. NASIK               |
| 4. BIJAPUR                    | 13. POONA               |
| 5. BROACH AND<br>PANCH MAHALS | 14. RATNAGIRI           |
| 6. DHARWAR                    | 15. SATARA              |
| 7. KAIRA                      | 16. SHOLAPUR            |
| 8. KANARA                     | 17. SURAT               |
| 9. EAST KHANDESH              | 18. THANA <sup>76</sup> |

**DISTRICT COURTS UNDER THE MADRAS HIGH COURT  
IN THE TERRITORY COMPRISING THE PRESIDENCY  
OF MADRAS.**

- |                 |                    |
|-----------------|--------------------|
| 1. ANANTAPUR    | 6. CHITTOOR        |
| 2. ARCOT, SOUTH | 7. COIMBATORE      |
| 3. ARCOT, NORTH | 8. CUDDAPAH        |
| 4. BELLARY      | 9. GANJAM          |
| 5. CHINGLEPUT   | 10. GODAVARI, EAST |

<sup>75</sup> See Acts II and VI of 1835.<sup>76</sup> See Bombay Civil Courts Act of 1889, Sec. 5.

- |                    |   |
|--------------------|---|
| 11. GODAVARI, WEST | 18. MALABAR, SOUTH                                |
| 12. GUNTUR         | 19. NELLORE                                       |
| 13. KANARA, SOUTH  | 20. RAMNAD  |
| 14. KISTNA         | 21. SALEM   |
| 15. KURNOOL        | 22. TANJORE, WEST                                 |
| 16. MADURA         | 23. TANJORE, EAST                                 |
| 17. MALABAR, NORTH | 24. TINNEVELLY                                    |
| 25. TRICHINOPOLY   |   |
| 26. VIZAGAPATAM    |   |
| 27. AGENCY TRACTS  | } GANJAM<br>GODAVARI<br>VIZAGAPATAM <sup>77</sup> |

*DISTRICT COURTS UNDER THE ALLAHABAD HIGH COURT IN THE UNITED PROVINCES IN THE TERRITORY COMPRISING THE OLD PROVINCE OF AGRA.*

- |                                       |                  |
|---------------------------------------|------------------|
| 1. AGRA (includes the area of Muttra) | 10. FURRUKHABAD  |
| 2. ALIGARH                            | 11. GHAZIPUR     |
| 3. ALLAHABAD                          | 12. GORAKHPUR    |
| 4. AZAMGARH                           | 13. JHANSI       |
| 5. BAREILLY                           | 14. KUMAUN       |
| 6. BENARES                            | 15. MAINPURI     |
| 7. BUDAUN                             | 16. MEERUT       |
| 8. BULANDSHAHR                        | 17. MORADABAD    |
| 9. CAWNPORE                           | 18. SAHARANPUR   |
|                                       | 19. SHAHJAHANPUR |

*DISTRICT COURTS UNDER THE PATNA HIGH COURT IN THE TERRITORY COMPRISING THE PROVINCE OF BIHAR AND THE PROVINCE OF ORISSA.*

*N. B. Though the territory of Orissa has under Section 4 the Government of India Act of 1935 been made a separate Governor's Province for the purposes of executive administration, there is at present no High Court or Chief Court or Court of a Judicial Commissioner for Orissa. No mention appears to be made in the Government of India Act of 1935 as to the future arrangements to be in force for the judicial superintendence of the District Courts in Orissa. At present the District Courts throughout the Province of Orissa are continued to be administered under the superintendence of*

<sup>77</sup> See Madras Civil Courts Act (Act III of 1873).

*the High Court at Patna. It may be presumed however in view of the marked tendency to independent Provincial autonomy now shown in the new Government of India Act, that such an arrangement where the District Courts of one Province are to be under the superintendence of a Court of another province will not long be allowed to continue.*

*In Bihar :—*

- |                |                  |
|----------------|------------------|
| 1. PATNA       | 7. BHAGALPUR     |
| 2. GAYA        | 8. MONGHYR       |
| 3. SHAHABAD    | 9. PURNEA        |
| 4. SARAN       | 10. CHOTA NAGPUR |
| 5. MUZAFFARPUR | 11. MANBHUM—     |
| 6. DARBHANGA   | SAMBALPUR        |

*In Orissa.*

- | Name and Location of<br>District Courts :—                            | Having jurisdiction over<br>Revenue Districts of :—   |
|---|---|
| 1. DISTRICT COURT OF<br>CUTTACK-SAMBALPUR.<br>(at Cuttack)            | 1. Cuttack ; Balasore : and<br>Sambalpur.   |
| 2. DISTRICT COURT OF<br>GANJAM-PURI. <sup>78</sup><br>(at Berhampur). | 2. Puri ; Ganjam ; and Kora-<br>put.<br>(Excluding the agency tracts<br>in Ganjam and Koraput). |

*N.B. In the District of Ganjam and Koraput the District Magistrates concerned function as District Judges under the Superintendence of the High Court of Patna ; and in the tracts known as the districts of Angul and the Khondmals the Deputy Commissioners of the respective areas have jurisdiction as District Judges subject to the control of the Revenue Commissioner of Orissa who functions as the High Court for the said districts of Angul and the Khondmals.*

#### **DISTRICT COURTS UNDER THE HIGH COURT OF LAHORE IN THE TERRITORY COMPRISING THE PROVINCE OF THE PUNJAB.**

- |               |             |
|---------------|-------------|
| 1. RAWALPINDI | 3. AMBALA   |
| 2. JHELUM     | 4. SARGODHA |

<sup>78</sup> See The Bengal, Agra and Assam Civil Courts Acts of 1887.

- |               |               |
|---------------|---------------|
| 5. KARNAL     | 8. FERROZEPOR |
| 6. AMRITSAR   | 9. MONTGOMERY |
| 7. GUJRANWALA | 10. LAHORE    |

**DISTRICT COURTS UNDER THE NAGPUR HIGH COURT  
IN THE TERRITORY COMPRISING THE CENTRAL  
PROVINCES.**

- |                |                         |
|----------------|-------------------------|
| 1. AKOLA       | 6. NAGPUR               |
| 2. AMRAOTI     | 7. NIMAR                |
| 3. CHHINDWARA  | 8. RAIPUR               |
| 4. HOSHANGABAD | 9. WARDHA <sup>79</sup> |
| 5. JUBBALPORE  |                         |

**DISTRICT COURTS UNDER THE CHIEF COURT OF OUDH  
AT LUCKNOW IN THE UNITED PROVINCES IN THE  
TERRITORY COMPRISING THE OLD PROVINCE OF  
OUDH.**

<i>Location and name of District Court.</i>	<i>Having jurisdiction over the revenue districts of:—</i>
1. BARA BANKI	1. Bara Banki
2. FYZABAD	2. Fyzabad and Sultanpur
3. GONDA	3. Gonda and Bahraich
4. HARDOI	4. Hardoi
5. LUCKNOW	5. Lucknow
6. RAE BARELI	6. Rae Bareli and Partabgarh
7. SITAPUR	7. Sitapur and Kheri
8. UNAO	8. Unao <sup>80</sup>

**DISTRICT COURTS UNDER THE COURT OF THE JUDI-  
CIAL COMMISSIONER OF SIND IN THE TERRITORY  
COMPRISING THE PROVINCE OF SIND.**

*N.B. By the Sind Courts Act (Bombay Act VII of 1926) which was afterwards supplemented by the Sind Courts (Supplementary) Act 1926 (being an Act of the Indian Legislature No. XXXIV of 1926) full provision was made for the establishment of a Chief Court of*

<sup>79</sup> The District Courts in the Central Provinces were created under Section 16 of the Central Provinces Courts Acts, Central Provinces Act 1 of 1917.

<sup>80</sup> District Courts were first created in the province of Oudh by Act XIII of 1879. See also Section 23 of U. P. Act IV of 1925.

*Sind. The Act was to come into force on such date as the Governor in Council (of Bombay) might by notification in the Bombay Gazette appoint. The Act has not however as yet been put into force; no such notification having been issued. The reason for this state of affairs is presumably lack of finance. In the meantime Sind has become a separate province for the purposes of executive administration, as provided for in Section 289 of the Government of India Act of 1935 made effective by Notification of the Governor General in Council as from 1st April 1936.*

1. HYDERABAD (SIND)
2. SUKKUR
3. LARKANA

(Also at Karachi)<sup>81</sup>

**DISTRICT COURTS UNDER THE COURT OF THE JUDICIAL COMMISSIONER OF THE NORTH WEST FRONTIER PROVINCE: IN THE TERRITORY COMPRISING THE NORTH WEST FRONTIER PROVINCE :—**

There are two District Courts for the North West Frontier Province which are situated at :—

1. PESHAWAR
2. DERAJAT<sup>82</sup>

**DISTRICT COURTS UNDER THE COURT OF THE JUDICIAL COMMISSIONER OF COORG : IN THE TERRITORY COMPRISING THE CHIEF COMMISSIONER'S PROVINCE OF COORG :—**

There is only one District Court for Coorg, which is situated at :—

**MERCARA<sup>83</sup>**

<sup>81</sup> These District Courts were created by Bombay Act XII of 1866, amended by Bombay Act 1 of 1906 and again by Bombay Act 2 of 1916.

<sup>82</sup> See The North West Frontier Province Courts Regulation (No. I of 1931).

<sup>83</sup> This District Court was created under the Coorg Courts Regulation of 1901. Subordinate civil courts were created in Coorg by H. E. the Governor-General in Council's Regulation 2 of 1881 passed under the authority of 33 Vict c 3.



*DISTRICT COURTS UNDER THE COURT OF THE JUDICIAL COMMISSIONER OF AJMER-MERWARA : IN THE TERRITORY COMPRISING THE CHIEF COMMISSIONER'S PROVINCE OF AJMER-MERWARA :—*

There is one District Court for Ajmer-Merwara which is situated at :—

**AJMER<sup>84</sup>**

*DISTRICT COURTS UNDER THE COURT OF THE JUDICIAL COMMISSIONER OF DELHI : IN THE TERRITORY COMPRISING THE CHIEF COMMISSIONER'S PROVINCE OF DELHI :—*

There is one District Court for this territory which is situated at :—

**DELHI**

In the territories above mentioned there are, of course, in addition to the District Courts above mentioned, multitudinous subordinate courts, to which no reference for present purposes is necessary ; since it is only in a District Court and not in any court subordinate to a District Court that a suit for the infringement of a Patent may under the Indian Patent and Designs Act of 1911, be instituted.

Since Burma is to be separated from British India all particulars relating to Burma have been omitted here.

*AS TO THE REMAINING TERRITORIES OF BRITISH INDIA :—*

In regard to the territories already named an infringement suit may be brought, as previously observed, in the appropriate District Court of those mentioned.

In regard to the remaining territories of British India, consisting of British Baluchistan, the Andaman and Nicobar Islands. and Panth Piploda, it is not altogether clear in what Court a suit for infringement of a Patent committed in these territories should be instituted. There is no doubt that the monopoly created by an Indian (i.e., British Indian) Patent runs in these areas equally as in

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<sup>84</sup> See Regulation IX of 1926.

the territories already named. It is also clear that a suit for infringement of a Patent should be instituted in whatever is the appropriate "District Court" in the territory concerned. The position is however somewhat anomalous, since it appears that there are no "District Courts" strictly so-called in these territories. It would seem however that in these territories an infringement suit could be brought in whatever is the superior court of civil jurisdiction concerned.

**Nature of the jurisdiction, in suits for the infringement of a Patent, of the District Courts in British India.**

The original civil jurisdiction (under which the jurisdiction to entertain a suit for infringement of a Patent is of course included) of any one of the abovementioned District Courts is governed by the ordinary principles contained in Section 20 of the Civil Procedure Code, the terms of which are as follows :—

"20. Subject to the limitations aforesaid, every suit shall be instituted in a Court within the local limits of whose jurisdiction—

- (a) the defendant, or each of the defendants where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for gain ; or
- (b) any of the defendants, where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for gain, provided that in such case either the leave of the Court is given, or the defendants who do not reside, or carry on business, or personally work for gain, as aforesaid, acquiesce in such institution ; or
- (c) the cause of action, wholly or in part, arises."

The antecedent Section 19 does not appear to affect the general provisions of Section 20 in regard to the proper place of suing for suits for infringement of a Patent. Section 19 is as follows :—

"19. Where a suit is for compensation for wrong done to the person or to movable property, if the wrong was done within the local limits of the jurisdiction of one Court and the defendant resides, or carries on business, or

personally works for gain, within the local limits of the jurisdiction of another Court, the suit may be instituted at the option of the plaintiff in either of the said Courts."

From this it is clear that in the case of a District Court its jurisdiction is, (unlike that of a High Court previously considered above), independent of any question of leave to sue being granted in cases where a part of the cause of action only arose within the jurisdiction.

Therefore if a Patentee contemplates filing a suit for infringement of his Patent in any particular District Court he may rest assured that that particular District Court will have full and complete jurisdiction if the circumstances of the particular case fulfil any one set of the following conditions :—

1. If the Defendant (or all if more than one) at the time of the commencement of the suit resides within the local limits of the jurisdiction of the Court.
- or 2. If the Defendant (or all if more than one) carries on business or personally works for gain within such limits.
- or 3. If the cause of action either wholly or even in part arose within such limits.
- or 4. In cases where there are more defendants than one, then if any one of the Defendants resides within such limits provided either (a) Leave of the Court to sue in that Court has been obtained or (b) the outside Defendants acquiesce.
- or 5. Similarly in cases where there are more defendants than one, then if any one of the defendants carries on business or personally works for gain within such limits provided either (a) Leave of the Court to sue in that Court has been obtained or (b) the outside defendants acquiesce.

The plaintiff then need have no anxiety that any application made by the Defendant will oust his suit from the jurisdiction chosen by the Plaintiff on any ground that it was only a small part of the cause of action which arose within the jurisdiction. The Plaintiff will be spared all anxiety in the way of any applications on any such ground for revocation of leave to sue.

### Jurisdiction in Suits against the Secretary of State.

Now that the majority of Railways in India are nationalized so that the legal owner of such railways is the Secretary of State for India in Council, any suit by any patentee for any infringement by any railway of his patent will require to be filed against the Secretary of State as Defendant.<sup>65</sup> It may be worth while therefore

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<sup>65</sup> It would seem clear that a suit for infringement of Patent will lie against the Secretary of State in a case of an infringement of a Patent by a State-owned Railway. Though the Secretary of State is immune from any legal liability in tort for any act done in his sovereign capacity, it seems clearly established that this immunity does not ordinarily extend to acts done in his capacity as successor to the East India Company in commercial undertakings. See *P. & O. Steam Navigation Company v. Secretary of State for India* (1861) 5. Bom. H. C. R. App. A. p. 1; *Secretary of State for India in Council v. Moment* (1913) 40. Cal. 391 and the principles stated in *Mc Inerny v. Secretary of State for India* (1911) 38. Cal. 797; *Secretary of State for India in Council v. Cockcroft* (1914) 39. Mad. 351. Compare also *Secretary of State for India in Council v. Hari Bhanji* (1882) 5. Mad. 273 (not followed in the Calcutta cases); and distinguish the following cases in which the Secretary of State was held to be not liable owing to his immunity by reason of the act complained of as being a tort, having been done by him (or his servants) in his sovereign capacity :—*Secretary of State for India in Council v. Ramnath Bhatta* (1933) 37 C. W. N. 957; *Nobin Chunder Dey v. Secretary of State for India* (1875) 1. Cal. 11; *Shivabhanjan Durgaprosad vs. Secretary of State for India* (1904) 28. Bom. 314; *Ross v. Secretary of State for India in Council* (1913) 37 Mad. 55; *Secretary of State for India in Council v. Shreegobinda Chaudhuri* (1932) 59 Cal. 1289. The next question is whether in managing the state-owned railway the Secretary of State is acting as successor to the East India Company in a commercial undertaking or in a sovereign capacity. The case of *M. D'Orux & Others v. Secretary of State for India in Council* 40 C. W. N. 885 (the case though heard in 1932 having been only recently reported in 1936) would appear to be some authority for the proposition that the Secretary of State in respect of his ownership and management of the state-owned railways is acting in the capacity of a successor of the East India Company. In that case though the Secretary of State was held not liable for the claim in suit which was for the tort of wrongful dismissal, this conclusion was arrived at only on the ground that the East India Company itself would not have been liable for any claim of alleged wrongful dismissal by it or its servants; this immunity in this particular respect being due to certain express provisions of the Statutes under which the East India Company operated. For this reason alone it was held in that case that the Secretary of State also as successor to the East India Company could not be liable for any alleged wrongful dismissal. There would not appear to be any special provisions in any of the Statutes under which the East India Company operated which exempted it from liability on a claim for the infringement of a Patent. It follows, if the management of the state-owned railways is

noting before leaving this question of jurisdiction and Clause 12 of the Letters Patent, that it has been held in effect that the Secretary of State does not dwell anywhere or carry on business anywhere or personally work for gain anywhere within the meaning of Clause 12.

It is difficult to understand altogether the reasoning of the decisions. It is submitted it might be understandable if the view had been taken that the Secretary of State is in precisely the same legal position as the Crown in England, that is to say in no case liable for any tort : and not in any respect in any case liable in such a way as a private individual is liable. But this is not the law in India. For it has been repeatedly held that the Secretary of State has a dual personality—the one when he functions as the Crown and the other when he functions as the successor in business of the East India Company—and that in the latter personality he is liable for instance in tort, as any private individual. In that capacity it seems difficult to see how he can be said to have no dwelling, and no place where he carries on business and no place where he works for gain. It is submitted that if he does, as Government shows a progressively increased tendency to do, set up in business, as an owner of Railways and the like, then the Government in British India ought in all fairness to the general public to adopt one or other of two courses. They ought either to do, as Government does in England in such cases, make it known that the Secretary of State wishes to waive all special rights accruing to him by reason of his sovereign status in so far as his liabilities arising in matters which concern the Railways or other purely commercial undertakings are concerned, and in that sphere to submit to all the

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held to be only a commercial undertaking, that the Secretary of State must be liable as any other private individual for any infringement of a Patent by any state-owned railway. Even in the last mentioned case however though the learned Judge decided the case on the assumption that even if the Secretary of State in managing the railway was acting as a successor to the East India Company, this being the view most favourable to the Plaintiff, nevertheless he would not even then be liable ; yet the learned Judge does not anywhere appear positively to have stated as his view that the Secretary of State in managing the railway was not acting in a sovereign capacity. It seems curious that the point does not seem ever to have been expressly decided whether the business of managing the state-owned railways on the part of the Secretary of State is done by him in his sovereign capacity or as successor to the East India Company in the capacity of an ordinary commercial gentleman.

liabilities of a private person. Or else they should introduce definite legislation declaring that in the spheres in which the Secretary of State is acting in a purely business capacity, as successor of the East India Company, he has all the liabilities, including those as to tort in general and as to infringement of Patents in particular, of a private individual ; and is to be deemed to dwell at or carry on business at any place where, according to the ordinary principle of law applicable to ordinary persons, he would be held, if he were an ordinary person, to do so. If one or other of these courses are not adopted, it will entail great hardship on persons dealing with the Secretary of State in his business capacity, as when dealing with the Railways.

However as the law stands at present there is no doubt about it that there have been decisions in several cases to the effect already indicated : and accordingly the Secretary of State can only be sued in a Chartered High Court in cases either where the whole of the cause of action has arisen within the jurisdiction or where a part has, and leave has been obtained under Clause 12 : and no suit can be brought against him in the High Court on the other grounds which are open in the case of a private individual, *viz.* that he dwells or carries on business or personally works for gain within the jurisdiction.<sup>86</sup>

### **Jurisdiction in suits against the Federation of India.**

In the event of the Federation of India which is contemplated in the Government of India Act being created at any future date, the Railways presumably will vest in the Federation of India or in the Crown for the Federation of India. In such event any suit for infringement of a Patent by a state-owned Railway will have to be brought against the Federation of India.<sup>87</sup>

It would appear that in that event the principles mentioned in the last preceding paragraph as having been applied in the cases to the Secretary of State in Council will equally apply to the Federa-

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<sup>86</sup> See *Doya Narain Tewary v. Secretary of State for India in Council*. (1887). 14. Cal. 256 ; *Rodricks v. Secretary of State* (1913) 40. Cal. 308 ; and *C. Govinda-rajulu Naidu v. Secretary of State for India in Council*. (1927) 50. Mad. 449.

<sup>87</sup> See Government of India Act, 1935, Secs. 172, 173, 176, 177 and 179 ; also Part VIII, Secs. 181 to 199.

tion of India. If so, the Federation of India, though owner of the state controlled Railways of India, will have to be treated in law as having no dwelling and no place where it carries on business. Accordingly a suit for infringement of a Patent by a state-owned Railway will then, equally as now, only be able to be brought in a Chartered High Court or in a District Court where the whole cause of action has arisen or where part of the cause of action has arisen ; and in the case of a High Court in the latter case only with leave to sue obtained by the High Court in question.

### 5. Limitation of suits.

Article 40 of the Indian Limitation Act governs the period of limitation within which suits for infringement of patent must be brought. The wording of the article is as follows :—

“40. For compensation for infringing copyright or any other exclusive privilege :—Three years, (from the date of the infringement).”

### 6. Questions of estoppel and res judicata where there have been previous proceedings between the same parties—

In considering whether a suit should or should not be filed questions will in certain cases arise as to whether the Plaintiff is estopped from bringing a suit for infringement by reason of previous proceedings between the same parties. Circumstances can be imagined seldom to occur where the Plaintiff will be estopped by conduct from bringing a suit. There will however more frequently arise cases where the Plaintiff is estopped or barred by res judicata from bringing a suit against the Defendant by reason of some previous decision in previous proceedings between the same parties. Thus if in a previous suit between the same parties the patentee's patent had been held to be invalid the patentee would be conclusively barred from bringing a fresh suit against the same defendant in respect of another infringement of the same patent, unless of course the previous ground of invalidity had been since cured by amendment of his specification.<sup>88</sup>

In India the matter is covered for most if not all practical purposes in regard to previous litigation in Court by Section 11 of the Civil Procedure Code. Reference should be made to the precise

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<sup>88</sup> See *Horrocks v. Stubbs* (1895) 12 R.P.C. 540.

wording of the Section itself and to the comments thereon in Mulla's Civil Procedure Code (10th Edition : 1934) p. 37 et seq. It is not therefore necessary in that connection here to consider old English cases concerning estoppel by record apart from cases within that section.

It will be noted that the section is only applicable between the same parties or "between parties under whom they or any of them claim litigating under the same title".

At the same time it is to be observed that it has been held by the Privy Council that the principle of *res judicata* which prevents the same case being twice litigated is of general application and is not limited to the specific words of the Code ; and in short that Section 11 is not exhaustive.<sup>80</sup> Similarly it has been held that when a question of an interlocutory nature and therefore not strictly within Section 11, has been decided between certain parties in a suit yet this is an effective bar to a subsequent suit litigating the same question between the same parties.<sup>90</sup>

Where the same question has been the subject of previous arbitration proceedings between the same parties the award will, under the Indian Arbitration Act, as an estoppel, act as a bar to a subsequent suit.<sup>91</sup>

Similarly by reason of estoppel or *res judicata* the Defendant may be barred from making an effective defence to the suit.<sup>92</sup>

Cases of estoppel by conduct will arise for example where the Defendant is an assignor or a licensee of a patent from the Plaintiff.

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<sup>80</sup> See *Hook v. Administrator General of Bengal and ors.* (1921) 48. Cal. 499 or 48 I. A. 187 : and *Ramachandra Rao v. Ramchandra Rao* (1922) 45 Mad. 320 or 49 I. A. 129 : in these cases the argument was put forward that when the previous proceedings were interlocutory proceedings in execution and not a suit, therefore Section 11 was not applicable and as the section was exhaustive there was no bar to the subsequent proceedings, but the Privy Council held as indicated above that the section was not exhaustive and the subsequent proceedings were barred.

<sup>90</sup> See *Kalipada De and ors. v. Dwijapada Das and ors.* (1930) 34 C. W. N. 201 (P. C.) ; whereby previous cases to the contrary effect must be considered as overruled.

<sup>91</sup> See Sec. 8 of the first Schedule of the Indian Arbitration Act (Act IX of 1899), but see e.g., *Newall v. Elhot*, I. H. and C. 797 or 32. L. J. Ex. 129 and *Russel on Arbitration and Award* (13th edn : 1935) at p. 418.

<sup>92</sup> See also Chapter XVI at p. 601.



Cases of *res judicata* will arise in cases similar to those above already considered but where the previous decision has been adverse to the Defendant. Thus where the Plaintiff's patent has been held to be valid in a previous suit, the defendant will be barred by *res judicata* from setting up a defence of its invalidity in the subsequent suit : and this none the less though he may then seek to do so on entirely new grounds.<sup>93</sup>

And of course the result in law and the bar to subsequent proceedings is the same whether the judgment is after a contested hearing or by consent.<sup>94</sup>

A distinction has been made between *res judicata* and estoppel for which reference may be made to Mulla's Civil Procedure Code (10th Edition) p. 389 and the cases there cited, but the distinction there made is of no importance in connection with the matter now under discussion, which is merely primarily, how far if at all the Plaintiff may be barred from success in his projected suit and secondarily how far, if at all, the defendant will be barred from a defence.

It may conveniently here also be noted that by Section 10 of the Civil Procedure Code it is provided to the effect that where a previous suit between the same parties is pending, the subsequent suit may be stayed.

**Where there has been a previous decision of the same or one of the same questions in issue, but in proceedings between different parties.**

In such a case though the previous decision is in no sense a *res judicata* or an estoppel so as to operate as a legal bar to the subsequent proceedings yet in certain matters such as on a question of the construction of the specification of the patent in question, the Court will usually hold itself bound to follow the previous decision.<sup>95</sup>

<sup>93</sup> See *Murex Welding Processes Ltd. v. Weldries* (1922) Ltd. (1933) 50 R.P.C. 178 at 182 ; *Thomson v. Moore* (1889) 6 R.P.C. 426 and (1890) 7 R.P.C. 325 (H.L.) ; *Shoe Machinery Co. v. Cutlan* (1896) 1 Ch. 667 or 13 R.P.C. 141.

<sup>94</sup> See *Thomson v. Moore* above and *Brown v. Hastie & Co. Ltd.* (1906) 23 R.P.C. 361 (H.L.)

<sup>95</sup> See (1886) 3 R.P.C. 109 at p. 114 ; (1889) *The Automatic Weighing Machine Co. v. The Combined Weighing Machine Co.* 6 R.P.C. 367 (C.A.) ; (1889) *Edison and Swan Electric Light Co. v. Holland.* 6 R.P.C. 243 (C.A.) at p. 300. See also for the principle that a decision in a suit for infringement between A & B is not a bar to a subsequent petition with the fiat of the Advocate-General by B,

## 7. Inspection of Defendant's machine before filing of Plaintiff.

In England a Plaintiff has been allowed, on an application made by him on the summons for directions, an order for inspection of the proposed Defendant's machine before delivering to the other side his Statement of Claim ; so that he may in a proper case be in a position to supply with his claim proper particulars. The application was made under Order 50 Rule 3 of the English Rules of the Supreme Court.<sup>96</sup> There appears no positive provision of law or procedure making it impossible for the course adopted in that case to be allowed in a proper case in India. But it is more likely to be held in India that no application for inspection of such a machine can well be made unless a Plaintiff has been filed prior to such application or is at least filed simultaneously with it ; otherwise, there being no suit in existence, no application strictly speaking—which can only be made in the suit—would lie. An undertaking at least from a responsible attorney would be required to be given that the necessary suit would in fact be filed. And the Courts in India may be less inclined to accept such an undertaking and to dislocate the ordinary routine for the filing of suits by doing so, instead of insisting on the Plaintiff being filed first.

The Plaintiff may however plead that he proposes to give further particulars of his claim after he will have obtained inspection of the Defendant's machine from the Defendant.

## As to inspection of documents before filing of Plaintiff.

Should the Court take the view that no order can be made in the suit before the Plaintiff is filed, it is, in practice not possible for inspection to be obtained of the documents in Defendant's possession before drawing the Plaintiff. Yet it will often happen that full and proper particulars of the claim cannot be given in the Plaintiff in the absence of particulars which are within the knowledge of the Defendant and not of the Plaintiff and which may appear from an inspection of Defendant's books of accounts or other documents. In such a case all that the Plaintiff can do is to state in his Plaintiff

who then sues not as a private individual but as a member of the public, page 443 above and the cases cited. The position will be different where the earlier decision is a decision in rem, which will be binding against all the world.

<sup>96</sup> See *Edler v. Victoria Press Manufacturing Company*. (1910) 27 R.P.C. 114.

that he reserves to himself the right to make further claims in respect of further reliefs and will give further particulars of his claim after inspection of the Defendant's books and documents.

### 8. Service of the writ.

Service of the writ of summons in Patent suits is governed by the ordinary rules relating to service in all suits. It is unnecessary therefore here to go in any detail into questions concerning the procedure for service of the writ of summons.

In suits for infringement of Patent it will frequently happen that recourse has to be had to service of the summons by registered post : leave being obtained for the purpose.<sup>87</sup>

So long as it can be shown that the postman has served the summons on the proper person, this will be held to be good service. Accordingly even though the registered letter is refused by the Defendant and the postal receipt is marked "refused", this will ordinarily be held to be sufficient.<sup>88</sup>

If however the Defendant subsequently appears and denies knowledge of the writ of summons, the Court will probably order a new trial in such a case.<sup>89</sup>

If the suit is filed in a District Court the writ of summons is in all cases served on the Defendant through the Court. If the Defendant resides within the jurisdiction of the Court in which the suit is filed, the writ of summons is served personally on the Defendant by the serving officer of that Court. If not then the arrangements for service whether through another appropriate Court or by registered post are made by the Court in which the suit is instituted. Neither the Plaintiff nor the Plaintiff's Attorney has any concern in the actual process of serving the writ of summons when the suit is instituted in a District Court.

<sup>87</sup> In the Calcutta High Court the practice is to obtain such leave on application to the Master.

<sup>88</sup> See Section 27 General Clauses Act (Act 10 of 1897) ; (1911) *Balaram Ramkissen and ors. v. Bai Pannabai and anr.* 35. Bom. 213 ; (1914) *Roopchand Rangildas v. Haji Hossein Haji Mahomed Soudagar* 16. Bom. L.R. 204 ; the matter is governed in the Calcutta High Court by Rule 11 of Chapter VIII of the Rules of that High Court ; compare Mulla's Civil Procedure Code (10th Edn.) p. 519 and 520 commenting on a similar point arising on Order 5 Rule 21, Civil Procedure Code.

<sup>89</sup> See *Sunder Spinner and anr v. Makan Bhula* (1922) 46. Bom. 130.

If the suit is instituted in a High Court, the position is different : being governed by the rules of the particular High Court.

In the Calcutta High Court originally all writs of summons were served on the Defendant through the Sheriff. Now (see Rule 14 of Chapter 8 of the Rules of that High Court as amended on 17th August 1935), "where, the Plaintiff's Attorney has received a letter from the Defendants Attorney expressing readiness to accept service," the writ of summons may be served by the Plaintiff's Attorney or some person employed by him independently of and without reference to the Sheriff. Formerly, moreover, if leave was obtained to serve the writ of summons on the Defendant by registered post, the writ of summons was in all cases required to be sent to the Defendant by registered post by the Sheriff : (under the Rule 11 of Chapter 8 of the Rules of that Court prior to its amendment on 17th August 1935). Now where such leave to serve by registered post is granted, it would seem that leave may, if desired, at the same time also be granted by the Court for such posting to be effected direct by the Plaintiff's Attorney independently of and without reference to the sheriff.<sup>100</sup>

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<sup>100</sup> Order 49 Rule 1 of the Civil Procedure Code in itself gives power to Attorneys of a High Court to serve direct, without reference to the Court or to the Sheriff; Notices (such as Notices of Motion) in certain categories, from which the writ of summons in the suit itself is excluded. The mere absence however of a grant under the Civil Procedure Code of power to serve a Writ of Summons in the suit is not a prohibition against that power being granted outside the Civil Procedure Code. Formerly the position was that the old form of Rule 11 of Chapter 8 of the Calcutta High Court Rules made it obligatory that in all cases of service of the writ of summons in the suit by registered post, the posting was to be done through the Sheriff. Now the words "by the Sheriff to him" have been omitted from the amended Rule. Accordingly the position is that this Rule 11 of Chapter 8 does not make it obligatory for the service to be effected through the Sheriff; and therefore the words "unless the Court or a Judge shall otherwise order" in Rule 14 of Chapter 8 of the Rules of the Calcutta High Court may now be invoked. Accordingly it seems in a case in the Calcutta High Court where the Writ of Summons is to be served by registered post, provided the leave of the Court to do so is obtained, there is no bar in the Code or the Rules to prevent the Writ of Summons in the suit itself (just as in the case of a Notice of Motion in an interlocutory matter) from being posted and served by an Attorney of a High Court without reference to the Sheriff.

### Expense.

Before he embarks on Court litigation in the form of an infringement suit, it is extremely advisable that the Plaintiff should carefully consider the likely and possible expense of such a course.<sup>101</sup>

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<sup>101</sup> The following interesting comments have been made in regard to the expense of patent litigation by Mr. Haddan (President of the Chartered Institute of Patent Agents in the United Kingdom):—"Expense of Litigation—Litigation relating to patents is comparatively expensive owing to the technical character of the subject-matter. The cases which come before the Courts are not simple, of which the facts are readily comprehended by the average non-technical mind, but usually require for their understanding relatively extensive explanation by experts with the assistance and conduct of Counsel, who likewise have the ability to comprehend and explain the phenomena which bear on the case at issue. Patent cases naturally require a larger expenditure of time both for their preparation and for their presentation to the Court, than is needed in litigation concerned with (the) simplest subjects, and the basis of fees is also higher. A source of expense not usually encountered in litigation on other subjects is the expert's fees, which may run into a considerable sum according to the time that may be needed for preliminary study, tests, &c., in order that the expert may have a sufficiently intimate knowledge of the invention in question and the probable basis of the defence, to supply adequate answers to the questions of examination and cross examination. Before litigation is commenced it is extremely desirable to ascertain as fully as practically possible that the patent is supportable and that the supposed infringement is within the scope of the claims. It is usual to supplement the inadequate search of the Patent Office by further searches among foreign patents and other sources, and to submit the matter for Counsel's opinion before embarking on actual litigation. These various occasions of expense account for the relatively high cost of patent litigation and rather tend to show that a judicious arrangement of compromise may be in the better interest of both parties.

Where the matter in dispute is not of sufficient value to warrant the expense of Court litigation or the not much inferior cost of an arbitration as usually practised, it may be suggested that a convenient method for the settlement of the dispute may be found in the submission of a joint case on behalf of the patentee and on behalf of the "infringer": to an arbitrator, for example, a Patent Counsel, for an opinion which could be treated as an award. This method, with such minor variations as may be required by the nature of the points at issue, usually leads to a fair result without the proverbial uncertainties of litigation and at a fraction of the expense of the latter." See Haddan's Compendium (1931 edn.) p. 190.

## PART III

### AS TO OTHER PRELIMINARY MATTERS SUCH AS MAY ARISE PRIOR TO THE HEARING OF THE SUIT ITSELF.

Certain matters are now discussed in this part of this chapter under the headings already indicated at page 646 ; such different headings being consecutively numbered as before merely for convenience of reference.

#### 1. The Plaintiff.

The Plaintiff will need to state in his Plaintiff the following facts :—

(i) Particulars of the grant of the Patent and the nature of Plaintiff's title as registered patentee. He may mention as a short descriptive title of the invention the title of the Specification and give the number and date of the Indian Patent and state whether the Patent was originally granted to him or if not to whom and in the latter case the date and particulars of the assignment to him. In any event he should state positively that he is the registered patentee.

(ii) He should state the period of the monopoly to which he is entitled ; giving the date up to which it is current ; and it will be as well also in case there is any possibility of ambiguity or confusion in regard to the infringing acts having taken place before the monopoly commenced, that he should state the date from which his monopoly began.

It may be observed that in many cases nothing will turn on these dates but it is suggested that by drafting the Plaintiff in this form the Plaintiff's advisers will be employing a useful check over the essential features which are necessary for success in their Clients' case ; which may prevent discrepancies as to dates being overlooked that might give a loophole to the Defendant for establishing a good defence. It may sometimes happen that it is not until the litigant's case is sent to Counsel for the Plaintiff to be drawn and the case is put on paper that certain salient features of the case are appreciated.

(iii) It will be as well, as is usually done, to state positively that the Patent is valid. There is an inconsistency in the decisions

of reported cases as to whether the onus of establishing the validity of the patent is on the Plaintiff or whether the onus to establish its invalidity is on the Defendant. The general practice is for the Plaintiff to give evidence sufficient to establish a *prima facie* case of validity: particularly on the issues of novelty, utility and sufficiency.<sup>1</sup>

(iv) It is then necessary to state the acts which have been done by the defendant such as are complained of as infringements and to state which of the claims of the Plaintiff's Specification are said to be infringed.

#### *English Practice.*

The English practice as to this is, that the necessary particulars are given not in the body of the *Plaint* but in a statement called "*Particulars of Breaches*" which is delivered with it. The practice is specifically laid down in Order 53A Rules 11 & 14 of the Rules of the Supreme Court which read as follow :—

"11. In an action for infringement of a patent the plaintiff must deliver with his statement of claim particulars of the breaches relied upon."

"13. A defendant in an action for infringement of a patent who under section 32 of the principal Act counterclaims in the action for the revocation of the patent shall with his counterclaim deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim."

#### *Indian Practice.*

There is no express provision to this effect in India: there being no rules and orders at all in the Schedule of the Civil Procedure Code specially relating to Patent Suits and no Rules even of the Calcutta, Bombay, or Madras High Courts having any special reference to such suits. On the other hand there is nothing in the Civil Procedure Code or elsewhere which would in any way interfere with this practice being adopted which has been found by experience in England to be useful. In the course of the hearing of one patent appeal in an infringement suit in the appellate bench of the Calcutta High Court, the view has been expressed that it would be convenient

<sup>1</sup> See Fletcher Moulton (1913 : Edn) p. 188 and see note (c) and cases there cited.

if a practice similar to the English Practice were to be adopted in all infringement suits in India.<sup>2</sup> The chief advantage of the practice appears to be that in a suit where many acts of infringement are relied on or the nature of the infringement relates to intricate technical features, these particulars can be set out clearly and at length, if necessary, without encumbering the actual pleadings in the case from which the main points in issue may the more readily be apparent.

In any event whether the English practice is adopted of having separate Particulars of Breaches or what has hitherto been the more usual India practice, it is advisable that proper particulars of the facts indicated above should be stated in the one document or the other.

(v) It is then usual in India, though perhaps not strictly necessary, to state that though demand has been duly made, the defendant has refused to desist from the infringement or to deliver up proper accounts or to deliver over stocks of the offending articles : or whatever may be the position in this respect. It is submitted that no demand is necessary in order to establish the Plaintiff's right to succeed generally if infringement is made out and to his right to a certificate or declaration and to at least nominal damages and costs ; but it is also submitted that if it were the fact that the Plaintiff had gone to Court without giving the Defendant any notice of his complaint as to infringement and the Defendant at the earliest opportunity before the Court expressed his regret for the infringement and his intention not to commit any further infringements after the matter had been brought to his notice, it might be reasonable for the Court not to grant any injunction or at least to refuse the Plaintiff his costs of the suit.

(vi) If a certificate of validity questioned has been obtained in a previous suit, this fact should be pleaded.<sup>3</sup>

(vii) The usual paragraph will then follow as to the Plaintiff's cause of action showing when and how and where it arose, showing

<sup>2</sup> Unreported. See also *Lallubhai Chakubhai v. Chinantal Chumilal & Co.* (1935) 37. Bom. L. R. 665 at p. 668, where the practice of having Particulars of Breaches annexed to the plaint was adopted without question.

<sup>3</sup> See *The Pneumatic Tyre Ltd. v. R. F. Chisholm and Co.* (1896) 13. R. P. C. 488.



that the Court has jurisdiction and showing that the suit is not barred by limitation.

(viii) After this, to conclude the *Plaint*, will follow the prayers, stating the nature of the various reliefs asked for by the *Plaintiff*. Reference may be made as to these matters to Part V below where the final reliefs, which may be obtained in the suit, are discussed in detail.

(ix) The Concise Statement, the List of documents filed with the *Plaint* and the List of documents on which the *Plaintiff* relies will all be drawn in the usual form as for any ordinary suit ; and the verification verified in the same way. The *Plaint* will then be filed in the ordinary way in the offices of the Court, leave to sue being obtained, as already mentioned, if required.

**Whether Plaintiff may give evidence outside his particulars of breaches.**

In the United Kingdom it is provided by Order 53A Rule 19 as follows :—

“At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem fit), be admitted by proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.”

Under Rule 17 of the same Order 53A the Court in the United Kingdom has a wide discretion to allow the amendment of particulars of breaches and this course may be availed of to complete particulars not fully given in the first place. But the final result remains clear—that the *Plaintiff* must before the disposal of the suit give full and definite particulars of whatever breaches he intends to rely on, so that the Defendant knows what case he has to meet. And this principle is firmly maintained in practice in the United Kingdom.

In India there is no positive rule to the effect abovementioned. It would therefore appear that there is no definite provision of law in India which makes it necessary for a *Plaintiff* to give the requisite full particulars in his *Plaint* ; or which will bar him in India, if he pleads infringement merely generally but has not given any proper particulars, and the Defendant chooses not to ask for any particulars,

from giving evidence of such acts of infringement as he may desire to prove at the hearing.

But on general principles a party is entitled to particulars of the case he has to meet, and therefore, if the Defendant makes an application for particulars and it is found that the Plaintiff has not inserted the proper particulars in his Plaint, he will no doubt be ordered to do so under Order 6, Rules 4 & 5 of the Civil Procedure Code eventually ; at the same time having to pay the costs of such application. It is therefore advisable for the Plaintiff in India as in England to give the full particulars in his Plaint in the first place.

Should the Plaintiff not have done so, and should the Defendant make an application for particulars, then if the Plaintiff fails to give the requisite particulars, no doubt the Court even without the aid of any rule in India similar to the English Order 53A, Rule 19, would hold that the Plaintiff would not be entitled to give any evidence of any breaches of which proper particulars had not been given.

## **2. Interim Injunction.**

In many cases it will be of the utmost importance to the Patentee, when he has discovered an infringement, to put a stop to the infringement at the earliest possible moment. In a proper case an injunction may be obtained from the Court, prior to the hearing of the suit, restraining the infringer from committing any infringement pending the hearing of the suit.

The matter is governed generally by the ordinary principles of law relating to the granting of injunctions in general which are contained as regards India in the Civil Procedure Code (Act V of 1908) in Section 94 and in Order 39, Rules 1 to 5 ; but it will be worth while here to consider in some detail the factors arising in patent cases upon which the likelihood of success or failure in obtaining such an interim injunction may depend.

The application for interim injunction may be made as is explained hereafter in a suitable case immediately on filing the Plaint and before even the writ of summons in the suit has been served.

### **Ex parte application.**

The ordinary grant of an injunction which is expressly and directly provided for in the Code of Civil Procedure is contemplated

as being made on motion after notice of motion has been served on the other side. It is clear however from the exceptions referred to in Order 39, Rule 3 of the Civil Procedure Code (and, as to the Calcutta High Court, in Chapter XX Rule, 3 of the Rules of that High Court) that the making of other applications for a temporary injunction to the Court *ex parte* and without notice to the other side is also sanctioned. In practice in cases of infringement of patents, just as in cases of libel, or passing off, or infringement of copyright, or infringement of copyright in a registered design, such *ex parte* applications are common. Indeed it may be said that in the majority of such suits, owing to the urgency of the matter to the Plaintiff, it is found in practice advisable if there be considered to be a fair prospect of success to make the application for the temporary injunction at the earliest possible moment : which entails its being made *ex parte* and without notice to the other side. The considerations mentioned below affecting the matter should however be carefully considered.

#### General considerations as to *ex parte* applications.

In order to support a prayer for an injunction being ordered *ex parte* it is necessary to satisfy the court that the delay caused by proceeding in the ordinary way, that is to say after notice to the other side, would or might (as it is put in Ch. 20, Rule 3 of the Calcutta High Court Rules) "entail irreparable or serious mischief" or would (as it is put in Order 39, Rule 3 of the Civil Procedure Code) "defeat the object of granting the injunction."<sup>4</sup>

The *ex parte* application here referred to can only be made after or at the time of filing the Plaint. It is necessary therefore

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<sup>4</sup> The practice in the Calcutta High Court when it is desired to obtain an *ex parte* injunction is to have the Notice of Motion and the Petition in connection therewith duly prepared and engrossed, the Petition being duly verified by affidavit, and for Counsel to hand these documents himself in to the Court at the time of moving the application ; and for Counsel to make the application in Court at 11 A. M. when the Court sits ; or in cases of extreme urgency at 2. 30 P. M. when the Court takes its seat after the Midday adjournment, or even at 4. 30 P. M. immediately before the rising of the Court. The application is referred to as "an *ex parte* court application". Since an injunction cannot be ordered in Chambers, such an application, even though *ex parte*, cannot be moved in Chambers. See as to the Calcutta High Court, the High Court Rules (3rd Edn. : 1930) Chapter 6, Rule 11 and Rule 12 and the List of matters which may be disposed of in Chambers at p. 758, also Chapter 20, Rule 3.

either that the *Plaint* should have been drawn and filed already in the office of the Court, or that a *Plaint* should be drawn along with the *Notice of Motion and Petition* and then that the *Plaint* should be presented to the Judge in Court with the other documents by Counsel and leave obtained by him to file the *Plaint* then and there before the Judge in Court at the time of making the application for the *ex parte* injunction.

If the temporary injunction thus asked for *ex parte* is granted, the practice is for an order to be made directing the notice of motion to be served on the other side and fixing a certain date as the returnable date of the notice of motion for the hearing of the motion ; and for it to be ordered that the interim *ex parte* injunction is to continue only pending the decision of the motion itself. The period during which the injunction obtained on such an *ex parte* application will continue in force may thus be as little as two days—if an early date is fixed for the hearing of the motion ; in any ordinary case it will not in any event exceed two weeks or thereabouts, being the time taken for the getting of instructions on each side and for the preparing and swearing and delivering of affidavits in connection with the motion. In a case where the Defendant is resident abroad or in some such exceptional case, or, if, as has occurred before now, there is a block in the disposal of the motion list owing to the illness of judges or to an insufficiency of judges on the original side of the High Court or to other exceptional causes, then it may occasionally happen that, the motion not being heard for say two months, the *ex parte* injunction will continue for that period. In the ordinary way the *ex parte* injunction will be effective for a few days only. It is for this reason all the more necessary to consider whether the obtaining of it is of any vital importance. After this the notice of motion with a copy of the grounds (i. e. the *Petition*) is then served on the other side, and the original petition which is filed at the making of the *ex parte* application is used as the *Petition* in support of the motion at the hearing thereof ; the opposite party being at liberty to file an affidavit in opposition to the *Petition* and the Petitioner being at liberty to file an affidavit in reply thereto in the ordinary course.

#### **Delay.**

It would seem that delay on the part of the Plaintiff in coming to Court will be even more fatal to an application by him for an

ex parte injunction than in the case of an application by him for an injunction on motion after notice to the other side. He should apply preferably the very day he hears of the infringement.<sup>5</sup>

**Special considerations as to ex parte applications in Patent Suits.**

There is as yet no settled practice of the Courts in India in regard to the granting or refusing of ex parte interim injunctions in cases where the Patent has not been established. If the English practice is followed in this respect no injunction will be granted ex parte in a case where the Plaintiff's Patent has not been well established, since in England no ex parte injunction is granted unless the Plaintiff's Patent, apart from its age, has actually been validated by a certificate in the Courts.<sup>6</sup>

Where the Plaintiff's Patent has been validated in the Courts (that is by the grant of a certificate of validity questioned) and where it is shown that the matter is one of special urgency by reason of circumstances similar to those in the case of *British Thomson-Houston Co. Ltd. v. Philip Henry & Co. Ltd.*—where the facts established on affidavit were that there was a considerable subterranean trade in the infringing articles imported from abroad by dealers who were men of straw such as the Defendant, and that if the Plaintiffs proceeded by way of serving a writ on the Defendant the result in such cases was that the Defendant either sent the infringing articles away elsewhere or returned them to his foreign principals; so that the infringing articles were again the potential source of infringement in the hands of other people; and the Plaintiff was prevented from having his proper remedies and in particular was deprived of the remedy which he would be entitled to in the action of delivery up of the infringing articles—an interim injunction will be readily granted ex parte.<sup>7</sup>

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<sup>5</sup> See *Greer v. Bristol Tanning Co.* (1885) 2. R. P. C. 268.

<sup>6</sup> See *British-Thomson Houston Coy. Ltd. v. Philip Henry & Coy. Ltd.* (1928) 45. R. C. 218 at p. 220 (C. A.) where it was conceded by Plaintiff's Counsel that the procedure there relied on was not applicable unless the Patent had been validated in the Courts. And see for the general principles of the practice of the English Courts as to interim injunctions in Patent cases the judgments of Atkin L. J. & Scrutton L.J. in *Smith v. Grigg Ltd.* (1924) 41. R.P.C. 149 at 153, 154 & 155.

<sup>7</sup> *British Thomson-Houston Coy. Ltd. v. Philip Henry & Coy. Ltd.* (1928) 45. R. P. C. 218 (C. A.) where an interim ex parte injunction was granted on appeal from a judgment refusing an ex parte injunction. See also *Moser v. Jones & Co.* (1893) 10. R. P. C. 368.

**Leave for short notice of Motion.**

If the court refuses to make any order for an injunction on the ex parte application, then it will in many cases give leave to serve short notice of motion either the next day or for an early date less distant than the 4 days normally required to elapse between service of the notice of motion and the returnable date to be fixed for the hearing of the motion. In many cases the saving of time which can be effected by such short notice is as useful as the obtaining of the ex parte injunction in the first place.

**Ex parte application before filing of Plaint : orally.**

If the matter is of intense urgency, it is submitted that the Court has ample power to grant an ex parte interim injunction on the mere oral application of Counsel ; even before any Plaint has been filed and in the absence of any notice of motion or verified Petition. In such a case it would of course ask for an undertaking from the Solicitor instructing Counsel to file the requisite Plaint within a certain definite time, say by the next day, and also an undertaking by Counsel on behalf of his client as to damages.\*

It appears that such a course has frequently been adopted in the English Courts in urgent cases of libel where it is clear that there has been no time for the usual documents to be drafted and where it may be supposed that delay in granting the injunction will entail irreparable damage to the applicant. Sir Hugh Fraser obtained such an injunction on more than one occasion when appearing as Counsel for the Plaintiff in a libel action. It has to be here stated, though, that there does not appear to be any precedent of such a course ever having been adopted by an Indian Court. In India, unlike England, a power of attorney is required to be filed by the attorney in any suit. If this alone were filed, it is submitted there is no reason why in a proper case an Indian Court should not issue an interim ex parte injunction in the circumstances described.

It may be surmised that in a case of an infringement of a Patent it will only be in a very exceptional case that the circumstances will justify the Court in acting in the absence of any affidavit

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\* i. e. An undertaking to abide by any order the Court may make as to damages, in case the Court should thereafter be of opinion that the Defendant should have sustained any by reason of the granting of the injunction.

and on the mere oral representation of Counsel and before the filing of any Plaint : but it is not impossible to imagine such an exceptional case.<sup>9</sup>

But see what is stated as to the necessity in practice of the Patent having been well-established, before the Court usually, in practice, grants any interim injunction at all. All that is here said must be taken as being subject to that qualification and to the Plaintiff's having a very strong case on the merits.

#### **Application on motion after notice to Defendant.**

Whether the matter has come before the Court before on an *ex parte* application for an injunction as above indicated, or whether the first application is made to the Court on motion after notice to the Defendant, the matter will, if an injunction is desired before the decision of the suit, in either event come up for hearing in Court on motion ; when both sides will be entitled to be represented by Counsel and the evidence for and against the application will be before the Court in the form of affidavits. As the suit itself may take anything from three months to two years to be heard, it may be a matter of some importance to the Plaintiff to obtain an interim injunction on the motion pending the decision in the suit.

#### **Service of the Notice of Motion.**

If the suit is filed in a District Court service of the Notice of Motion must be effected through the Court in which the suit is filed in the same manner as the writ of summons in the suit is required to be served. See Order 48, Rule 2 of the Civil Procedure Code.

If the suit is filed in a High Court the position is different. Under Order 49, Rule 1 of the Civil Procedure Code any service of any Notice of Motion may be effected by the Attorney of the Applicant.

#### **Service of the Notice of Motion by registered post.**

If the suit is being brought in a District Court, leave to

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<sup>9</sup> That the Court may accept undertakings when making *ex parte* orders such as that now under consideration appears from Ch. 20, Rule 2 of the Rules of the Calcutta High Court.

serve the summons by registered post may be obtained by application on a written petition to the judge who will hear the motion.

If the suit is being brought in a High Court, the matter will be regulated by the Rules of the particular High Court in which the suit is being brought. In the Calcutta High Court (see Chapter 8, Rule 24A) leave to serve the Notice of Motion by registered post may be obtained from the Master on application with a formal petition (stamped with a Rs. 12-0-0 stamp). This Petition though it may be verified on information and belief by an Attorney acting for the Plaintiff (the only matter of fact to be verified being the locality of the residence of the Defendant where the notice is proposed to be sent), yet has to be signed by the Plaintiff. Alternatively, if preferred, the leave to serve the summons may be obtained usually, according to the practice of certain Judges, by application made before the Judge who will hear the motion. It is the practice however of other Judges not to entertain the application for the reason that such matters should be disposed of before the Master. It appears that if the application is made to the Judge, it may be made in Chambers<sup>10</sup> either by counsel or by an Attorney, and the practice is that no Petition is necessary and accordingly no stamp fee required to be paid, and that no affidavit either is necessary. It appears from the wording of the Rule that the leave to serve the Notice of Motion by registered post may be obtained also from the Registrar. The Registrar's usual practice is however not to take any but applications which have been listed for disposal before him and to direct that applications of this nature should be made before the Master.

In the Bombay High Court under the practice within Chapter XX of the Rules of that High Court it appears that special leave to serve by registered post is ordinarily obtained by application to a Judge in Chambers : with a formal affidavit as grounds.<sup>11</sup>

**Grounds which should be made out to succeed on an application for an interim injunction.**

It is proposed next to consider the nature of the grounds

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<sup>10</sup> This is clear by the use of the word Judge, and not Court, in Rule 24A of Chapter 8.

<sup>11</sup> As to what is good service of the Notice of Motion by registered post the position is the same as in regard to the writ of summons in the suit when that is served by registered post : see page 706 above.



which should be shown in the Petition filed on the motion, in order to be likely to succeed in obtaining an interim injunction such as will continue pending the hearing of the suit.

**Discretion : dependent on the facts.**

It must be largely a question of fact dependent on the circumstances of every case whether the Court will grant an interim injunction or not, yet as the matter is one in which the discretion of the Court may be expected to be exercised judicially, it becomes of some interest to consider cases where an interim injunction has been refused and cases where it has been granted.

**Plaintiff's patent must be well established.**

It is the practice of the Courts in England not to grant an interim injunction except in cases where the Plaintiff can show either that he has already obtained a certificate of validity questioned or at least that there has been a well established user over several years of his patent. This principle has the double merit of being old-established among the decided cases and of being reasonable. There is no reason to suppose that the Courts in India would adopt any different outlook.<sup>12</sup>

The Court will not normally grant an interim injunction where the Defendant denies the validity of the Plaintiff's patent ; for it is loth to decide the question of validity on the motion for interim injunction ; and without coming to the conclusion that a decision of the question of validity appeared to it to be *prima facie* at any rate favourable to the Plaintiff, it would not consider itself in a position to grant him the interim injunction.<sup>13</sup>

Where a certificate of validity questioned has been obtained the Court will normally grant the interim injunction.

**As to Novelty.**

It appears to be the practice in England for the Plaintiff to

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<sup>12</sup> See *Smith v Grigg Ltd.* (1924) 41. R. P. C. 149 at p. 153 ; *Trautner v. Patmore* (1912) 29. R. P. C. 60 at p. 63. From the various cases cited in *Fletcher-Moulton* in the note at p. 182 where the age of the Patent in each case cited is given, and from the observations in *Terrell* (8th edn.) at p. 382 it would appear that six years is commonly taken as a reasonable age for the Patent in the United Kingdom to show that it is well established.

<sup>13</sup> See *Holophane Ltd., O'Cleary and Davis v. O. Berend and Coy. Ltd.* (1898) 15. R. P. C. 18 at p. 19.

state in his affidavit facts showing that his invention is novel. It might have been expected that once the Plaintiff had shown that he was the patentee, novelty like all other requisites of a valid patent would be presumed in his favour until proof was given to the contrary by the Defendant. The wide nature of the search which is now in every case made at the Patent Office before a patent is granted would also, it might have been expected, be taken into consideration by the Court to support such a view. But for some reason this view does not appear to have found favour in the Courts in England. With the result, as stated, that in England it is commonly considered to be necessary for the Plaintiff on an application for an interim injunction not only to show that he is the Patentee, but also to show that his invention is in fact new. And that being so, it has further become the practice in the United Kingdom that the Plaintiff must show on his affidavit not only that he believed the invention new at the date of the grant of Patent but that he does so at the date of the affidavit ; to ensure that he has not since its grant acquired knowledge of any anticipation of it.<sup>14</sup>

Whether the Courts in India will insist on either or both of these points being positively established by affidavit is difficult to prophecy. Apart from the precedents of previous decisions in England, insistence on the Plaintiff making out these points would, it is submitted be unnecessary. And if he is compelled to establish the requisite of novelty in his patent why is he not to be compelled to establish all the other requisites : such as sufficiency and utility and the rest ? Which he can hardly be expected to do on an application for an interim injunction. Moreover if the Court is averse to trying the question of validity on the motion, why should it enter at all on the question of novelty, which is merely a subsidiary part of that question ?

It is submitted that in India where the Court on this point will be unfettered by any direct previous decisions it may well take the view that provided the Plaintiff shows he is the patentee, it is not necessary for him to show positively on his affidavit in the proceedings for interim injunction that his invention is new.

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<sup>14</sup> For the English practice see *Fletcher Moulton* at p. 182. Citing *Hill v. Thompson* (1817) W. P. C. 229 and *Sturtz v. De La Rue* (1822) 5 Russ 322. See also *Terrell* (8th edn.) p. 382.

### A *prima facie* case of infringement.

It is naturally necessary that in the petition on the motion for the interim injunction the Plaintiff must show at least a *prima facie* case of infringement. It is no doubt preferable that he should show a strong case of infringement; but it has been held that if he shows a *prima facie* case of infringement this will do.<sup>15</sup>

### Necessity for the interim injunction.

No matter how good a case the Plaintiff appears to have for a permanent injunction or damages in the suit, it would seem that the Court will not grant any interim injunction unless some necessity is shown for it. Thus where a sufficient undertaking has already been given by the Defendant, the Court may refuse to grant any interim injunction.<sup>16</sup>

In cases where after the institution of the suit a satisfactory undertaking has been offered by the Defendant but refused, even if the Court grants an interim injunction it may refuse to give the Plaintiff the costs of the motion.<sup>17</sup>

### Delay.

An interim injunction will not be granted where the Plaintiff has delayed unduly. There have been frequent examples of cases where an interim injunction has been refused in the United Kingdom on account of the laches of the Plaintiff.<sup>18</sup>

But for reckoning the period of delay prior to the application it should be shown that the Plaintiff had in fact actual knowledge of the infringement; and it may not be enough to state that because the Defendants had taken out a patent therefore Plaintiff must have known or ought to have known of the position.<sup>19</sup> And though a Plaintiff may have known of the intention of a Defendant to infringe, the Plaintiff will not ordinarily be considered to have

<sup>15</sup> See *Plimpton v Spiller* (1876) 4. Ch. D. 286 C.A.

<sup>16</sup> See *Lyon v Mayor etc. of Newcastle-upon-Tyne* (1894) 11. R. P. C. 218 where the motion was dismissed with costs.

<sup>17</sup> See *Perry v. Societe des Lunetiers* (1896) 13. R. P. C. 664 at p. 672; *Dunlop Pneumatic Tyre Co. Ltd. v. Stone* (1897) 14. R. P. C. 263; *Spaul v. Monopole Co.* (1906) 23 R. P. C. 647.

<sup>18</sup> See *Fletcher Moullon* p. 183.

<sup>19</sup> See *Osmond v. Hirst* (1885) 2. R. P. C. 265.

delayed in respect of any period prior to the date when infringement was actually perpetrated.<sup>20</sup>

Where there have been a number of infringements it will not ordinarily be held that any delay of the Plaintiff in proceeding with one case is justified by his proceeding with another case and awaiting its results. On the contrary the proper course of a Plaintiff in such a case, if he has not established his patent is to write to each infringer asking if they will agree to abide by the decision in the first case as a decision in their case; and if they do not agree then to institute suits against each of them without delay.<sup>21</sup>

On the other hand it is no reason for refusing to grant an interim injunction that the Plaintiff has been guilty of laches in other cases in not taking proceedings (criminal or civil) against other infringers.<sup>22</sup>

As an exception to what has been stated above that no delay will be considered against the Plaintiff prior to actual infringement, it may be that in a special case where the Plaintiff has stood by and allowed the Defendant to build special factories, such conduct may be considered by the Court sufficient reason to refuse to grant an interim injunction.<sup>23</sup>

Where there has been a change of ownership of the Patent, it has been suggested that laches may be counted "against the owners irrespective of the change of ownership": that is to say against the Plaintiff even though it was not he but his predecessors who were guilty of the delay.<sup>24</sup>

#### Balance of convenience.

It has been stated that in England possible inconvenience will not prevent the Court granting an interim injunction when the Plaintiff's patent is well established.<sup>25</sup>

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<sup>20</sup> See *United Telephone Co. v. Equitable Telephone Association* (1888) 5 R. P. C. 233.

<sup>21</sup> See *Bovill v. Crate* (1865) L. R. 1. Eq. 388; *North British Rubber Co. v. Gormully & Jeffery Mnf. Co.* (1894) 12. R.P.C. 17; *Aktiengesellschaft fur Cartonagen Industrie v. Temler* (1899) 16 R.P.C. 447; also *Fletcher Moulton* p. 183.

<sup>22</sup> See *Pneumatic Tyre Co. Ltd. v. Warrilow* (1896) 13 R.P.C. 284.

<sup>23</sup> See *Fletcher Moulton* at p. 183 citing *Neilson v. Thompson* (1841) W. P. C. 225.

<sup>24</sup> See *Fletcher Moulton* p. 163.

<sup>25</sup> See *Fletcher Moulton* p. 184 citing *Davenport v. Jepson* (1862) 4 De G. J. & F. 440.

It is clear that even in England the Court may consider the balance of convenience in borderline cases : and may thus consider that if the Defendant will in all probability be able to pay damages should he lose the suit, it may be more convenient not to grant an interim injunction.<sup>26</sup>

It is submitted that in India the Court should in all cases consider the balance of convenience : though having regard to the fact that even if the Defendant does in the end pay full damages, this may not be the best remedy for the Plaintiff and that the capacity of the Defendant to pay damages may be no reason for denying an interim injunction to the Plaintiff in a proper case.

### **Conduct and position of the parties.**

The Court is also entitled in exercising its discretion to take into account the conduct and position of the parties. Certain examples of cases where such special factors have been taken into consideration, are referred to in *Fletcher Moulton* at p. 144, note (g).

### **Estoppel.**

The question of estoppel may arise in connection with the application for an interim injunction in two different quarters.

In one class of case it may be shown that the Defendant by reason of his being a licensee, or assignee, or by reason of his conduct in some other respect, is estopped from disputing the validity of the Plaintiff's patent. The consequence of such an estoppel is then merely that the validity of the patent as between the parties and in the particular suit in which the application for interim injunction is being made is taken as established. And provided the Plaintiff satisfies the other necessary requirements, the interim injunction asked for by him will be granted.<sup>27</sup>

In another class of case it may be shown that the Plaintiff is estopped by reason of his conduct or by reason of a decision in previous litigation from making any claim against the Defendant

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<sup>26</sup> See *Fletcher Moulton* p. 184 citing *Newall v. Wilson* (1852) 2 De G.M. & G. 282 ; *Bracher v. Bracher Dean & Co.* (1890) 7 R.P.O. 420.

<sup>27</sup> See *Edmunds* pp. 269-272 ; *Fletcher Moulton* p. 244, p. 8.

for infringement. The consequence of such an estoppel is then that the injunction asked for must inevitably be refused.

It may be noted that mere delay to enforce a legal right is no bar to an action unless the delay is such as to cause a statutory bar ;<sup>28</sup> or unless, it is submitted, the delay is coupled with such other circumstances, such as misrepresentation by the Plaintiff and alteration of position by the Defendant, as to amount by reason of such other circumstances to an estoppel.

For the purpose of preventing the grant of the interim injunction at the stage when the motion only and not the suit is before the Court, it will not be necessary for the Defendant to show a complete estoppel against the Plaintiff since mere acquiescence by the Plaintiff short of estoppel may be enough to prevent the Court from granting the interim injunction.

#### **Acquiescence.**

An interlocutory injunction may be refused if there has been on the part of the Plaintiff acquiescence in the wrong of which he complains. Cases of acquiescence may arise which cannot be put on the ground of delay : the delay being only reckoned after actual infringement while the acquiescence may consist of conduct on the part of the Plaintiff prior to infringement : or complete acquiescence may have been shown in a short space of time. Cases of acquiescence may also arise differing from cases of estoppel proper for other reasons : thus in a case of estoppel the Plaintiff would find himself estopped from obtaining either a permanent or an interim injunction : while a degree of acquiescence which might not debar a Plaintiff from obtaining a perpetual injunction at the trial might yet be fatal to his obtaining an interim injunction on the interlocutory proceedings.<sup>29</sup>

#### **Interim injunction before actual infringement. Threatened infringement.**

In some cases in practice the question may arise whether the Plaintiff is entitled to an injunction where the infringement is imminent but has not as yet been perpetrated. It is true that owing

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<sup>28</sup> See *Three Town Banking Co. v. Maddever* (1884) 27 Ch. D. 523 at p. 530.

<sup>29</sup> See *Edmunds* p. 275 citing *Neilson v. Thompson* (1841) 1 Web. P.C. 278 as the leading case on acquiescence. Also see *Fullwood v. Fullwood* (1878) 9 Ch. D. 176 ; cf. *Proctor v. Bennis* (1887) 36 Ch. D. 740 at p. 758.

to the wide interpretation given to the term "uses the invention" (in Section 29 of the Indian Act of 1911) many acts are found to be in law actual infringements which fall short of a sale. Thus there is no question about importation even without sale : this is user within Section 29 and therefore amounts to actual infringement. For this reason cases of intended infringement do not arise in practice as often as might at first sight be expected. It is however submitted, that on the general principles governing the issue of injunctions, a Plaintiff is fully entitled to an injunction even without proving actual infringement where the Defendant shows an intention to infringe and claims a right to do an act which will be an infringement and where it is plain that what is threatened to be done would, if done, constitute an infringement.<sup>30</sup> And it is submitted that this principle is equally applicable to a grant of an interim injunction on the motion proceedings as to the grant of a permanent injunction in the suit.

#### Undertaking as to damages.

In all cases where an interim injunction is granted it is usual for the Plaintiff to give an undertaking as to damages : that is to say that the Plaintiff will make good to the Defendant any damages which the Defendant may suffer by reason of the injunction having been issued, if it be shown thereafter that the interim injunction ought not to have been granted. In such an event an enquiry as to the amount of such damages may be ordered at a later stage.<sup>31</sup>

#### Other terms.

The Court may in a proper case impose other terms also upon the Plaintiff : such as an undertaking to supply the Defendant with all goods required by him during the continuance of the interim injunction as was done in the *United Telephone Co. v. Tasker* (1888) 5 R.P.C. 628 : or as to payment into Court of profits.<sup>32</sup>

<sup>30</sup> See *Frearson v. Loe* (1878) 9 Ch. D. 48 at p. 65 per Jessel M. R.

<sup>31</sup> See *Rothwell v. King* (1887) 4. R.P.C. 76.

<sup>32</sup> See *Fletcher Moulton* p. 185 citing *Neilson's Patent* (1841) W.P.C. 273, 286 : and see *Briggs & Co. v. Lardeur* (1884) 1 R.P.C. 192 (C.A.) ; *Edison Bell Phonograph Corp'n. Ltd. v. Hough* (1894) 11 R.P.C. 594 ; *North British Rubber Co. v. Gormully & Jeffreys* (1894) 12 R. P. C. 21 ; *Pneumatic Tyre Co. Ltd. v. Goodman & Son.* (1896) 13 R. P. C. 723 at p. 724 ; *Spencer v. Holt* (1903) 20 R.P.C. 142.

**Alternative order : undertaking by Defendant to keep accounts.**

The motion for the interim injunction is in very many cases disposed of by a compromise ; the Defendant undertaking to keep accounts of the sales of the articles complained of. In such event the order which is passed with the consent of both parties is merely to this effect :—

“on the Defendant’s undertaking to keep accounts of the sales of the articles complained of in the Plaint, no order is made on the motion except that the costs of the motion shall be costs in the cause.”

Such an order by enabling profits or damages to be reckoned without further trouble or expense will meet the case in many instances. Where there turns out to be any real dispute about the merits of the suit this is often the utmost that a Plaintiff may expect to obtain as a result of the application for an interim injunction.

**Costs.**

It is seldom if ever that the Plaintiff will be given the costs of the motion then and there. Though it is possible to imagine a case where the circumstances will be such as to lead the Court to make such an order.<sup>33</sup>

If the Plaintiff is successful on the motion, the usual order is for the costs of the motion to be costs in the cause.

If the interim injunction is refused, the motion may be dismissed with costs (which means that the Plaintiff pays the costs of the Defendant in respect of the motion in any event whatever be the result of the suit). This is usually done if the reason for the refusal is conclusive and independent of the question to be tried in the suit ; as for the delay of the Plaintiff. Or the motion may be dismissed without any order as to costs (which means that each party pays its own costs of the motion in any event). This is sometimes done where the matter is a borderline case ; or where there is a good deal to be said for both sides. Or the costs of the motion may be ordered to be costs in the cause. This is often done where there appear to be substantial questions in issue in the suit ; and

<sup>33</sup> This appears to have been done in *Hayward v. Pavement Light Co.* (1884) 1 R.P.C. 207.



when the interim injunction is refused for that reason. In exceptional cases the costs of the motion may be reserved.

### **Compromise of the suit with the motion.**

It often happens, the whole dispute between the parties having been agitated in the pleadings of the suit and during the course of the preparation of the affidavits for the motion, that the parties in process of coming to terms on the motion have for all practical purposes disposed also of all the questions which will arise in the suit. In such a case it is possible to anticipate the ordinary procedure and to settle the suit at the same time as the motion. On the motion being called on in Court the matter is mentioned to the Court. The sanction of the Court is obtained to settle the suit with the motion. The Judge then gives directions to the Court Officer to treat the suit as placed in the list of suits to be heard that day. And the terms of settlement are either put in in writing signed by Counsel on both sides (which is usually the more satisfactory method) or orally stated by Counsel to the Court and recorded by the Court Officer in the minutes of the Court. And the Judge then and there passes a consent decree in the suit and motion in accordance with the terms of settlement.

### **3. Appearance in the suit.**

The procedure required to be followed by the Defendant in order to make an appearance in the suit is regulated, if the suit is being brought in a District Court, by Order 9 (Rule 1 and the following rules) of the Civil Procedure Code. Thereby the Defendant is required to appear in Court either in person or by his pleader (duly instructed) when the suit is called on for hearing. There is no provision for his appearance being entered in writing before that, as in a High Court.

If the suit is being brought in a High Court the matter is further regulated by the Rules of the particular High Court. In Calcutta it is provided in particular by Rule 15 of Chapter VIII of the Rules of the Calcutta High Court that a Defendant shall enter appearance on certain specified Forms which he may file with an officer of the Court at any time before the final date fixed, the wording of the Rule being as follows :—

“15. A defendant shall enter his appearance to a writ of

summons by filing with the proper officer in the office of the Registrar, on or before the day fixed for his appearance in the writ, a memorandum in writing dated on the day of its delivery and containing the name and place of business of the defendant's attorney, or stating that the defendant defends in person and containing his name and place of residence. (Forms Nos. 4 and 5)."

Other matters concerning the entering of appearance and the effect thereof and the effect of failure to do so within the time allowed are also regulated in Chapter VIII of the Rules of that High Court.

In Bombay the procedure which must be followed by the Defendant in order to enter appearance in the suit is laid down in Chapter VII of the Rules of that High Court, in particular under Rule 117 as follows :—

"117. The defendant shall, on or before the day fixed in the writ of summons for the filing of his written statement, if such be called for, or otherwise before the date fixed for his appearance, file with the Prothonotary and Senior Master an appearance; in default of this the suit will be set down as undefended. Should the defendant then appear and desire to defend, the suit shall be subject to transfer to the defended list, or to postponement, with costs not exceeding Rs. 50/- to be paid by such defendant to the plaintiff."

#### 4. The remaining pleadings—The Written Statement.

If the suit is being brought in a District Court the procedure relating to the filing of the Written Statement is regulated by the Civil Procedure Code only. Unless ordered to do so, there is no provision in the Code making it incumbent on the Defendant to file a Written Statement: accordingly unless he has been ordered by the Court to file a Written Statement, no consequences follow on his not doing so. In the absence of a special order there is no time within which any written statement, if filed, is required to be filed. Order 8, Rule 1 of the Civil Procedure Code being merely as follows :—

"1. The defendant may, and, if so required by the Court,

shall, at or before the first hearing or within such time as the Court may permit, present a written statement of his defence."

But under Rule 9 of Order 8 the Court may at any time require a written statement from the Defendant and fix a time for presenting the same.

The common practice is for the writ of summons to be issued as a summons calling on the Defendant to appear "for settlement of issues" only (except in simple cases)<sup>34</sup>. A date is inserted in the writ of summons which will give the Defendant time to appear on the date stated for this purpose. The Judge then on that date orders a written statement to be filed and fixes a date for that purpose. The practical result is that the Writ of Summons in suits filed in a District Court is in effect a summons to appear for directions. If there has been an order made for the Defendant to file a Written Statement by a fixed time, then Rule 10 comes into operation which is as follows :—

"10. Where any party from whom a written statement is so required fails to present the same within the time fixed by the Court, the Court may pronounce judgment against him, or make such order in relation to the suit as it thinks fit."

If the suit is being brought in a High Court, then the procedure required to be followed by a Defendant in regard to the filing of his written statement is regulated by the Rules of the particular High Court in which the suit is filed.

In the Calcutta High Court if the suit is an ordinary suit and not marked as a commercial cause, the time for filing the written statement is the time stated in the writ of summons to be calculated from the date of service thereof. The period of time which is in practice allowed varies according to the distance of the place where the writ of summons is to be served. The form of the writ of summons in use in the High Court of Calcutta is shown in the Rules and Orders of the Calcutta High Court (3rd edn.) at p. 513 ; which will be seen to contain a marginal note as follows :—

"The defendant (name) (is) required by the Court to file (his)

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<sup>34</sup> See *Civil Procedure Code Order 5, Rules 5 & 6.*

written statement within (blank) days from the service upon (him) of his writ."

It will also be seen to contain at the end a note to the following effect:—

"Note 2. The written statement called for must be filed within the time limited, the defendant having first entered an appearance. In default thereof, the suit will be liable to be heard *ex parte*."

The actual period of time allowed and notified in the writ of summons for filing the written statement according to the practice of the Calcutta High Court varies in different classes of case from 14 days to 63 days. By Chapter VII, Rule 4 of the Rules of that High Court it is provided to the effect that the Registrar may fix the time having regard to the residence of the defendant or defendants as given in the plaint. Actually a table of times has been framed by the Registrar which is shown on page 199 of the Rules & Orders of the Calcutta High Court (3rd edn.): to which reference may be made as necessary. If the Defendant has not filed his Written Statement within the time allowed him, the Plaintiff may make an application to the Judge in chambers for an order that the suit shall be transferred to the peremptory list of undefended suits: under Rule 3 of Chapter IX of the Rules of that High Court.

If the suit having been filed in the Calcutta High Court is marked as a Commercial Cause, the period in which the Defendant is required to file his written statement reckoning from the date of service of the summons is 14 days in every case; and notification of this is given in the writ of summons (see note in Rules & Orders (3rd edn.) page 198). If 21 days have elapsed after appearance has been entered and no written statement has been filed in a commercial suit, the suit is listed in the List of Suits for Directions and comes up in Chambers before the Judge for directions to be given. On that occasion both parties may be represented in Court, usually by their Attorneys; and among other necessary directions the Judge will usually fix a period within which the written statement is to be filed; and may in a proper case order that in default of its being so filed within the time ordered the suit is to be transferred to the undefended list. If the Defendant has reason to want a specially long period in which to file his written statement, either for the

reason that his Client is abroad or any other reason, he may inform the Judge on that occasion and if the Judge thinks fit the Judge will direct a specially long period for that purpose.

In a Commercial Suit if the time ordered for filing the written statement has elapsed and it has not been filed, the Plaintiff may apply to have the suit placed again in the list for directions and then apply for having it transferred to the undefended list.

Whether the suit has been marked as a commercial suit or is being heard as an ordinary suit, if the defendant has good reason to be unable to file his written statement within the proper time, his attorney may write to the Plaintiff's attorney and explain the position and ask him to agree not to take any steps for compelling the filing of the written statement or for having the suit placed on the undefended list. In any genuine case there will be no point in the Attorney for the Plaintiff refusing to agree to this. Such an arrangement is commonly come to for mutual convenience for the purpose of saving the costs of an unnecessary application on one side or the other.

In the case of a suit filed in the Bombay High Court, the time allowed to the Defendant to file his written statement is similarly fixed in the Writ of Summons as mentioned in Rule 114 of that High Court which is as follows :—

"114. When a written statement shall be called for by the Judge from a defendant in the first instance notice to that effect shall be given in the margin of the writ of summons calling on the defendant within four weeks from the service thereof (unless the Judge shall otherwise order) to file his written statement and serve a copy thereof on the plaintiff or his Attorney".

If the suit is in the Bombay High Court transferred to a list of Commercial Suits, the time for the delivery of points of defence (which in a commercial suit there takes the place of a Written Statement) will be fixed by the Judge at the time the suit comes up for directions : under Rule 203 of that High Court.

### **Contents of the Written Statement.**

*As to defences :—*

The various defences which may be open to a defendant in a suit for infringement have been previously sufficiently discussed in

Chapters XIV, XV & XVI and it is not necessary here to go into them in detail.

*As to particulars of objections :—*

The position in India as to whether or not the practice of delivering with the written statement a separate statement entitled "Particulars of Objections", which is the normal English practice in patent cases, should be adopted or not, stands on the same footing as the similar question already discussed in regard to Particulars of Breaches in connection with the Plaintiff.

It is submitted that it would be convenient if this procedure were to be universally adopted in patent suits in India and there is nothing in the Civil Procedure Code which militates against it.

In any event the Defendant should give full and proper particulars of objections either in the form of Particulars of Objections or in the Plaintiff itself from which the Plaintiff may know precisely what case of invalidity he will be called upon to meet.

*As to a counter-claim for revocation in the Written Statement :—*

In view of the provisions of Section 29(2) of the Indian Act of 1911 to the effect that "every ground on which a patent may be revoked under this Act shall be available by way of defence to a suit for infringement" it is abundantly clear that the question of the validity or invalidity of the Plaintiff's patent may be made a direct issue in the infringement suit. This will be so no matter whether the suit is being heard in a District Court or a High Court.

Since an infringement suit may be heard by any District Court while a petition for revocation can only be heard by a High Court (contrast Section 29(1) with Section 26(1) of the Indian Act), it is clear that there could be no counter-claim for revocation of the Plaintiff's patent in a written statement of a suit for infringement being heard by a District Court which was not a High Court.

The question arises whether in an infringement suit filed by a Plaintiff in a High Court it will be open to the Defendant not merely to take by way of defence the plea that the Plaintiff's Patent is invalid, but, on the basis of such a plea of invalidity, to counter-claim for an order for revocation of the Patent in the suit.

It should be noted that while cases in which a Defendant has successfully counter-claimed for an order for revocation in an infringement suit are common in England, such right so to counter-claim for revocation is given to the Defendant under Section 32 of the English Patents & Designs Act; and arises solely out of that section. That this is so was clearly stated by Atkin L. J. (as he then was) in *British Thomson-Houston Co. Ltd. v. British Insulated Helsby Cables Ltd.*<sup>35</sup>

There is no corresponding section in the Indian Patents & Designs Act of 1911 or any section in the Indian Act which refers at all to such a counterclaim for revocation.

Moreover the Civil Procedure Code by which the general procedure in civil suits throughout British India is regulated, does not provide for or at all contemplate any such counterclaim being made in any civil suit. It is for this reason that in India the common practice, where the Defendant has a cross-claim against the Plaintiff, is for a cross suit to be filed. Where convenient, such cross suits being consolidated, or the evidence in one being treated as evidence in the other. It would seem probable that any reference to a counter-claim was purposely omitted by the framers of the Indian Act to prevent disconformity with the general practice and rules of procedure in civil suits in India.

This view acquires added weight when it is noted that the Section in the English Patents and Designs Act which creates the right to counterclaim for revocation only gives the Defendant in England the right to "apply in accordance with the (English) rules of the (English) Supreme Court by way of counter-claim." It would be natural therefore for the framers of the Act in India, where counterclaims do not ordinarily exist, to refrain from creating in this unique instance under the Indian Patents and Designs Act any special right to counterclaim for revocation. Particularly does this seem likely to be so also, when it is also remembered that an order for revocation, if obtained, amounts to a judgment *in rem* which will create rights against all the world and not merely between the Defendant and the Plaintiff.

In view of these considerations it is submitted that it is clear that in British India it is not open to a Defendant in his Written

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<sup>35</sup> (1924) 41. R. P. C. 345 at p. 415 and see p. 454 above.

Statement to counter-claim for an order for revocation ; and that a Court in British India in a suit for the infringement of a Patent has no power to make an order in favour of a Defendant for the revocation of the Plaintiff's Patent.

There appears to have been no direct decision in any Indian case on the point. It is true that in a very recent case in the Patna High Court heard before Sir Courtney Terrell C. J. and Jwala Prosad J., such an order for the revocation of the Plaintiff's Patent was made, no doubt following the English practice with which the learned Chief Justice would naturally be familiar. And it is true that the decision of the Patna High Court was subsequently confirmed on appeal before their Lordships of the Privy Council. But it seems that at no stage of the case was any objection made to the counterclaim by the Defendant for revocation and at no stage was the point whether it was open under the Indian Patents & Designs Act for such an order to be made, argued or even referred to. It is submitted therefore that the formal confirmation by their Lordships of the Privy Council of the order for revocation as an incidental part of the judgment of the Patna High Court, against which the appeal came up for their consideration and decision on completely different points, cannot be taken as any decision of the point now under consideration : since this point was actually never raised or argued or even referred to before their Lordships of the Privy Council.

#### **Written Statement by Plaintiff in Reply.**

Unless the Defendant takes the point in his written statement that the Plaintiff's Patent is invalid, no question of a reply on the part of the Plaintiff will probably arise.

If the Defendant does raise the plea of invalidity, it may be advisable for the Plaintiff to file a reply in the form of a Plaintiff's Written Statement.

#### **5. Further and better particulars.**

If either the Plaintiff or the Defendant fails to give sufficient and proper particulars in his pleading, the other party may, as in any ordinary suit, make an application for further and better particulars. The proper practice is for the Attorney of the party



desiring such further particulars first to write a letter demanding that they be furnished and stating clearly and concisely in numbered paragraphs precisely the nature of the different particulars required. If the other party in fact has not furnished sufficiently complete particulars in his pleading, or even if there be room for any doubt upon the question whether the first party is entitled to the particulars or not, in most cases, unless there is some good objection, the party asked will be well advised to furnish the required particulars at once by letter. Otherwise, in some cases, especially where the two cases of the two parties consist of conflicting allegations of fact, if it can be said at the hearing that the one party, though asked at an early stage for particulars about his case, was unable to give any, this may be used in argument against the credibility of his case. In any event by furnishing the particulars thus by letter, the party avoids all risk of being ordered to pay for the costs of an application which the other party would otherwise find it necessary to make ; and which if particulars were ordered, would in most cases be ordered to be paid by the party then ordered to furnish them : more especially if he had previously refused to do so by letter. Since the costs of such an application may well amount to about Rs. 500, this may be an appreciable point to be considered.

#### **6. Notice to admit facts and documents : an admitted Brief of Correspondence.**

A Notice to Admit Documents or a Notice to Admit Facts or both may be sent by letter to the other side in a Patent suit just as in any other suit : the procedure as to this being that laid down in Rules 2-5 of Order 12 of the Civil Procedure Code. It is to some a matter of regret that the Courts in India do not more often penalise a party in costs who has protracted a hearing by reason of his failure to admit clear facts when called upon by such a notice. There is no doubt that the hearing of many suits might be considerably shortened and the costs to the litigants thereby diminished if this power was more widely used.

In every patent suit, if possible, arrangements should be made between the Attorneys on both sides so that a Brief of Correspondence containing copies of every material document which may be required at the hearing by both sides or either of them, should be prepared, and that the documents of which copies are contained in such Brief

of Correspondence should have been admitted between the parties before the hearing. Failure to agree such a Brief of Correspondence causes much unnecessary inconvenience to all parties and to the learned judge hearing the case, and loss of time and consequently increased costs.

In any event the lack of any collected typed brief of correspondence to which the judge can refer without interruption, while original letters or papers may be being handed to the witness for perusal or proof or to the court clerk for being marked as an exhibit or otherwise handed about and confused in order, must be so great an inconvenience for the learned Judge as appreciably to increase for him the difficulty of adjudicating in any case where such a brief is not afforded for his use. If the other side therefore should refuse or fail to consent to the use of a proper or complete brief of correspondence as an agreed and admitted brief, it will in all cases be advisable for the Plaintiff to collect in one brief, arranged in proper chronological order, copies of all documents upon which he at least wishes to rely for his part and which he intends to prove at the hearing; this brief may then be handed to the Judge at the beginning of the hearing, it being understood that none of the documents of which copies are contained in the brief can be used as evidence until proved or specifically admitted. The documents proved may be noted with their exhibit number as proved. By the end of the hearing at least in this way it will be ensured that the Judge will have for his own use an orderly brief containing copies of all such documents as will by then have been proved and exhibited.

## **7. Amendment of Pleadings.**

Circumstances may arise before or at the hearing which will induce one side or the other to make an application to amend its pleadings. It is unnecessary in the main here to say more than that all matters arising in connection with such an application to amend pleadings in a suit for infringement of patent are dealt with in the same manner and under the same rules of procedure as in any other suit.

## **Appeal.**

An order of a Judge granting or refusing an amendment of pleadings ordinarily is not appealable as a judgment under Clause 15

of the Letters Patent of the Calcutta, Bombay or Madras High Courts of 1865. Nor is it appealable under Section 104 or Order 43 of the Civil Procedure Code. Thus it is not appealable at all. Save possibly in an exceptional instance where it might be shown to be of so far-reaching and final a character as to amount to a judgment under Clause 15.

### **Amendment of particulars of breaches or of particulars of objections.**

This is in effect an amendment of the pleadings in the suit. It is therefore clear that an amendment of such particulars should only be feasible with leave of the Court : on application in the same way as by application to amend pleadings. To take any other view might mean that a party might be completely taken by surprise and might mean giving the amending party the power to set up an entirely new case as of right.

Under Order 53A, Rule 17 of the English rules it is expressly provided as follows :—

“Particulars of breaches and particulars of objections may from time to time be amended by leave of the Court upon such terms as may be just.”

For the English practice in regard to amendments under that Rule, reference may be made to Terrell (8th Edn.) p. 410. There is no such express provision in India, but as there is also no general provision at all for particulars of breaches or particulars of objections, these it is submitted, if filed with the Plaint for convenience as a separate statement, will nevertheless need to be treated when a question of amendment arises, as a part of the pleading itself.

*N. B. As to amendment of the Specification :—Instances will frequently occur in Patent suits, where the patentee may desire to effect an amendment of his specification, it may be so as to eliminate some objection of invalidity, after the suit has been filed. This matter, which of course has no direct connection with the question of amendment of the pleadings in the suit, has been already sufficiently dealt with in Chapter XII.<sup>30</sup>*

<sup>30</sup> See pages 490 and 494.

### 8. Obtaining directions : generally.

The inherent nature of a patent suit makes it desirable that the parties should be able to obtain special directions relating to the mode and conduct of the hearing. Certain directions which may be obtained even in ordinary suits are found even more requisite in patent suits : while it has been found by experience that certain other directions which go beyond any directions which may be had or are desirable in ordinary suits may be requisite for the proper and expeditious hearing of a Patent suit.

It is no doubt owing to the urgent necessity in practice of having available an effective system of enabling such special directions to be given, that Order 53A, Rule 21A, of the Rules of the Supreme Court in England has been framed in the cogent and comprehensive terms in which it now exists. That is as follows :—

- “(1) The Plaintiff in an action for infringement of a patent so soon as he becomes entitled to give notice of trial shall, and the defendant in such an action if the plaintiff makes default under this Rule for fourteen days may, apply under Rule 1 (c) or Rule 5 of Order XXX for directions as to the mode of trial. Such application may be dealt with in chambers or in Court as the Judge shall think fit. Upon any such application such directions for the delivery of further pleadings or particulars, or statements in the nature of further pleadings or particulars, and for the making of experiments, tests, or inspections for the purposes of the trial and for obtaining reports and for the hearing of any preliminary question that may arise and otherwise may be given as the Court or the Judge shall think necessary or expedient for the purposes of (a) determining any question of construction which may arise on the specification, (b) defining limiting or directing the issues of fact to be tried, (c) restricting the number of witnesses to be called at the trial on any particular issue, and (d) otherwise

securing that the trial shall be conducted consistently with adequate hearing in the most expeditious manner. No action for infringement of a patent shall be set down for trial unless and until an application under this Rule has been made and disposed of".

The Rule is within the powers given under Section 34 of the English Patents and Designs Act 1907-1932, the material parts of which for present purposes are as follows :—

"In an action for infringement of a patent, . . . . . the Court may on the application of either party . . . . . make such order for an inspection and impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit".

Powers equally as wide as those of the English Section 34 are expressly given to the Court in India under Section 31 of the Indian Act of 1911 which reads as follows :—

"31. In a suit for infringement of a patent, the Court may, on the application of either party, make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit."

There is however no specific rule similar to the English Rule (Order 53A, R. 21A) above quoted laying down any procedure by which the directions referred to in Section 31 are to be obtained.<sup>37</sup>

In many cases it will be found to be only by the giving of special directions possible to effect an expeditious hearing; and to prevent a protracted inquiry into all sorts of unnecessary questions

<sup>37</sup> It is submitted that it would not only clear up any possible ambiguity as to the extent of the Court's powers in India to give directions of the special nature usually given in Patent suits in England if a rule similar to the English Rule 21A were formulated either as an addition to the Code of Civil Procedure or as an addition to the Rules of the Calcutta, Bombay, and Madras High Courts respectively, but by making it compulsory to obtain directions, this would also assist considerably towards the elimination of a considerable portion of the excessive delay and high costs which will be almost inevitable if Patent suits are allowed to come up for hearing in India without the question of directions having been considered beforehand.

with ramifications into multifarious unnecessary matters at the time of the actual hearing.

Under present procedure in India there is no provision for the case to come up for directions before the hearing, unless the suit is being brought in a High Court and has been marked as a Commercial Cause under the Rules of the High Court.<sup>38</sup>

It appears clear however from the wide terms of Section 31 of the Indian Act, that, even in suits instituted in District Courts and in suits in a High Court not specially marked as Commercial causes, any requisite directions of the nature of those hereafter considered may be obtained by making an application in Chambers; and that the Court under Section 31 has ample power to give such directions when asked to do so.

It is proposed next to consider the nature of various directions which it may be advisable in certain cases for the parties to obtain in a Patent suit. Many of such directions could be obtained at one and the same time on a single chamber application, in order to save costs, (reasonable forethought being exercised sufficiently early before the hearing of the suit as to what directions would be actually required). For the sake of convenience of reference only however each of the various directions discussed are here dealt with separately, as if a single direction only were required, in a separate single application.

#### 9. Application for discovery and inspection of documents.

If the suit is brought in a District Court other than a High Court, the matter of discovery and inspection of documents is regulated by the general rules contained in the Civil Procedure Code Order 11, Rules 12 & 13. If an affidavit of documents is required from the other side it is then necessary in every case for an application to be made to the Court for the requisite order. Without a special order there will then be no discovery or inspection of documents.

If the suit is brought in a High Court, the position is the same unless the suit has been marked as a Commercial Cause.

If the suit is brought in a High Court and has been marked as a Commercial Cause then the matter is further regulated by the Rules

<sup>38</sup> See further below.

for Commercial Suits in the particular High Court in which the suit has been filed.

In the Calcutta High Court in every case which is marked as a "Commercial Suit" an affidavit of documents is required to be furnished by each side as a matter of course, without any special order, within 14 days from the written statement : under Chap. XII Rule 2c of the Rules and Orders of that High Court which is as follows :—

"In all commercial suits affidavits of documents shall be filed by all the parties within 14 days from the filing of their respective Written Statements and in the case of the Plaintiff, from the filing of the first Written Statement."

In the Bombay High Court while there are no mandatory provisions in the rules which make it compulsory for the parties on each side to file an affidavit of documents, the provisions contained in Chapter XII of the Rules and in particular in Rule 203 give convenient power for all necessary orders for lists of documents and inspection to be passed by the Court at the time when the suit comes up for directions on the application for transfer of the suit to the list of commercial causes.

### **Peculiar importance of the matter in Patent suits.**

In a patent suit it may be of more than ordinary importance to success in the suit to obtain discovery and inspection of important documents and accounts of the other party. On the other hand in a Patent suit also it will be equally true from the inherent nature of such a suit, that being compelled prematurely or unnecessarily to give discovery and inspection to a competitor in business may cause more than ordinary loss and damage. The question whether in a particular case discovery and inspection of certain accounts or documents should be compelled or refused, assumes therefore in Patent suits more than ordinary importance.

### **Time for discovery.**

It is no doubt for this reason that a practice has grown up in England in patent cases for discovery of documents relating to infringements in general to be postponed until after the Plaintiff has obtained a decree and the question of account of profits or damages has to be gone into. Discovery of such documents however

as relate to the specific infringements referred to in the Plaintiff's particulars of breaches are required to be disclosed before the hearing in the ordinary manner for documents relevant to the suit.

It is not usual for any order for discovery, that is for the filing of an affidavit of documents, to be made until after the Written Statement has been filed and the pleadings completed, so that it will have become apparent what are the issues in the suit. Until then it will not be wholly possible for either party, who will file the affidavit, to be in a position to say what documents are and what are not relevant. For this reason, where either party wishes to allege a fact particulars of which are known to the other side and not to him, as when a plaintiff wishes to allege various acts of infringement of which he does not know full particulars, or a Defendant wishes to allege prior user by the Plaintiff himself of which he does not know full particulars, the party must plead the fact generally and state that he will give further particulars after discovery.

**What documents are to be disclosed in the affidavit of documents.**

Although the broad issue of the infringement of the Plaintiff's patent may be put generally in issue on the pleadings, the Plaintiff will not be entitled to force the Defendant to disclose all documents which might relate generally to that broad issue ; since the Plaintiff is required to narrow that broad issue down by the particulars of breaches ; and the Plaintiff will only be entitled to have disclosed to him the documents which relate directly to the particular acts of infringements relied on by the Plaintiff.

Similarly although the broad issue of the validity of the Plaintiff's patent be put generally in issue on the pleadings, the Defendant will not be entitled to force the Plaintiff to disclose all documents which might relate generally to that broad issue ; since the Defendant is required to narrow that issue down by the particulars of objections ; and the Defendant will only be entitled to have disclosed to him the documents which relate directly to the particular grounds relied on by the Defendant.<sup>39</sup>

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<sup>39</sup> See *Edison & Swan United Electric Light Co. v. Holland* (1888) 5. R. P. C. 213 ; *Avery Ltd. v. Ashworth Son & Co. Ltd.* (1915) 32. R. P. C. 463 at p. 560 and 33 R. P. C. 235 (C. A.) ; and *Aktiengesellschaft für Autogene Aluminium Schweissung v. London Aluminium Co. Ltd.* (1919) 36. R. P. C. 199.



Owing to the comparatively small volume of Patent business and litigation which there has hitherto been in India, there are no reported Indian decisions of patent cases on this matter which are of assistance in formulating what should be and what should not be compelled to be disclosed ; it becomes of interest therefore to refer to the English practice and decisions on the subject. In this connection reference may be made to the authoritative statement of the law in Fletcher Moulton on Patents (1913) edition at p. 177 as follows :—

“The general practice in patent actions is to defer discovery relating to infringements, other than those specifically mentioned in the particulars of breaches, till after the Plaintiff has obtained judgment. If the defendant alleges that he is working under a secret process discovery before trial tending to disclose this process will probably be refused, but documents relating to such process should be included in the affidavit and an objection made to produce them on the ground of the injury such production would cause.

Documents relating to former actions on the same patent, or to a petition to revoke the patent, are usually relevant and must be included in the affidavit, though, if they were brought into existence merely for the purpose of a communication to the solicitor in the former action, they may be privileged. There is no privilege attaching to communications to a patent agent unless these are privileged on other grounds, and where the solicitor to a party is also a patent agent he should state that the communications for which privilege is claimed were made to him as solicitor. Where documents in a defendant's possession relate merely to prior user they are part of his case and need not be disclosed.”

#### 10. Application for inspection of apparatus.

Where the question is one of the degree and nature of the similarity or difference in two processes or machines it may often be a matter of the greatest importance for the one side to have inspection of the actual process or machine of the other side before the hearing. Even relative documents, drawings, and correspondence

referring to or describing the process or machine, and even interrogatories, however carefully framed and however frankly answered, will be but a poor substitute for a view by the eye. In a passing-off suit, more often than not, the passing-off complained of relates to a label or an inscription which is by its nature in essence a document in itself; and therefore the necessary inspection will be obtained as a result of the ordinary process of obtaining an affidavit of documents and inspection of documents. In a patent suit however, the position may be entirely different; nothing short of an inspection of the works or process or machine itself will be of any use, and the question is how and when a special order for this is to be obtained before the hearing.

In England in addition to the general provisions of Section 34 of the English Patents & Designs Act 1907-1932, it is directly provided by Order 53A Rule, 21A of the Rules of the Supreme Court that upon an application for directions under that rule such directions "for the making of experiments, tests or inspections for the purposes of the trial and for obtaining reports.....and otherwise may be given as the Court or the Judge shall think necessary or expedient for the purposes of (a) determining any question of construction which may arise on the specification, (b) defining, limiting or directing the issues of fact to be tried, (c) restricting the number of witnesses to be called at the trial on any particular issue, and (d) otherwise securing that the trial shall be conducted consistently with adequate hearing in the most expeditious manner.....". The practice in England as to such applications for directions has already been referred to.

There are also in England the general provisions contained in Order 50, Rule 3 & Order 30, Rule 2 of the English Rules of the Supreme Court concerning inspection of apparatus.

In India there is a provision in general terms giving power to a Court to order inspection: this is contained in Section 31 of the Indian Act of 1911 as follows:—

"In a suit for infringement of a patent the Court may, on the application of either party, make such order for an..... inspection....., and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit".

It is clear from the similarity of the wording that Section 31 of the Indian Act is based on Section 34 of the English Act which is the section which creates the power for the Court to order an inspection of apparatus, for which the English Rule 21A above mentioned formulates the details of procedure to be followed in England. In India there is no special rule (either of the Civil Procedure Code or of the High Court Rules of the Calcutta, Bombay or Madras High Courts) corresponding to that rule. It is clear none the less that a Court in India hearing an infringement suit has as wide powers to make an order for inspection of apparatus by the parties before the hearing as the Court in England. Where the suit has come up for directions either as a Patent suit, following the suggested practice, or through being marked as a commercial cause, if in a High Court, such an application may, no doubt, be made on the suit coming into the list for directions, and the requisite order be obtained among the other directions required. If the suit has not come up for directions, it will be necessary for an application to be made in Chambers for an order for the requisite inspection of apparatus before the hearing.

The applicant must show that the inspection asked for is essential to his case ; it will be advisable also for him to show a *prima facie* case in his favour on the merits, for as an order for inspection of a man's apparatus or works may cause him considerable inconvenience or even loss, the Court will not be likely to make it against one person in favour of another who does not appear to have a good case.

In England, where the Court has considered this desirable, orders have been made in infringement suits for mutual inspection by both the parties respectively of the apparatus of the other side before the hearing ; that is to say an inspection of both the patented apparatus of the Plaintiff and the apparatus of the Defendant which is alleged to be the infringement ; and orders made for the party having such inspection to see the apparatus working and to allow him to take samples of the work done by the apparatus in his presence.

To avoid undue disclosure of trade secrets to competitors, a practice has in several cases been adopted by the Court of not allowing an inspection by the parties themselves to the suit, but instead, directing that the inspection is to be made by scientific experts only

(excluding the parties to the suit), and making it a condition of the order for inspection, that the experts are directed to keep to themselves any secrets which they may discover which are not relevant to the matters in issue in the suit.

Thus in a recent case, *Coloured Asphalte Company Ltd. v. British Asphalt & Bitumen Ltd.*<sup>40</sup> where the Plaintiff Company on an application for directions applied (inter alia) for an order that the Defendant Company should disclose the analysis of the substance (a certain red mastic) in suit, an order was made for inspection of the Defendant Company's substance and the process for making the same, in spite of the Defendant Company's objection on the ground that their product was the subject of a secret process. The inspection was however ordered to be restricted only so as to be had by the Plaintiff's Solicitor, the Plaintiff's Counsel and one expert on certain terms. The precise order made in that case which is of considerable interest was as follows :—

"It is ordered that the Plaintiffs by their Solicitor Mr. Key, Counsel Mr. Lloyd Jacob and also Mr. Alan Wolf of 105a, Barrowgate Road, Chiswick in the county of Middlesex, the expert nominated on behalf of the Plaintiffs, be at liberty within 14 days of this Order, at a time to be agreed between the Solicitors for the parties, to enter upon the premises of the Defendants and inspect and examine the materials and process used by the Defendants in the manufacture of the red mastic referred to in paragraph 2 of the Particulars of Breaches and at the Defendants' premises to make any tests or analyses which may be thought fit by the said expert and to make and/or carry away such notes, records or the like as may be necessary for the purposes of this action and a sample or samples of the manufactured mastic, provided that the said Messrs Key, Lloyd Jacob and Wolf shall not at any time disclose anything appearing at the said inspection, which is claimed by the Defendants to be a secret process, except by leave of this Hon'ble Court, but shall be entitled to report to the Plaintiffs, without giving any details, whether or not in the opinion of any one of them the same infringes the Letters Patent

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<sup>40</sup> (1936) 53. R. P. C. 89.

in suit. And it is ordered that the said Defendants do give all other reasonable facilities for the purpose of the said inspection, tests and analyses and that the costs of this Summons be costs in the action.”

References to certain other English cases in which orders have been given for inspection of apparatus, from which the principles on which the Courts have acted in such cases may be observed, are given in the note below.<sup>41</sup>

### Inspection of prior users.

In a case where the Defendant disputes the validity of the Plaintiff's patent on the ground of prior user (of which as required he gives specific instances), it may be as necessary to the conduct of the Plaintiff's case for him to obtain inspection of any apparatus alleged to constitute such prior user, as it is in other cases for him to obtain inspection of the apparatus of the Defendant which the Plaintiff alleges to be an infringement. But in regard to this the position is different, in that, the owner of the apparatus not being a party to the suit, the Court cannot make any direct order against him for the inspection of his apparatus by the Plaintiff. If the third party owning the apparatus in question refuses to allow it to be inspected prior to the hearing, it is not possible for the Court to order any inspection of such apparatus. It was to get over this difficulty, as far as possible, that in England Rule 16 of Order 53A was framed in regard to English procedure. The material part of that Rule reads as follows :—

“No evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent

<sup>41</sup> See *Batley v. Kynock* (1874) L. R. 19. Eq. 90; *Germ Milling Co. Ltd. v. Robinson* (1884) 1. R. P. C. 217; *Cheetham v. Oldham & Fogg* (1888) 5. R. P. C. 617; *British Thomson-Houston Co. Ltd. v. Duram Ltd.* (No. 2) (1920) 37. R. P. C. 121; *Solaflex Signs Amalgamated Ltd. v. Allan Mnfy. Co. Ltd.* (1931) 48. R. P. C. 577; *Junkers v. Ford Motor Car Co. Ltd.* (1932) 49. R. P. C. 347 at p. 348; *British Celanese Ltd. v. Courtaulds Ltd.* (1933) 50. R. P. C. 63 at p. 80. See also *Patent Type Founding Co. v. Walter* 8. W. R. 353. *Mo Dougall Bros. v. Partington* (1890) 7. R. P. C. 351, 472 (C. A.); *Sidebottom v. Fielden* (1891) 8. R. P. C. 266.

What is here considered is an application by a party to the suit for inspection of apparatus belonging to the opposite party. As to an application for inspection to be had by the judge see Part IV below.

and which is in existence at the date of the delivery of the particulars shall be receivable, unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.”

There is no such Rule in force in India. Accordingly there appears to be no means by which the Court in India can make an order which will result in affording inspection for a Plaintiff of any apparatus of third parties relied on by the Defendant as instances of prior user : except in cases where this may be made a condition precedent to the giving of some other direction favourable to the opposite party.

**11. Application regarding the making of experiments ; and for appointment of an expert to make experiments and report.**

In England an application is commonly made under modern English patent practice for the evidence of experiments to be limited to those performed in the presence of the scientific witnesses of both parties.<sup>42</sup>

It is submitted that a Court in India may have an inherent power to make an order to that effect. In any event it might be to the advantage of both parties, at the time of obtaining directions, to consent to such an order being made.

After the hearing has begun, experiments have been allowed in a proper case concerning matters which have arisen during the hearing.<sup>43</sup>

There is also now a procedure available in England whereby arrangements may be made to have experiments made by an expert appointed not by the parties but by the Court and for him to make his report direct to the Court. This is done under a special English Order being Order 37A of the Rules of the Supreme Court, which is applicable in all suits and not merely in Patent actions. It regulates in clear terms the procedure, which may be adopted by the Court, in

<sup>42</sup> See *Junkers v. Ford Motor Car Co. Ltd. & Cooper* (1932) 49 R.P.C. 347 at p. 348.

<sup>43</sup> See *British Celanese Ltd. v. Courtaulds Ltd.* (1933) 50 R.P.C. 63 at p. 84.

its discretion, on the application of any party, for appointing an independent expert who is to be called "the Court expert". Reference may also be made in regard to modern English Court procedure to Order 38A, Rule 8(3) of the "New Procedure Rules".

Even before these orders came into existence it has long since been held in England that the Court has power in a Patent suit to call in an independent expert to make certain experiments and report thereon to the Court or merely to report on certain points to the Court. <sup>44</sup>

There are no orders or rules of procedure in force in India corresponding to the English Order 37A or Order 38A, Rule 8(3) above mentioned. Nevertheless it is submitted, that in a Patent suit a Court in British India will have inherent power in its discretion to appoint an expert to report to the Court on certain points or to make experiments and report thereon to the Court on similar principles as Courts in England have been held to have such inherent power. This being so, since the specific orders mentioned as being now operative in England merely provides a procedure for the exercise of this inherent power, it is submitted that the same procedure may conveniently be followed in India where necessary. Since such procedure has been found by long experience to be a convenient course in such cases in England, it may be of interest to note here the features of that English procedure; in case it may be found convenient for a similar course to be taken in any given patent suit in India which may call for the appointment of an expert on such lines.

The wording of Order 37A of the English Rules & Orders is as follows :—

#### *Court Expert.*

"37A. 1. In any case which is to be tried without a jury involving any question for an expert witness the Court or a Judge may in his discretion at any time on the application any party appoint an independent expert (to be called

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<sup>44</sup> See *Moore v. Bennett* (1884) 1 R.P.C. 129 (C.A.); *Badische Anilin und Soda Fabrik v. Levinstein* (1885) 2. R.P.C. 73 and 4. R.P.C. 449 (H.L.) at p. 454; *North British Rubber Co. v. Macintosh & Coy. Ltd.* (1894) 11. R.P.C. 477; *British Motor Syndicate v. J. F. H. Andrews & Co. Ltd.* (1899) 16. R.P.C. 577 at p. 591; see also *Mellin v. Monico* (1877) 3. C.P.D. 142, at p. 149.

"the Court expert") to inquire and report upon any question of fact or of opinion not involving questions of law or construction (hereinafter called "the issue of the expert").

- (2) The report so far as it is not accepted by all parties shall be treated as information furnished to the Court and shall be given such weight as the Court may think fit. The report shall be made in writing to the Court, together with such carbon or other copies as the Court may require, and copies of the report, shall be forwarded by the proper officer to the parties or their solicitors.
- (3) Any party shall be at liberty within 14 days after receipt of a copy of the report, or such other time as the Court or Judge shall direct, to apply for leave to cross-examine the Court expert on his report, and the Court or Judge shall on such application either (a) make an order for the cross-examination of the Court expert by all parties at the trial, he being called and sworn at such stage, as the Court shall at the hearing direct or (b) make an order for a like cross-examination before an Examiner at such time and place as the Court shall direct.
- (4) The Court expert shall if possible be a person agreed between the parties, and failing agreement shall be nominated by the Court or Judge. The question or the instructions submitted or given to the Court expert, failing agreement between the parties, shall be settled by the Court or Judge.
- (5) If the Court expert is of the opinion that any experiment or test of any kind is necessary to enable him to report in a satisfactory manner (other than any experiment or test of a trifling character), he shall communicate the fact to the parties or their solicitors and shall endeavour to arrange with them as to the expenses involved and as to the persons to attend and other similar matters. Failing agreement between the parties all such matters shall be determined by the Court or Judge.
- (6) The Court or Judge may at any time direct the Court experts to make a further or supplemental report which shall be treated as annexed to his original report.
- (7) The remuneration of the Court expert shall be fixed by the Court or Judge and shall include a fee for making the report, a fee for any supplementary report and a proper sum per diem for each day during which the presence of the Court expert may be required either in Court or before an examiner. The parties shall be jointly and severally liable to pay the remuneration so fixed without prejudice to the question by whom it shall be ordered to be paid as part of the costs of the action or proceeding. Provided however that in any case in which the appoint-



ment of a Court expert is opposed, the Court or Judge may require the party applying for the appointment to give such security for the remuneration of the Court expert as the Court or Judge may think proper as a condition of making the appointment.

- (8) Any party shall be at liberty on giving reasonable notice before the trial to call, with regard to the issue for the expert, not more than one expert witness, provided that in exceptional cases and by the leave of the Court two or more expert witnesses may be called. Provided however that the costs of and occasioned by the calling of any such expert shall be specially dealt with by the Judge at the trial, and that no such costs shall be allowed to a successful party unless the Judge shall certify that the calling of such expert was reasonable and that his evidence has materially assisted the Court in determining the question or issue.
- (9) In any case in which more than one issue for the expert shall arise the Court or a Judge may appoint more than one Court expert to inquire and report on the separate issues so arising, and these Rules shall apply to each Court expert so appointed.
- (10) In taxing the costs incurred in proceedings in which a Court expert shall have been appointed, such just and reasonable charges and expenses as appear to have been properly incurred in obtaining the advice of an expert (whether called as a witness or not) as to whether the action should be brought or defended or as to whether the report or reports of the Court expert should be accepted to any and what extent or as to the matters on which he might properly be cross-examined upon his report or reports, including if proper the attendance in Court of the expert so employed are to be allowed.
- (11) The word "Expert" in this Order shall include scientific persons, medical men, engineers, accountants, actuaries, architects, surveyors and other specially skilled persons whose opinions on any question relevant to the issues involved would be received by the Court."

The wording of Order 38A, Rule 8(3) is :—

"(3) The Judge may order that any question involving expert knowledge shall be referred to a special referee for inquiry and report, and in particular and without prejudice to the general power, the Judge may refer to a special referee for inquiry and report any question arising as to the nature, extent and permanence of any inquiry caused or alleged to have been caused by the negligence of a party on the terms (a) that the report when received

shall be communicated to both parties with a view to ascertaining whether they are willing before further expense is incurred to agree to accept the report in whole or in part ; (b) that in so far as the report is not accepted by both parties it shall be treated as information furnished to the Court and shall be subject to the criticism of any expert witness called at the trial, and shall be given such weight in deciding any question of difference between the expert witnesses as the Court shall think fit ; (c) that the proper remuneration of the referee shall be fixed by the Judge after the receipt of the report, and that the parties shall be jointly and severally liable to pay the remuneration so fixed to the referee, and (d) that the costs of the reference—including the remuneration of the referee, unless otherwise ordered, shall be costs in the action.”

## **12. Application for limiting the number of scientific witnesses.**

That some limit should be placed on the numbers of scientific or “expert” witnesses to be called by either side at the hearing, is now recognised in England in the terms of the English Order 53A, Rule 21A governing the obtaining of directions in a patent suit ; to which reference has already been made (see page 739).

There is no such specific provision in India. It might be of advantage for the purpose of saving the unnecessary expense of protracted hearings if some such rule were to be specifically enacted in India. It would seem very doubtful whether Section 31 of the Indian Act (corresponding to Section 34 of the English Act), by itself, is sufficient to give power to a Court in India to refuse to allow a party in an infringement suit to call as many expert witnesses as he may desire or to give any directions to that effect unless the parties consent.

## **13. Application for administering interrogatories.**

In addition to such discovery of documents as is afforded by the filing of an affidavit of documents, discovery of facts may also be obtained in a proper case through the administration of interrogatories. This again is a process which becomes often more than ordinarily important in Patent suits owing to the circumstance, that it so often happens that the facts which are required to prove the case of the one party are more peculiarly within the knowledge of the other party. The general provisions in India regarding the

procedure for the administration of interrogatories are contained in Order 11, Rules 1 to 11, of the Civil Procedure Code ; as to which see also the commentary in Mulla's Civil Procedure Code (10th Edn.) p. 608 et seq. In the hope of saving costs it will be advisable that a request for information, worded in a manner similar to the proposed interrogatories, be sent in the first place in the form of a letter to the Attorney of the interrogatee ; for if the required information is received by letter in reply there will be no need to incur the costs of an application for formal interrogatories through the Court.

**What interrogatories will be allowed.**

Though there is no Indian case law on the subject of interrogatories in Patent suits, it is submitted that, the principles governing the procedure in India and in England being the same in this matter, English decisions may be usefully if not authoritatively relied on. The following are instances where interrogatories have been allowed in England :—

*As to true and first inventor :—*

Whether a certain person was not the true and first inventor of the patented process in suit.<sup>45</sup>

*As to sales :—*

Where infringement is not admitted : questions to the effect whether Defendant did not on such and such a date sell such and such goods to so and so.<sup>46</sup>

This may be a most useful and effective form of interrogatory by which much time and the giving of much evidence may be saved at the hearing.

*As to facts showing utility and as to process used :—*

Where utility is denied : questions whether in fact the Defendant used or uses the patented article or process have been allowed.<sup>47</sup>

<sup>45</sup> And as to facts regarding novelty see *Hoffman v. Postill* (1869) 4 Ch. App. 673.

<sup>46</sup> See *Lister v. Norton Bros. & Co. Ltd.* (1885) 2 R. P. C. 68.

<sup>47</sup> See *Renard v. Levinstein* (1864) 11 L. T. 79 at p. 81 ; *Rylands v. Ashley's Patent (Machine Made) Bottle Co.* (1890) 7 R. P. C. 175 (C. A.) Contrast *Jourdian v. Palmer* (1886) 12 Jur. N. S. 214 ; see also *Ashworth v. Roberts* (1890) 7 R. P. C.

*As to prior user :—*

The position has altered in England owing to the new rules embodied in Order 53A, Rule 18, which give a Plaintiff a right to compel a defendant alleging invalidity on the ground of prior user, to give full particulars in his Particulars of Objections. It is seldom then in modern practice in England there will be any need to resort to interrogatories to obtain particulars of prior user. It is submitted that in general the proper course in India also will not be to administer interrogatories in such a case but to apply for further and better particulars : for even though there is no specific rule of procedure in India corresponding to Order 53A, Rule 18, it may be expected that a Court in India also would order the particulars to be given on general principles as being necessary and proper particulars within Order 6, Rule 5 of the Civil Procedure Code. In any event it will be advisable for the Plaintiff by one method or the other to obtain the requisite information before the hearing. References to some of the English cases under the old practice are given for what they are worth in the note below as authority for the Plaintiff's right to interrogatories in such cases, should resort to interrogatories be necessary.<sup>45</sup>

*As to name of manufacturer :—*

Where a defendant, who is sued as a user of the infringing article, states that he does not know how the article is made, he has been ordered to give the name of the manufacturer where the Court has been satisfied that this will enable the Plaintiff to prove infringement.<sup>46</sup>

*Limits of answers that need be given :—*

Where the interrogatee is a company, answers need only be

451. *Benno-Jaffe and Darmstaedter Lanolin Fabrik v. John Richardson & Co. Ltd.* (1893) 10. R. P. C. 136 ; See also *Aktiengesellschaft fur Anilin Fabrikation in Berlin & anr. v. Levinstein Ltd.* (1913) 30 R. P. C. 401 (C. A.) and 30. R. P. C. 673 ; *Osram Lamp Works Ltd. v. Pope's Electric Lamp Co.* (1914) 31. R. P. C. 313.

<sup>45</sup> See *Alliance Pure White Lead Syndicate Ltd. v. Mc Ivor's Patents Ltd.* (1891) 8. R. P. C. 321 ; *Birch v. Mather* (1883). 22. Ch. D. 629 ; *Crossley v. Tomey* (1876) 2. Ch. D. 533 ; *General Electric Co. (1900) Ltd. v. Safety Lift & Elevator Co.* (1904) 21. R.P.C. 109 ; compare *Flower v. Lloyd* (1876) 45. L.J. Ch. 746 (explained in *Birch v. Mather* above) and *Daw v. Eley* (1865) 2. H & M. 925.

<sup>46</sup> See *Saccharin Corporation Ltd. v. Haines Ward & Co.* (1898) 15. R. P. C. 344.

given of knowledge which the directors have acquired in their capacity as directors on behalf of the company, and need not state matters of knowledge acquired by them in their personal capacity.<sup>50</sup>

*As to extent of infringement :—*

As to this and other matters which do not arise until the enquiry as to damages, which does not ordinarily take place until after the suit, interrogatories are not ordinarily allowed in the suit.<sup>51</sup>

*As to names of customers :—*

A defendant may be asked whether he has sold the article in suit to anyone and if so to give the name of the customers.<sup>52</sup>

*As to names of suppliers :—*

Cases have arisen, where the names of the suppliers of the goods (the sale of which by the defendant is the alleged infringement in the suit) are relevant. Ordinarily these will not have any bearing on any matter in issue between the parties in the suit : but a case where interrogatories were allowed was where the patent in suit was for a process of chemical manufacture, where the plaintiffs showed that they knew every process employed by various rival manufacturers, where some of such processes were infringing processes and some were not, where the manufactured product was in itself similar after all processes of manufacture ; and where the suit was against the defendants as sellers only (and not manufacturers) of an article said to have been manufactured by an infringing process. There the Court allowed the interrogatories because it considered that proof of the identity of the manufacturer would show whether the goods had been manufactured by an infringing or a non-infringing process and accordingly whether the defendants were selling infringing or non-infringing goods.<sup>53</sup>

*Time for administering interrogatories :—*

It has been held in effect that the Plaintiff must file his plaint with his Particulars of Breaches before administering any inter-

<sup>50</sup> See *Welsback Incandescent Gas Light Co. Ltd. v. New Sunlight Incandescent Co. Ltd.* (1900) 17. R. P. C. 401.

<sup>51</sup> *Terrell* p. 414.

<sup>52</sup> See *Lister v. Norton Bros. & Co. Ltd.* (1885) 2. R. P. C. 68 ; *Stahlwerk Becker A.G.* (1917) 34. R. P. C. 344.

<sup>53</sup> See *Saccharin Corporation v. Haines* (1898) 15. R. P. C. 344 (C. A.) ; *Stahlwerk Becker A.G.* (1917) 34. R. P. C. 344.

rogatories; but that where he is not in a position to give full particulars in his Particulars of Breaches without obtaining further facts from the defendant, he may make an application for the administering of interrogatories so as to obtain the necessary facts and then amend his Complaint or Particulars of Breaches afterwards.<sup>54</sup>

#### 14. Application for commission.

Whether it be for the purpose of obtaining the evidence of experts resident abroad whom it is impossible to bring to Court or for the purpose of proving other facts which it is necessary to establish in the suit, it will frequently happen in Patent Suits that it will be found advisable by one party or the other, or both, to have the evidence of witnesses examined on commission. Ordinarily any witness resident within 200 miles of the Court may be compelled to come and attend Court on the day of the hearing of the suit by the issue of a sub-poena which is issued, as of right, on application being made therefor, by the Court hearing the suit (see Civil Procedure Code Order 16, Rule 1 read with Order 16, Rule 19). But no person resident beyond such 200 miles radius can be so compelled to attend; and accordingly if the evidence of such a witness is required, this can only be obtained by an application to have his evidence taken at his place of residence (or at some other convenient place) on commission. While the Court hearing the suit has power ordinarily to issue a summons to compel the attendance in its Court for giving evidence of any witness resident within 200 miles of that Court under Order 16, Rule 19, the power to issue a commission is given in relation to any witness resident beyond the local limits of that Court. It is possible therefore that a commission might be asked for to issue for the examination of a person resident outside the local limits but inside the 200 mile radius, if there were special reasons making it more than ordinarily difficult for him to attend Court: ordinarily however the Court will refuse to issue any commission for the examination of a witness resident within the 200 mile radius in view of the powers it has to compel his attendance by sub-poena.

The hearing Court may either issue the Commission to any Court, not being a High Court, within the local limits of whose

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<sup>54</sup> See *Jones v. Platt* (1861) 7. Jur. N. S. 978; compare *Edler v. Victoria Press Mfg. Co.* (1910) 27. R. P. C. 114.

jurisdiction the witness resides : in which case that distant Court will appoint the Commissioner, and the Commissioner will return his Commission, when executed, to that distant Court, who will forward the proceedings to the hearing Court. Or the hearing Court may itself appoint any pleader or other person as Commissioner who will return his Commission direct to the hearing Court. In which case the hearing Court may either, as it commonly does, appoint a practitioner known to it, who practises and is resident within the locality of the hearing Court, who will then travel to and from the place of the commission ; or it may itself directly appoint a person resident within the locality of the commission. The Court ordering the commission will be less likely to adopt the latter course unless the parties consent to a particular person to be appointed Commissioner, or unless such person is known to the Court, since it may consider it unsatisfactory to appoint an unknown person as its Commissioner. Should the parties desire to avoid the expense of sending out a travelling Commissioner, then the Court ordering the Commission may leave the selection of the Commissioner to the distant Court. In spite of the additional expense of a travelling Commissioner, both the parties themselves and the Court issuing the commission may consider it preferable, particularly in a patent suit, that the selection of the Commissioner may be made by the Court hearing the suit.

In either case if a commission is ordered, the Commissioner will have the powers of a Civil Court, and may in case of necessity, by application to the Court within the local limits of whose jurisdiction a witness resides, effect the issue of a summons for the examination of any witness : under Rule 17 of Order 26 of the Code of Civil Procedure.

### **As to Appeal.**

An order granting or refusing a commission is not one of the specific appealable orders under Section 104 and Order 43, Rule 1 of the Civil Procedure Code. An order granting a commission is also clearly not a judgment within the meaning of Clause 15 of the Letters Patent of 1865 of the Calcutta High Court : and is not therefore appealable thereunder.<sup>55</sup> It is also established, for the Calcutta High Court at least, that an order refusing an application for com-

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<sup>55</sup> See the Calcutta High Court Rules (3 Edn.)

mission is also not appealable under Clause 15 of the said Letters Patent ; not being a judgment within the meaning of the Clause.<sup>56</sup>

### 15. Application for hearing with Assessors.

Owing to the highly technical questions which may be involved in certain Patent suits, provision has been made for the Court, if it thinks fit, to appoint an expert as an Assessor to assist it in the trial of the suit. The relative provisions of Section 35 of the Indian Act are as follows :—

- “35. (1) In a suit or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall on the request of all the parties to the proceedings, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance.
- (2) A Court exercising appellate jurisdiction in respect of such suit or proceeding may, if it thinks fit, call in the aid of an assessor as aforesaid.
- (3) The remuneration, if any, to be paid to an assessor under this section shall in every case be determined by the Court and be paid by it as part of the expenses of the execution of this Act.”

The corresponding Section of the English Act of 1907-1932 is Section 31 similarly worded. It appears that the inconvenience of trial with an assessor has resulted in this course being rarely adopted in England, the more usual course being, where expert technical assistance is required by the Court, for an expert to be appointed to make experiments and report to the Court, or for experiments to be made by the experts of the parties in the presence of both parties. As to the procedure adopted where an Assessor has been appointed under Section 31 of the English Act and has sat with the Court (see the cases referred to in the note).<sup>57</sup>

<sup>56</sup> See *Toremull Dilsook Roy v. Kunj Lall Monohar Dass.* (1920) 31. C. L. J. 162. The Madras High Court has taken the same view in *Tuljaram Row. v. Alayappa Chettiar* (1910) 35. Mad. 1. (F. B.) overruling (1906) 30 Mad. 143. *Maruthamuthu Pillai v. Krishnamacharian.*

<sup>57</sup> *Hattersley & Sons Ltd. v. Hodgson Ltd.* (1905) 22. R. P. C. 229 ; *Mackie v. Berry* (1886) 2. R. P. C. 146 ; *Marconi v. Helsby Wireless Telegraph Co. Ltd.* (1914) 31. R. P. C. 121. As to the practice in the Court of Appeal see *Hattersley v. Hodgson* (above) ; and *c.f. Moore v. Bennett* (1884) 1. R. P. C. 129 (C. A.). Compare Order 36, Rules 2 and 43 of the English Rules of the Supreme Court.



### As to Costs.

Section 35 of the Indian Act of 1911 provides that the costs are paid by the State and not by the parties.<sup>58</sup>

### 16. Application for hearing of the suit in camera.

If one of the parties contends that a process in question used by him is a secret process, he may desire to obtain an order that the suit shall be heard *in camera*. In England, in a proper case, such an order has been made to avoid unreasonable business loss to a party. In such a case arrangements have also been made for the shorthand notes of the suit to be impounded.<sup>59</sup>

It is submitted that, in a proper case in which one of the parties may stand to suffer irretrievable loss if his secret process is divulged, a Court in India will have inherent power to make an order for the suit to be heard *in camera*, if it thinks fit.<sup>60</sup>

### 17. Application for consolidation of suits.

On principles similar to those on which a Plaintiff has, as previously mentioned, been allowed to sue on several different patents in one suit, it is submitted, that if a Plaintiff has filed several suits on several different patents, the breach of which is all claimed to be by or in relation to one article, such a Plaintiff on application, would be entitled to obtain consolidation of his several suits so as to have them heard as one suit ; thus saving the extra costs.

It has been held that the Court has inherent power under Section 15 of the Civil Procedure Code to make suitable orders for the consolidation of suits.<sup>61</sup>

### 18. Application for stay of the suit.

Should there be another suit in existence in which the issues should be similar, or partially similar, to those in the suit now in question, it may be advisable for an application to be made for the

<sup>58</sup> For an Indian case where the Act was so applied see the judgment of Gregory J. in *Indian Vacuum Brake Coy. Ltd. v. E. G. Luard* (1926) 53. Cal. 306 at p. 318.

<sup>59</sup> See *Badische Anilin und Soda Fabrik v. Levinstein* (1885) 2.R.P.C. 73.

<sup>60</sup> For a precedent of an order in such a case preventing disclosure of evidence see *Badische Anilin etc. v. Levinstein* (1885) 2. R.P.C. 73 (ibid) at p. 85.

<sup>61</sup> See *Mulla* (10th Edn.) p. 435 note (p.) and cases there cited.

stay of the suit pending the disposal of the other suit. The matter then governed by Section 10 of the Civil Procedure Code.

**As to appeal.**

It has been held that an order either to allow or to refuse a stay of a suit is a Judgment within the meaning of Clause 15 of the High Courts Letters Patent of 1865; and is therefore appealable thereunder.<sup>62</sup>

It is possible that in certain circumstances even if the applicant is not entitled as of right to a stay under Section 10 of the Civil Procedure Code, yet where there is another suit or appeal or proceeding to be heard involving the same issues, or even some of the same issues, the court may be willing to order an adjournment of the suit in question for reasons of general convenience. In such case the Court may either direct that the suit shall stand over definitely until the other matter is disposed of; or it may grant a provisional adjournment for a fixed period after which the question of the date of hearing may be again considered.<sup>63</sup>

#### **19. Application for an early date to be fixed for the hearing.**

It may be important for the parties, or one of them, for particular reasons, that the suit should be heard and decided at an early date. In many cases it may be that if an order is obtained from the Judge for an early hearing there will be no need for an injunction or for certain other relief, which might otherwise need to be asked for. In such cases an application may be made if desirable, for an early date to be fixed for the hearing of the suit.

#### **20. Application for judgment on admissions.**

The procedure embodied in Order 12, Rule 6 of the Civil Procedure Code is as applicable to Patent suits as to any other suits. In some cases this procedure may be used as an effective form of summary procedure for the benefit of the Plaintiff. The Plaintiff will be equally entitled to make such an application for judgment

<sup>62</sup> See *Jivanlal Narsi v. Pirojshaw R. Vakharia & Co.* (1933) 57. Bom. 364. at p. 368.

<sup>63</sup> See different courses adopted in *Smith v. Upton* (1843) 6. M. & G. 251; *Muntz v. Foster* (1842) 7. Sc. N. R. 898; *Welsback Incandescent Gas Light Co. Ltd. v. John McGrady & Co.* (1901) 18. R. P. C. 513; *Dunlop Pneumatic Tyre Co. Ltd. v. Rimington Brothers & Co. Ltd.* (1900) 17. R. P. C. 665. (C. A.)

on admissions whether the suit is being brought in a District Court or in a High Court. In patent suits such a situation may not infrequently arise where the Defendant admits infringement in respect of part of the allegations in suit, but joins issue as to the rest.

If the suit is being in a High Court, it may be that the Rules of the particular High Court, in which it is brought, allow a Plaintiff also to have the benefit of another form of summary procedure in certain circumstances : as is provided, for example, in the Calcutta High Court under Chapter XIII A of the Rules of that High Court. But as such summary procedure is available only for suits for debts or liquidated demands, it is not available to a Plaintiff in the usual suit for infringement of a Patent. It will be found however in practice, that, in most cases, whatever advantage might have been obtained under an application under Chapter XIII A, if it had been available, may be equally well obtained by an application for judgment on admissions under Order 12, Rule 6 of the Civil Procedure Code.

**As to appeal.**

It has been held that an Order in a High Court rejecting an application for judgment on admissions is a "judgment" within the meaning of Clause 15 of the Letters Patent of 1865 and is appealable thereunder.<sup>64</sup>

**21. Disposal of the suit in the absence of any defence on the part of the Defendant. Application to have the suit placed on the undefended list.**

*N. B.—What is stated under this heading is only applicable when the suit for infringement has been brought in a High Court : it is not applicable to District Courts.*

If the suit is brought in a High Court it may be found that, under the Rules of the particular High Court in which it is brought, it is open to the Plaintiff in the event of the Defendant, if he has entered appearance, thereafter making default in not filing his Written Statement within the period allowed him, to make an application in Chambers for the suit to be placed on the Undefended List. If such application is successful the suit will come up for hearing as an undefended suit and be disposed of at an early date.

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<sup>64</sup> See *Koramall Ramballav v. Mongilal Dalimchand* (1919) 23 C. W. N. 1017.

In the Calcutta High Court such an application may be made under Chapter IX, Rule 3 of the Rules of that High Court.

If a suit is settled entirely, or in such circumstances that the parties require only an order for taxation of costs, the setting down of the suit in the List of Undefended Suits for its disposal may be obtained by requisition by letter to the Registrar under Rule 15 of Chapter X of the Rules of that Court.

In cases where the Defendant has failed to enter appearance, or there has been a specific direction of the Court to the requisite effect, the suit will of course be placed in the Undefended List by the Registrar, without the necessity of any application being made for the purpose by the Plaintiff. This is provided for under the Calcutta High Court Rules under Rule 25 of Chapter X, which is as follows :—

- “25. (a) Where a sole defendant has, or all the defendants, being *sui juris* have failed to enter appearance, or (b) where in cases under Order XXXVII of the Code, a sole defendant has, or all the defendants being *sui juris*, have failed to obtain leave to defend, or (c) a direction under Chapter XII, rule 6 has been given, or (d) where an order has been made for the transfer of the suit to the Undefended List—the suit shall, unless otherwise ordered, be set down in the Peremptory List of Undefended Suits, in case (a) on the first available day after the expiry of the time for entering appearance, and in cases (b), (c) and (d) on the first available day as the case may be, after the date of the direction, or the filing of the order, and the expiry of the time or the non-compliance with the terms of the order.”

In the Bombay High Court the course of dealing with the list of suits is somewhat different, though in practice the result is much the same in that, if the Defendant delays in filing any Written Statement, an order may be obtained on him to do so within a definite period, and then, if he has not done so after the expiry of such period, the suit will come up for hearing as an undefended suit. In the ordinary course no special application is required to be made by the Plaintiff in Bombay to have the suit placed on the undefended

list in such circumstances. The matter is regulated by Rule 22 of Chapter 2 of the Rules of that High Court which is as follows :—

“22. Suits in which written statements are called for but not furnished are set down each week for hearing as undefended.....”

**22. Dismissal of the suit for want of prosecution on the part of the Plaintiff. The Special List.**

*N. B.—What is stated under this heading is only applicable when the suit for infringement has been brought in the High Court of Calcutta : it is not applicable to District Courts or to the High Courts of Bombay or Madras.*

If the suit is brought in a High Court, it may be found that under the Rules of the particular High Court in which it is brought, the suit becomes liable, after the lapse of a fixed time, if not properly proceeded with, to be dismissed for want of prosecution.

In the Calcutta High Court suits, which have not become effective for hearing within six months from the date of institution, are regularly placed in what is known as “the Special List” for consideration by the Judge ; and are then, if no step has been taken in the suit, liable to be dismissed for want of prosecution. The rule which authorises this course is Rule 36 of Chapter X of the Rules of the Calcutta High Court : as follows :—

“36. Suits and proceedings, which have not appeared in the Prospective List within six months from the date of institution, may be placed before a Judge in Chambers, on notice to the parties or their attorneys, to be dismissed for default, unless good cause is shown to the contrary, or be otherwise dealt with as the Judge may think proper.”

It has been held that this rule is not *ultra vires*, the Court having the power to make it under cl. 37 of the Letters Patent.<sup>65</sup>

It may be noted that though the word used is “may”, the practice is for all such suits regularly to be placed on this Special List ; and a Patent suit will not be treated differently to any other suit in this respect. It is to be noted therefore that it may be a

matter of vital importance for the Plaintiff, that once the suit is instituted, active steps be taken to bring it to a hearing. No application is required by a Defendant to have a suit placed in the Special List; it will be sorted into the Special list by the officials of the High Court. No comments are called for in regard to the procedure of such dismissal for want of prosecution in particular relation to Patent suits. It will be of interest merely to note that it is open to the Plaintiff even after his suit has been placed on the Special List and dismissed for want of prosecution, to file a fresh suit—provided he is not by that time barred by limitation.

The Calcutta High Court Rules also express provision in respect of a suit in which there has been an order passed for a reference to account, on an application being made by the Plaintiff, for the suit to be dismissed also for want of prosecution if due diligence is not shown in prosecuting the reference. This is provided for under Rule 8 of Chapter 26 which is as follows :—

- “8. Where no steps are taken within 30 days to apply for and file a decree or order or reference, or where no office copy thereof is filed in the Accounts Department within the time prescribed by rule 4 or within such further time as may have been allowed, any party may apply to a Judge by summons that the suit be dismissed for want of prosecution or that all further proceedings under the reference be stayed or such order made as to the Judge shall seem fit.”

In respect of cases in which the order for the Reference has been duly applied for and filed, but thereafter there is a want of prosecution of the reference, further provision is contained in the Calcutta High Court Rules for the striking out of the Reference for want of prosecution. This is provided for under Rules 27 and 53 of Chapter 26 which are as follows :—

- “27. Where a party has made default in filing any statement of accounts, objection, surcharge or in doing or performing any act which he has been directed to do or perform, the officer shall be at liberty to proceed ex parte as regards such party as though he had not appeared, or he may adjourn the meetings or direct any other party to file a statement of account, or proceed to determine the refer-

ence on the evidence before him, or strike the same out of his list of references or make such other order including directions as to costs as, under the circumstances, he thinks fit."

"53. Where at any stage of a reference no steps have been taken to prosecute it for 30 days, the officer to whom the reference is directed may, where he thinks fit, strike the same out of his list and the same shall also be struck out of the General List of References as hereinafter provided."

In such case however the striking out of the Reference does not necessarily put an end to the suit itself.<sup>66</sup>

It appears that there are no specific rules in the Bombay High Court or the Madras High Court similar to Rule 36 of Chapter X of the Calcutta High Court such as to provide for the dismissal of suits for want of prosecution in the same way as in the Calcutta High Court.

### 23. Disposal of the suit in the event of settlement before hearing.

Though the Defendant intimates that he will not contest the suit, and that he is willing to give an undertaking not to infringe, the Plaintiff is nevertheless ordinarily entitled (in the absence of course of express agreement as to specific terms of settlement) to have an order in Court for a permanent injunction. He is in such a case not bound to forego the costs of obtaining the requisite decree in the suit.<sup>67</sup>

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<sup>66</sup> See *Gocool Chunder Gossamee v. Administrator-General* (1880) 5. Cal. 728.

<sup>67</sup> See p. 785 below.

## PART IV

### MATTERS WHICH MAY ARISE AT OR IN CONNECTION WITH THE HEARING OF THE SUIT.

It is now proposed to consider certain points of practice which may arise at or in connection with the hearing of the suit. These matters are discussed separately under the headings already indicated (at page 648); such different headings being consecutively numbered merely for convenience of reference.

#### 1. Trial of preliminary point first.

If the Plaintiff's patent is invalid, no question of infringement need arise; similarly if it can be shown in fact that no acts amounting to an infringement have been done, it might be considered in some cases waste of time and money to enter into a lengthy enquiry as to the validity of the patent.

In certain cases the Court may direct that a preliminary point may be heard and determined first.<sup>1</sup>

In some instances it may be found that such an apparent short cut will in the end in practice turn out to be inconvenient; and even lead finally to more protracted and more expensive litigation. The general observations which have been made from time to time by the Court of Appeal in the High Court of Calcutta would seem to be applicable just as much to patent suit as to others.

And it has been observed in England that in general the course of trying a preliminary point first should only be adopted where it appears probable that the trial of such point will decide the suit.<sup>2</sup>

Should it nevertheless be thought desirable that some preliminary point should be tried first it would seem that this course

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<sup>1</sup> See *eg Woolf v. Automatic Picture Gallery* (1902) 19. R. P. C. 425. *Stephenson Black & Co. v. Grant etc.* (1917) 34. R. P. C. 192 (as to a registered design); *Murex Welding Processes Ltd. v. Weldrics* (1922) Ltd. (1933) 50 R. P. C. 178. *Contrast United Telephone Co. v. Mottishead* (1886) 3. R. P. C. 213; see also *Hutchinson v. Pattulo* (1888) 5. R. P. C. 351 at p. 356 (H L.); *Sarason v. Frenay* (1914) 31. R. P. C. 252 at p. 260.

<sup>2</sup> See *Emma Silver Mining Co. v. Giant* 11. Ch. D. 918 at p. 927 (Jessel M. R.); *Piercy v. Young* (1890) 15. Ch. D. 475; *United Telephone Co. v. Mottishead* (1886) 3. R. P. C. 213.



may be adopted under the procedure allowed under Order 15 Rule 3 of the Civil Procedure Code.

In a case where Defendant claimed a secret process, it was held in an English case that the question of validity might be tried first as a preliminary issue, in order to avoid going into the question of infringement and thereby laying bare the secrets of the process when this might be unnecessary.<sup>3</sup>

## 2. Application for adjournment.

It may happen that owing to some unforeseen occurrence it becomes necessary for one party or the other to make an application for adjournment of the hearing of the suit. If the suit is being heard in a District Court any application for adjournment will require to be made to the Judge who will hear the suit.

If the suit is being heard in a High Court, a postponement of hearing may in the early stages be obtained by requisition to the Registrar in certain circumstances.

In the Calcutta High Court the practice is as follows. If the suit has not yet been placed in the Warning List, either party through his Solicitor may write to the Registrar of the Original Side of the Calcutta High Court and request him, owing to the parties not being ready for the hearing, to arrange that the suit will not be placed in the Warning List before a certain date. This will then be done without more ado. If the suit has already been placed in the Warning List then the matter must be mentioned to the Judge in to whose list the suit would eventually in the ordinary course, come. In order that the suit may be effectively so mentioned and that the Judge may effectively deal with the matter, it is essential that both sides are represented in Court at the time of its being mentioned. It is therefore necessary that a letter be first sent to the Attorney for the other side notifying him that the suit will be mentioned before a particular (named) Judge on a certain stated date at a certain stated time. After receiving such a letter, the other side's Attorney will ordinarily have the courtesy to arrange for counsel to attend on behalf of his Client at the time and place stated. The matter may then be mentioned without further formality and the necessary directions may be given by the Judge for

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<sup>3</sup> See *Badische Anilin und Soda fabrik v. Levinstein* (1885) 2. R. P. C. 73 ; *Hanks and anr v. Coombes* (1927) 44. R. P. C. 305 & 45. R. P. C 237.

the suit to go out of the Warning List and be again placed in it on a certain date, or for the suit to remain in the Warning List but not to come into the Hearing List before a certain date, or for a specific date to be fixed some time distant on which the suit is to be placed in the Hearing List at the top of the list subject to any part heard suit; or some such convenient order. If however the other side fails to attend for the mentioning after receiving such a letter, then there will be nothing for it but to issue a Summons to appear in Chambers, and to make a Chamber Application for the required adjournment. In any case if the adjournment is wanted on grounds of illness of a party or a witness, the request for adjournment should be supported, where possible, by a doctor's certificate annexed to a short affidavit.

If it should be that the cause of the party requiring the adjournment has occurred at the last minute, and it has been impossible to mention the matter or make any application prior to the suit being called on for hearing, the application may be made orally in Court on the suit being called on, but it is more than likely that, even if the adjournment is granted, the party applying may be ordered to pay the costs of the day. As these may amount in many cases to Rs. 1000 or more, it is particularly advisable that if an adjournment is even likely to be required, the mentioning or the application therefor should be done early and before the suit reaches the hearing list.<sup>4</sup>

### 3. Onus.

As to proof of his title to the patent and as to proof of the infringement alleged, the onus is on the Plaintiff.

As to proof of the invalidity or validity of the Patent, there have, in England, been conflicting decisions as to where the onus lies. The general practice in England is for the Plaintiff to be required to discharge the onus of making a *prima facie* case as to validity in respect of novelty, utility and sufficiency.<sup>5</sup> It has been doubted whether proof of even such *prima facie* case is strictly

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<sup>4</sup> As to an application for adjournment pending the decision of a question in another proceeding see Part IV above.

<sup>5</sup> See *British Thomson-Houston Co. Ltd. v. Charlesworth Peebles & Co.* (1923) 40. R. P. C. 426 at p. 456.

necessary : see *Weber v. Xetal Products Ltd.*<sup>6</sup> The Plaintiff is not required to make even a *prima facie* case as to validity in respect of showing that there has been no abuse of the monopoly (i.e. as to an issue of non-manufacture or manufacture outside the United Kingdom) ; nor as to an issue of leave and licence granted to the Defendant.<sup>7</sup>

After the Plaintiff has made his *prima facie* case of validity for novelty, utility and sufficiency, it is then for the Defendant to discharge the onus of proving the invalidity alleged in accordance with his particulars of objections : whether these be framed for want of novelty, want of utility, or want of sufficiency, or otherwise. Thus the onus of specific instances of prior user is on the Defendant.<sup>8</sup> The Plaintiff can call evidence in rebuttal. Such evidence has in one case been admitted even after the hearing.<sup>9</sup> Evidence to contradict such rebutting evidence has in some cases been allowed.<sup>10</sup>

If the alleged invalidity is alleged to be on the ground that the Patentee was not the true and first inventor, or on the ground of an abuse of the monopoly, alleging non-manufacture or manufacture abroad, the onus is on the Defendant as to these matters from the first.<sup>11</sup>

As to proof of a defence of leave and licence granted to the Defendant, the onus on such an issue is on the Defendant from the first.<sup>12</sup>

It needs only to be observed that the fact that the onus is on the Defendant to establish a certain issue does not mean that he

<sup>6</sup> (1933) 50. R. P. C. 211 at p. 212.

<sup>7</sup> See *Fletcher Moulton* (1913 : Edn.) p. 188 note (c).

<sup>8</sup> See *Dick v. Tullis & Son* (1896) 13. R. P. C. 149 at p. 162.

<sup>9</sup> See *Boyd v. Horrocks* (1888) 5. R. P. C. 537.

<sup>10</sup> See *Beno Jaffe und Darmstaedter Lanolin Fabrik v. John Richardson & Co. (Leicester) Ltd.* (1894) 11. R. P. C. 93 and at p. 261 (C.A.) ; also see *Blakey & Co. v. Latham & Co.* (1889) 6. R. P. C. 29 at p. 36 but see *Penn v. Jack* (1866) 14, L. T. 495. As to want of utility see *Minter v. Wells* (1834) W. P. C. 127 ; and *Easterbrook v. G. W. R. Co.* (1885) 2. R. P. C. 201.

<sup>11</sup> As to the onus on the issue of true and first inventor see *Nichals v. Ross* (1849) 8. C. B. 679 ; *Pilkington v. Yeakley* (1901) 18. R. P. C. 459 ; *Ward Bros. v. Hill* (1901) 18 R. P. C. 481 at p. 490 ; *Kelvin v. Whyte Thomson & Co.* (1908) 25. R. P. C. 177 ; *Young v. White* (1854) 23. L. J. Ch. 190 at p. 196.

<sup>12</sup> See *Fletcher-Moulton* (1913 : edn.) p. 188.

must necessarily call his own evidence to do so : it is always open to him, if he can, to prove his case by cross-examination of the Plaintiff's witness, if called, if he can sufficiently discharge the onus in that way.<sup>13</sup>

It is submitted that on the question of onus similar principles to those above mentioned as having been followed in England will be followed also in India.

#### 4. The right to begin and the right to reply.

The right to begin is in India regulated by Order 18, Rule 1 of the Civil Procedure Code : see also Order 18, Rules 2 and 3. The position in Patent suits does not differ from that in other suits. The rules of procedure as to this under the Indian Civil Procedure Code moreover do not differ from the English practice, though there is no precisely corresponding rule in the Rules of the Supreme Court in England. The right to begin depends upon where the onus in the suit lies ; and is dependent on the Rules of Evidence contained in the Indian Evidence Act Sections 101 to 104 which determine where the burden of proof lies.

The right to begin is less important in a non-jury trial such as a Patent suit than in a jury case. It may only be important for tactical reasons. Thus if it is considered by one party that he may be able to make his case from the cross-examination of a witness of the other party and then will not need to call certain witnesses on his side, it may be important to force the other party to begin ; so as to know soon enough whether the other side will call the particular witness or not. Or, as the right to begin carries with it a right to the last word, it may be considered important in a particular case for that reason.

The right to begin under the Indian Procedure for the normal course of the hearing of the suit, does not give the party having the right to begin a right to an extra (that is to say third) speech, as appears to be the case in England.<sup>14</sup>

The general practice in England is that the Plaintiff in an infringement suit usually begins : and this even though the

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<sup>13</sup> See *Saccharin Corporation Ltd. v. National Saccharin Co. Ltd.* (1911) 28. R. P. C. 291.

<sup>14</sup> Compare the sequence of events given in Order 18, Rule 2 of the Indian Civil Procedure Code with the sequence mentioned in the notes to Order 36, Rule 36 of the 1935 English Annual Practice.

onus of proving invalidity is on the Defendant.<sup>15</sup> But in certain cases the Court may depart from the general sequence of events for the course of the hearing : as by hearing the evidence of the Defendant's process before the Plaintiff closes his case. In a case where infringement was admitted and the onus of proving invalidity by prior user was on the Defendants, the Court in England gave the Defendants the right to reply on the question of invalidity but reserved for the Plaintiffs a right to reply, if necessary, generally on the whole case.

It is submitted that in India in a case where the onus of proving invalidity is on the Defendant the Plaintiff may either refuse to begin at all, or, if he does begin, may wait to give his evidence on invalidity by way of answer to the Defendant's evidence ; as is provided by Order 18, Rule 3 of the Code of Civil Procedure.

#### 5. Whether a party is entitled to a decision on all points.

The accepted view in England is that it is entirely within the discretion of the Court whether it will determine a question between the parties not actually necessary for the decision of the suit before it. In one case the House of Lords has refused to decide whether further claims have been infringed after holding that the Patent was bad in regard to one claim. In another case the Court refused to decide the issue of infringement where it had held that the Patent was invalid.<sup>16</sup>

On the other hand in another case the House of Lords heard arguments and decided the point of substance between the parties even though it was of the view that the action had been wrongly constituted.<sup>17</sup>

It is submitted that in India in a Court of first instance, it will be found preferable in most cases if the Court decides all substantial points between the parties : not to do so may lead to much waste of money in costs in the event of the decision of the Court of Appeal necessitating a fresh hearing of the suit.

<sup>15</sup> See *Terrell* (8th edn. ) p. 424 ; *Fletcher-Moulton* (1913 edn.) p. 186.

<sup>16</sup> See *Fletcher-Moulton* (1913 : edn.) p. 186 ; and *Parkinson v. Simon* (1895) 12. R.P.C. 403 (H. L.) ; *Tubeless Pneumatic Tyre and Capon Heaton Ltd. v. Trench Tubeless Tyre Co. Ltd.* (1899) 16. R.P.C. 291.

<sup>17</sup> See *Dudgeon v. Thomson* (1877) 3. A.C. 34 ; *Thorsten Nordenfolt v. Gardner* (1884) 1. R.P.C. 61. (C. A.).

## PART V

MATTERS RELATING TO THE FINAL RELIEFS  
OBTAINABLE IN THE SUIT.

## 1. Final Injunction

As to the nature of the remedy : its extent : not perpetual.

Since the Patentee only has a monopoly for a limited period, and since one of the basic conditions, on which that monopoly is given to him, is, that he will in his specification give sufficient instructions, so that all the public may be enabled to have the benefit of his invention after that period, he will in a suit for infringement, broadly speaking, only be entitled, for the purpose of restraining infringement, to an injunction limited to the period of the currency of his monopoly.

At the same time it has been suggested that a sale after the expiry of a Patent of articles manufactured during the currency of the Patent (if the articles are such that the sale thereof during the currency of the Patent would have been an infringement) might in itself be infringement.

If this is so, then it would appear to be reasonable that the injunction ordered should be a perpetual injunction in the sense that it might perpetually restrain the sale of articles manufactured during the currency of the Patent. It would not however be perpetual in form in regard to the restraint of manufacture.

It appears that formerly in England it used to be the practice in infringement suits to issue injunctions in that perpetual form in regard to the restraint on sale.<sup>1</sup>

Now however the restriction of any sale afterwards of articles manufactured during the currency of the Patent is effectively ensured by the order commonly made for delivery up or destruction of infringing articles. This being so, there is clearly no need for the injunction in any respect to be in the form of a perpetual injunction.

It has been held that an injunction which was not stated to be either expressly perpetual or expressly limited to the period of the currency of the Plaintiff's Patent must be interpreted to be for the currency of the Patent only.<sup>2</sup>

<sup>1</sup> See page 780 below.

<sup>2</sup> See *Daw v. Eley* L. R. 3 Eq. 496 at p. 508.

### As to the form of the final injunction.

A final injunction in an infringement suit in British India is commonly granted in the following form :—<sup>3</sup>

And it is further ordered and decreed that an injunction be and the same is hereby awarded against the Defendants restraining them, their respective servants and agents during the continuance of the Plaintiff's Indian Letters Patent No.——dated——mentioned in the Plaint in this suit, from importing into British India, indenting for, distributing, advertising, offering for sale, selling, supplying, dealing in or otherwise using within British India goods (stating the nature of the goods), not being goods manufactured by the Plaintiff Co., or its licensees, manufactured according to or in the manner described in the Specifications of the invention protected by the said Indian Letters Patent No.——or made according to or in any manner only colourably differing from the same, and generally from infringing the rights of the Plaintiff Co. in respect of the said Letters Patent.

### Where certain only and not all claims are infringed.

Even if it be positively established at the hearing that the Defendant has not infringed certain of the claims but only some and not all, the Plaintiff will none the less be entitled to an injunction. And such injunction will still be granted in the same general form without being restricted to those claims only which have been shown to have been infringed.<sup>4</sup>

### As to a stay of the injunction where the Defendant appeals.

In special circumstances an order that the injunction shall not become operative until an appeal filed by the Defendant has been decided, may be obtained. Thus in *Leeds Forge Coy. Ltd. v. Deighton's Patent Flue and Tube Coy., Ltd.*<sup>5</sup> on the ground that the Defendant Company had a very large works employing something like 70 men and the whole establishment would be stopped at once and the men would have to be dismissed, if the injunction was not stayed, the Court of first instance at the time of delivering judgment made an order that the injunction should be suspended for a short time up to a fixed date to allow sufficient time to enable the Defendant to present their Appeal and to apply to the Court of Appeal. Cozens

<sup>3</sup> The ordinary form in England is stated in Terrell to be as follows :—"That the Defendants, their servants and agents be restrained from infringing the Plaintiff's Letters Patent No.——during the continuance thereof or any extension thereof."

<sup>4</sup> See *Mergenthaler Linotype Co. v. Intertype Ltd.* (1926) 43 R.P.C. 239 (C.A.) at p. 275.

<sup>5</sup> (1901) 18 R. P. C. 233 at p. 240.

Hardy J. in adopting this course observed :—"I certainly do not feel disposed to grant a stay which would probably, having regard to the state of business in the Court of Appeal, suspend the injunction for a twelve-month. I do not think that would be right. The Court of Appeal may think right to do it, or they may advance the appeal." In that case when the case came before the Court of Appeal afterwards, an order was made by consent staying the injunction pending the appeal on terms arranged between the parties.

So also in *Bonnard v. London General Omnibus Limited*<sup>6</sup> where the appeal of the Plaintiffs' was allowed and an injunction was ordered by the Court of Appeal, the Appellants having intimated that they were willing that the injunction should be stayed for a reasonable time and in the event of an appeal to the House of Lords that it should be stayed until the hearing of the appeal, the Court of Appeal not only stayed the injunction, but made it clear that the suspension of the injunction was meant to allow the Defendants freedom pending the appeal to fit the contrivances in question on their buses and to put new buses so fitted on the Streets without any restriction. The material portion of the order made in that case was as follows :—

"This court doth order that the said judgment be reversed. And it is ordered that the Defendants, The London General Omnibus Company Limited, their servants and agents be restrained from infringing the Letters Patent No. 24357 of 1912 in the Statement of claim mentioned. But this injunction is suspended until the 21st day of December 1919. (The order then dealt with matters relating to the Certificate and the Inquiry as to damages and Costs and proceeded). But it is ordered that if on or before 21st of December, 1919, the Defendants give Notice of Appeal to the House of Lords from this order, the injunction be suspended until after such Appeal shall have been heard by the House of Lords....."<sup>7</sup>

But in *Lanston Monotype Corporation Ltd. v. Martin J. Slattery*<sup>8</sup> the suspension prayed for of the injunction was refused (on the

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<sup>6</sup> (1919) 36. R. P. C. 307 at p. 325.

<sup>7</sup> See also *British Thomson-Houston Company Ltd. v. British Insulated and Helsby Cables Ltd.* (1924). 41. R. P. C. 345 at p. 375 where there was at the time of judgment, in the Court of first instance, a stay of the injunction by consent on the terms that there would be a stay for a fortnight and if the Defendants within that time gave notice of appeal and paid £10,000 into Court, then there should be a stay pending the appeal.

<sup>8</sup> (1925) 42 R. P. C. 366 at p. 396.



ground that the Defendant was not himself a manufacturer and would therefore not be grievously prejudiced by its operation pending the appeal). And in *Samuel Parker & Coy., Ltd. v. Cocker Bros. Ltd.*<sup>9</sup> it was held to the effect that in view of the absence of special reasons the injunction would not be suspended during the pendency of any appeal.

## 2. Damages.

As to the option of the Plaintiff to have either damages or an account of profits.

In India, under the current Indian Patents and Designs Act of 1911, a Plaintiff who is successful in an infringement suit has the right at his option either to a decree for damages or to an account of profits.

The right to damages he has on general principles as a consequence of the infringement by a Defendant of a legal right of the Plaintiff. See *Davenport v. Rylands*.<sup>10</sup>

The right to an account is expressly given to him under Section 81 of the Indian Act. This section which is, word for word, the same as Section 34 of the English Patents and Designs Act of 1907 as it existed prior to the amendment made therein in 1919, is as follows :—

"In a suit for infringement of a patent, the Court may, on the application of either party, make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit."

The Plaintiff is bound before judgment to exercise his election which of the two remedies, damages or an account of profits, he wishes to have. See *Betts v. Neilson*<sup>11</sup> and see Fletcher Moulton at pp. 193 and 194 (note z).

The position in England since the 1919 amendment is different ; since under the current English Section 84 it is expressly provided that a Plaintiff shall not be entitled in any case to an account of profits : See also *Terrell* (8th edition 1934) at p. 430.

As to the distinction between damages and profits.

If the Plaintiff elects to have an account of profits, he will then be considered as treating the Defendant, the wrongdoer, as his

<sup>9</sup> (1920) 46. R. P. C. 241.

<sup>10</sup> (1865) L. R. 1. Eq. 302.

<sup>11</sup> (1866) L. R. 5 H. L. 1.

agent; and against the Defendant on this basis he will be entitled to all profits made by the Defendant in respect of the infringing articles. On this basis the extent of the loss suffered by the Plaintiff—or whether he has suffered any loss or not—will be immaterial. All that matters is the extent of the profit made by the Defendant.

And conversely if the Plaintiff elects to have damages, the extent of the profits made by the Defendant—or whether he has made any at all, or whether he has made a loss—will be immaterial. All that then matters is the extent of the damages suffered by the Plaintiff.<sup>12</sup>

**As to the circumstances in which a decree for damages may be obtained.**

Since, as already indicated, any infringement of a Patent is a breach of a statutory and legal right, any infringement when established will entitle the Plaintiff to a decree for damages: even if only for nominal damages.<sup>13</sup>

The extent of the damages recoverable will be governed by the ordinary general principles of law and rules of causation as in non-patent cases. See *United Horse Shoe & Nail Coy., Ltd. v. Stewart & Co.*<sup>14</sup>

**As to the extent of the period before Suit over which damages or profits may be claimed and calculated.**

In British India the period over which damages or profits may be claimed would appear to be restricted to the period of three years immediately preceding the date of the institution of the suit; being the period of limitation.<sup>15</sup>

**As to the measure of damages if the Plaintiff does not himself manufacture.**

The extent of the damages directly suffered by the Plaintiff by

<sup>12</sup> (1888) 13 A. C. 401 or 5 R. P. C. 280 (H. L.) at page 267.

<sup>13</sup> See *Davenport v. Rylands* (1865) L. R. 1 Eq. 302.

<sup>14</sup> (1888) 13. A. C. 401 (H. L.).

<sup>15</sup> See page 702 above, and Article 40 and Article 89 of the Indian Limitation Act (Act 9 of 1908). The period in England is six years see *Terrell* (8th edn: 1934) p. 442; *Fletcher Moulton* p. 196 note (k) citing *Crossley v. Derby Gas Light Co.* (1839). W. P. C. 119.

reason of the infringement may differ according to whether he is or is not himself a manufacturer.

In a case where the Plaintiff is not himself a manufacturer, it will happen in most cases where the Plaintiff is at all in the position of claiming any substantial damages, that he will have entered into some agreements with some persons for licences and for the payment to him, under such licences, of royalties. When this is the case, damages will ordinarily be claimed and granted on a calculation of the amount of royalties the Plaintiff would have received if the Defendant had paid royalties for all infringing articles dealt with.

**As to the measure of damages if the Plaintiff is himself a manufacturer.**

In a case where the Plaintiff is himself a manufacturer, the calculation of the proper amount of damages recoverable may be a more intricate matter.

It has been held that the Plaintiff may recover in a proper case both for loss of such manufacturing profits as he would have made, if the Defendant had not sold the infringing goods, and the Plaintiff had sold either the whole quantity in fact sold by the Defendant or such a proportion of them as the Plaintiff taking all circumstances into account might according to reasonable probability have sold; and that the Plaintiff may also in a proper case recover for loss due to reduction of prices of the Plaintiff's goods necessitated by the competition of the Defendant in the infringing articles.

**As to the effect of a decree for damages in respect of the infringing goods.**

If the damages which have been decreed have been calculated as they should be, so as to be such as to put the Plaintiff into the same monetary position as that in which he would have been, if there had been no infringement, and if the goods had been sold lawfully under his Patent, then after such a decree any person subsequently buying the goods in suit will be free to deal with them just as if they had bought them lawfully from the Patentee himself. They will not be liable on any claim for infringement for dealing with those goods thereafter. See *United Telephone Coy. v. Walker and Another*<sup>16</sup> and *Peru v. Bibly*.

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<sup>16</sup> (1887) 4. R. P. C. 63 and L. R. 3 Eq. 398.

But in the last mentioned case it was also held that where the Plaintiff had only recovered agreed damages on a basis of royalties for annual hiring, any subsequent use by third parties after the period for which royalties had been recovered would be an infringement.

### 3. Account of Profits :

For the reasons already indicated it may be found to be more profitable for a Plaintiff to elect to have an account of profits in a case where the Plaintiff is not manufacturing or trading himself and the Defendant has established a profitable business in the infringing articles.

It appears that it will be necessary to show that the profits have been made out of the infringing articles. If the Defendant could show that, if he had not used the Plaintiff's patented article there were available equally efficient and satisfactory and profitable other articles (apart from the Patent), which he might have used or dealt in ; and that therefore his profits did not arise directly out of the patented article ; it seems doubtful what, if any, profits the Plaintiff will then be entitled to receive. See *Siddell v. Vickers Sons & Co. Ltd.*<sup>17</sup>

### 4. Order for a reference to ascertain either damages or profits, as the case may be :

**As to the form of the order.**

A common form of order in British India in directing a Reference for an enquiry as to damages or for an account of profits is as follows :—

*And it is further ordered and decreed that the further hearing of this suit be adjourned and that it be referred to the Registrar of this Court, with liberty to him to allocate the reference either to the Official Referee or the Assistant Referee of this Court, to take an account of the profits made by the said defendant—by importing, selling or otherwise dealing with the said goods made in infringement of the Plaintiff Company's said Letters Patent, and that the said defendant—do also allow inspection of all books of account, stock books and other papers and documents as the officer taking the said account shall direct.*

**As to inspection for the purposes of the Reference.**

The Plaintiff is entitled to full discovery and full inspection as if the issue arose in the suit itself, even though this will mean his

<sup>17</sup> (1889) 6 R. P. C. 464 ; and see generally on the point *Fletcher Moulton* at p. 195 ; in particular as to the position if the Plaintiff desires to prove in the insolvency of the Defendant.

seeing the Defendant's books of account and requiring information, as to the names of the Defendant's customers.<sup>18</sup>

**As to a stay of an enquiry as to damages or of an account of profits where the Defendant appeals.**

In certain circumstances an order that the order for the enquiry or the account, as the case may be, will not be operative, until an appeal filed by the Defendant has been disposed of, may be obtained.

And in *Craig v. Dowding*<sup>19</sup> ( a threats action ) a stay was so granted. On the other hand in certain cases a stay has been refused.

The present practice of the Court of Appeal in the Calcutta High Court is to incline to refuse to make any Order for a stay in the absence of specially cogent reasons showing why the Defendant will be grievously prejudiced by the Reference going on.

#### **5. Order for delivery up or destruction of stocks.**

**As to the nature of the remedy. Additional to damages :**

This remedy originated, it seems, as a subsidiary means of making effective an order for an injunction granted in an infringement suit ; since such injunctions, it seems, were originally granted in the form of perpetual injunctions restraining the Defendant for all time from selling infringing goods made during the currency of the Patent.<sup>20</sup>

If the principle, previously noted as having been adopted in *Pessers Moody, Wraith and Gurr Ltd. v. Newell & Co.*,<sup>21</sup> is correct, that mere possession is not an infringing act, where the Defendant does not intend to use or deal in the article until after the expiration of the Plaintiff's Patent, it is somewhat difficult to see why a Defendant should not in some cases be entitled on the same principle to keep or store the infringing articles until after the expiration of the Plaintiff's Patent. However in any infringement suit in which a Plaintiff has succeeded in showing that there has been

<sup>18</sup> And see page 742 above.

<sup>19</sup> (1908) 25 R. P. C. 1 at p. 9.

<sup>20</sup> See *Terrell* (8th edition : 1934) p. 445 citing *Crossley v. Beverley* 1. W. P. C. 119 ; also *Seton Judgments* 7th Edition at p. 630.

<sup>21</sup> (1914). 31. R. P. C. 510 ; and see page 562 above.

actual infringement, it appears that the Plaintiff is now regarded as entitled in law to an order on the Defendant for delivery up or destruction of the infringing articles in all cases.

This remedy has now, it appears, come to be one of the reliefs to which a Plaintiff is entitled in any infringement suit in which he succeeds.

This remedy is additional to, and not in any sense an alternative to, the remedy for damages and the remedy of an injunction. Thus it has been held in England that the value of the articles delivered up is not to be deducted from the damages decreed.<sup>22</sup>

Where the infringing parts are severable from the rest of the apparatus dealt in, the modern practice in England is to restrict the order for delivery up of infringing articles to the delivery up of the infringing parts only.<sup>23</sup>

Where the Patent is for a combination so that the use of the parts separately is no infringement, there will be no order for delivery up, but merely that the parts in question be dismantled from the combination.<sup>24</sup>

#### As to the form of the Order :

The order is usually made in such a form as to give the Defendant the choice of delivery up or destruction.<sup>25</sup>

The order will usually also include a direction on the Defendant to make discovery upon oath stating what infringing goods are in his possession.<sup>26</sup>

#### As to a stay of the order for delivery up where Defendant appeals.

In view of the inconvenience which will have been caused to a Defendant if he is made to deliver up all infringing articles during the pendency of an appeal in a case where he afterwards succeeds on his appeal, it is not uncommon for an order to be obtained that the order for delivery up shall be inoperative until after the decision of an appeal filed by the Defendant.<sup>27</sup>

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<sup>22</sup> *United Telephone Coy. v. Walker* (1887) 4 R. P. C. 63.

<sup>23</sup> See *Fletcher Moulton* p. 198.

<sup>24</sup> *Ibid.*

<sup>25</sup> See *British Westinghouse Mnsfy. Co. Ltd. v. Electrical Coy.* (1911) 28 R. P. C. 517 at p. 530.

<sup>26</sup> See *British Thomson-Houston Coy. Ltd. v. Irradiant Lamp Works Ltd.* (1923) 40 R. P. C. 243.

<sup>27</sup> See *Lancashire Explosives Co. v. Roburite Explosives Co.* (1895) 12 R. P. C. 470.

## 6. Certificate of Validity :

**As to the nature of this relief and the effect of a Certificate.**

By Section 32 of the Indian Patents and Designs Act it is provided as follows :—

“In a suit for infringement of a Patent the Court may certify that the validity of the Patent came in question, and if the Court so certifies, then in any subsequent suit in that Court for infringement of the same Patent the Plaintiff, on obtaining a final order or judgment in his favour, shall, unless the Court trying the suit otherwise directs, have his full costs, charges and expenses of and incidental to the said suit properly incurred.”

The wording of this Section corresponds with that of Section 35 of the English Patents and Designs Act of 1907 except that the words in the English Act, “as between solicitor and client”, do not appear in the Indian Act. The wording of the English Sec. 85 under the current English Patents and Designs Act 1907-1932 is also to the same effect as the English Act of 1907, except that it has included in it an additional provision by which it is expressly made clear that in a case where the validity of any one claim has come in question, the Court may grant a certificate restricted to a single claim or to certain specific claims. Sec. 32 of the current Indian Act has no such specific provision. It is submitted nevertheless that it will be open to a Court in its discretion to issue a certificate restricted to certain specific claims, if it thinks fit, even under the Indian Act.<sup>28</sup>

It is submitted also that the general term “full costs of and incidental to the said suit properly incurred” will cover costs as between Attorney and Client under the Indian Act also.

It is to be observed that the certificate above referred to in the Act, though commonly referred to as a “certificate of validity”, is only improperly so termed ; being only in truth a certificate that the “validity of the Patent has once previously been questioned”. It is

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<sup>28</sup> For authority that this will be so, see *Badische Anilin und Soda Fabrik v. La Societe Chimiques des Usines du Rhone and another* (1897) 14 R. P. C. 875, a case under the English Act of 1907 prior to the new existing English amendment.

not in any sense a certificate such as to declare to all the world that the Patent is valid.<sup>29</sup>

The certificate cannot be treated in any way as a piece of paper having the effect of a judgment *in rem*, which the Patentee may wave in the face of any person whom the Patentee thereafter claims to be an infringer, so as to preclude such person from questioning the validity in law of the Patentee's Patent. It is a certificate which affects nothing except, in certain circumstances, the costs of a subsequent infringement suit in the event of the Patentee having to bring such a suit either against the same or any other person.<sup>30</sup>

This certificate does not moreover affect in any way the costs of the suit in which it is granted.<sup>31</sup>

As to the Practice regarding the grant of the certificate.

The certificate is only granted in practice where the Patentee has succeeded on the issue of the validity of his Patent. Though, as already observed, it may be enough that he has only succeeded as to this in respect of one, or certain, and not all, of the claims of his specification. If the issue of validity has been tried and decided in favour of the Plaintiff, it would seem that he is none the less entitled to a certificate even though he may have failed to succeed on other issues, or, for example, may have failed finally in the suit by reason of having failed on the issue of infringement.<sup>32</sup>

According to the English practice the Plaintiff will in the subsequent suit be given his costs as between Solicitor and Client as

<sup>29</sup> It has been directly decided in England that an action does not lie for a declaration that a Patent is invalid : see *North-Eastern Marine Engineering Co. v. Leeds Forge Co.* (1908) 23 R. P. C. 529 (C. A.) ; *Traction Corp'n. v. Bennett* ('908) 25 R.P.C. 819 at page 822 ; *Killen v. Mac Millan* (1932) 49 R. P. C. 258 at p. 260.

<sup>30</sup> That this is clear is shown by the fact that in one case it appears that a certificate that the validity of the Patent came in question was granted (to the Plaintiff) although the Patent was held invalid, but the course adopted in that case has never been followed : See *Haslam Co. v. Hall* (1888) 5 R.P.C. 1 : but see *Acetylene Illuminating Coy. Ltd. v. United Alkali Coy Ltd.* (1902) 19 R. P. C. 213.

<sup>31</sup> Concerning Certificates of Particulars of Breaches and Certificates of Particulars of Objections which, if they were to be granted, would affect the costs of the suit in which they were granted, see further, below, under "Costs".

<sup>32</sup> See *Fletcher-Moulton* (1913 edn.) p. 200.



a result of the certificate obtained in the previous suit, even in cases where the issues in the second suit may be different from those in the first, and even in cases where in the second suit infringement only is in issue without any challenge to the validity of the Patent.<sup>33</sup>

It has been held that the costs of an appeal in the original suit in which the certificate is granted are unaffected by such certificate.<sup>34</sup>

It has also been held in England that the costs of a counter-claim for revocation (which in England may be agitated in the same suit as that in which the certificate is granted) are unaffected by the certificate.<sup>35</sup>

It has been held that the propriety of the grant of the certificate in one suit cannot be challenged in another.<sup>36</sup>

**As to cases where the Defendant does not appear, or abandons the defence.**

The question frequently arises (as to the meaning of the words "came in question" in the section) whether a Plaintiff is entitled to this certificate in an undefended suit; or in a suit in which the Defendant abandons the defence.<sup>37</sup>

It appears to be the modern practice in England, on the Plaintiff's calling formal evidence to prove the validity of his Patent in a case where the Defendant does not appear, for the Court to grant the Certificate that the validity of the Patent came in question. See *Descombes and Arondel v. Lestor and Parton*.<sup>38</sup>

<sup>33</sup> See *Fletcher Moulton* p. 201 note (s).

<sup>34</sup> *Incandescent Gas Light Coy. Ltd. v. De Mare Incandescent Gas Light System Ltd.* (1896) 13 R. P. C. 559 at p. 579 (C.A.).

<sup>35</sup> *British Vacuum Cleaner Coy. v. L. & S. W. Rlwy Coy.* (1910) 27 R. P. C. 649 at p. 670.

<sup>36</sup> *Peter Pilkington Ltd. v. Massey* (1904) 21. R. P. C. 697.

<sup>37</sup> There appears formerly to have been some divergence in the decided cases as to the earlier English practice. See *Fletcher Moulton* p. 199 where a list of the English cases complete up to the date of the publication of that work (1913) is given.

<sup>38</sup> (1931) 48. R. P. C. 473. See also *British Thomson-Houston Coy. Ltd. v. Corona Lamp Works Ltd.* (1922) 39 R. P. C. 49 at p. 93 where the question of the grant of a certificate and its consequences were fully discussed.

### As to the Discretion of the Court.

It is to be observed from the inclusion in the section of the words "unless the Court trying the suit (that is the subsequent suit) otherwise directs", that even where a certificate may have been obtained in a previous suit, the Court hearing the subsequent suit still has a discretion in the matter ; and may decide in spite of the previous certificate not to grant to the Plaintiff his costs as between Attorney and Client.

Therefore if the subsequent suit turns out to be the really substantial suit, and not the earlier suit in which the certificate was granted, it will always be open to the Court in exercising its discretion to refuse to grant to the Plaintiff his costs as between Attorney and Client in spite of any previous certificate.<sup>39</sup>

### Appeal.

It is submitted that the Court of Appeal will be entitled to grant or refuse the certificate in its discretion in accordance with such decision as it may come to, irrespective of the order of the Court below : just as it is entitled generally to exercise its discretion afresh as to its orders in other respects regarding costs in general.

It has been held in England that there is no appeal against the grant of the certificate alone.<sup>40</sup>

## 7. Costs.

### Generally.

The costs of a suit for infringement in British India will be disposed of according to the general principles relating to costs in all suits.<sup>41</sup>

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<sup>39</sup> See *British Thomson-Houston Coy. Ltd. v. Corona Lamp Works Ltd.* (1922) 39 R. P. C. 49 at p. 93, where Solicitor and Client costs were refused in spite of a previous certificate in a case where such certificate had been granted in a suit in which a defence had been put in but the Defendants at the hearing had not appeared ; also *Auster Ltd. v. Perfecta Motor Equipments Ltd.* (1924) 41 R. P. C. 482 at p. 498.

<sup>40</sup> *Haslam Co. v. Hall.* (2) (1888) 5 R. P. C. 144.

<sup>41</sup> In England there are certain special provisions contained in Order 53 A, Rule 22 of the English Rules of the Supreme Court regarding Certificates as to Particulars of Breaches to be obtained by Plaintiffs and Certificates as to Parti-

Where a Defendant has offered before suit an undertaking not to infringe, this does not disentitle the Plaintiff, ordinarily, from his right still to go to the Court to obtain a formal injunction in the form of a decree. But in a recent case, *Calico Printers v. D. N. Mukerjee* (a design case), where the Defendant had offered what was held to be an unconditional undertaking before the hearing, it was held by Lord Williams J. that the Plaintiff should not have gone on with the suit, but should have asked for judgment in the form of an order embodying the undertaking ; and in that case, while an injunction was granted in favour of the Plaintiff, the costs after a certain date were ordered to be paid by the Plaintiff.<sup>42</sup>

**As to costs as between Attorney and Client.**

An order for costs on a scale to include all costs actually properly incurred between Attorney and Client may be obtained by a successful Plaintiff, as already indicated, in cases where he has in a previous suit obtained a certificate of validity questioned under Sec. 32.

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culars of Objections to be obtained by Defendants, and to the effect that a party cannot recover any costs on any issue for which he has not obtained such a Certificate. There is no provision for the obtaining of any such Certificates in British India, nor, naturally, any prohibition against recovery of costs if such certificates be not obtained.

<sup>42</sup> (1936). 40. C. W. N. 938.

## PART VI

### FURTHER PROCEEDINGS SUBSEQUENT TO THE DECREE IN THE INFRINGEMENT SUIT.

#### 1. Application for stay of execution.

Any application for stay of execution, whether made to the Court of first instance at the time judgment is delivered, or whether made to the Court of Appeal thereafter, will be, generally speaking governed by the same principles and rules as in any non-patent suit. Terms as to the furnishing of security or otherwise may be imposed as a condition of the grant of such a stay. Similar terms may also be imposed on the Defendant.

In regard to a stay of an order for an injunction, or of an order for inquiry as to damages, or for a reference for an account of profits, or of an order for delivery up or destruction of infringing articles certain observations have already been made earlier in part V of this chapter, to which reference may be made as necessary.<sup>1</sup>

#### 2. Appeal.

The right of either party to appeal, and the procedure in connection with the disposal of any Appeal which may be filed, will, in all general respects, be the same as in any non-patent suit; and calls here for no further comment.

#### 3. Execution proceedings.

In the event of its becoming necessary to take legal proceedings in execution of the decree in order to compel compliance therewith on the part of the opposite party, such proceedings in execution are in all respects the same as in any non-patent suit, being governed by the rules laid down in the Code of Civil Procedure. They call here for no further comment.

#### 4. Contempt proceedings by motion for breach of an injunction granted in an infringement suit.

If in an infringement suit the Plaintiff has obtained an injunction restraining the Defendant from infringing the Plaintiff's Patent, and if thereafter the Defendant in breach of that injunction again infringes the Patent, the proper course for the Plaintiff will be, not

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<sup>1</sup> See pages 774, 780, and 781 above.

to file a fresh suit for infringement, but to institute proceedings for contempt on account of the breach of the injunction already obtained.<sup>2</sup>

On such motion further damages may also be asked for.<sup>3</sup>

**As to cases where the second mode of infringement is not the same as the original infringement which gave rise to the injunction.**

It will be immaterial whether the acts complained of as a Contempt of Court are the same or different from the acts complained of in the original suit. The only question will be whether the acts complained of as being a Contempt of Court are a breach of the injunction granted or not.

**As to proceedings against a person who was not a party to the original suit.**

Where in a suit for infringement an injunction has been issued against the Defendant and against the servants and agents of the Defendant, proceedings by way of motion to commit for Contempt of Court may in certain circumstances be successfully brought even against a person who was not the Defendant and was not himself a party to the original suit in which the injunction was granted ; provided it is clearly and positively established that such a person is a servant or agent of the person enjoined, and that he has himself had knowledge of the existence of the injunction, and in spite of that knowledge has aided and abetted in the breach of the injunction.<sup>4</sup>

**As to the liability in contempt of Directors personally.**

In the case of a breach of an injunction by a limited company it has been held in the English cases that an order for sequestration may be issued as well as orders for committal or attachment against the Directors.<sup>5</sup>

<sup>2</sup> See *Lancashire Explosives Coy. Ltd. v. The Roburite Explosives Coy. Ltd.* (1896) 13 R. P. C. 429, at pp. 440 and 441.

<sup>3</sup> *Ibid* at p. 433.

<sup>4</sup> See *Incandescent Gas Light Co. v. Thomas Sluce* (1900) 17. R. P. C. 173 (C. A.) at pp. 174-177 ; also *Seaward v. Paterson* (1897) 1 ch. 545 also *Dulgeon v. Thomson* (1877) 3 A.C. 34 H. L. and see *Oswald on Contempt, Committal and Attachment* (3rd. edn.) at p. 106.

<sup>5</sup> See *Spencer v. The Ancoats Vale Rubber Coy. Ltd.* (1889) 6 R. P. C. 46 : *Hattersley & Sons Ltd. v. Hodgson Ltd.* (1905) 22 R.P.C. 229. Where it is a

**As to cases where the Patent has been amended since the injunction.**

It would seem that under the current Indian Act, at least, an application by motion to commit for contempt will not lie in a case where the Patent has been amended since the injunction. It has been held that in truth the amendment in such a case dissolves the injunction.<sup>6</sup>

**As to the form of the order to be made.**

Not infrequently the Court merely makes an order against the Defendant to pay the costs of the Motion and to make monetary compensation to the Plaintiff.

An order for committal will only be made in cases of wilful disobedience of the order of the Court embodied in the injunction.<sup>7</sup>

company which has disobeyed the injunction obtained against it, the Plaintiff, if he prefers to take the remedy open to him by way of proceeding in execution rather than, or alternatively to, contempt proceedings, may enforce the injunction in execution by attachment of the company's property or by detention in the civil prison of the Directors, or both, under the provisions of Order 21, Rule 32 (2) of the Civil Procedure Code.

<sup>6</sup> See *Dudgeon v. Thomson* (1877) 3 A. C. 34. The position under the current English Patents and Designs Act 1907-1932 appears to be different owing to the amendment of the English Sections 21 (7) and 32A, see *Terrell* (8th edn. 1934) p. 437.

<sup>7</sup> *C.f.* also *Meters Ltd. v. Metropolitan Gas Meters* (1907) 24 R. P. C. 506.

## CHAPTER XVIII

### OTHER REMEDIES—THE POWER OF A HIGH COURT IN RESPECT OF THE CONTROLLER OF PATENTS— WRIT OF PROHIBITION—WRIT OF CERTIORARI —WRIT OF MANDAMUS OR MANDATORY INJUNCTION—SPECIFIC RELIEF ACT— INJUNCTION—COSTS.

#### Other remedies : their nature.

In respect of proceedings before the Controller of Patents it may be, in certain special circumstances, that a person aggrieved by an act or omission or decision of the Controller, may have a right to obtain redress by way of proceedings in a High Court in connection with one or other of the Writs known as the "high prerogative writs", or by obtaining a mandatory injunction under the Indian Specific Relief Act (Act I of 1877).

#### Common Law as to the High Prerogative Writs.

The well known high prerogative writs are in active use in the United Kingdom for the purpose of obtaining justice where this cannot be otherwise adequately obtained. Of such writs, the writ of Habeas Corpus and the Writ of Quo Warranto have no connection with the matters relating to Patents, with which this work is concerned ; but the Writ of Certiorari, the Writ of Prohibition and the Writ of Mandamus is, each one, a remedy to which resort has in various circumstances been had in England in connection with the administration of the Patent system.

#### The Nature of the Jurisdiction.

Broadly speaking the object of such writs is to prevent the doing of injustice or to ensure the performance of justice where other remedies fail. Such writs are issued upon cause shown, where the ordinary legal remedies are inapplicable or inadequate. The right to such writs exists in the United Kingdom at Common Law independently of any Statute.<sup>1</sup>

See *Halsbury* (Hailsham edn. Art. 1202) ; *Ex Parte Basset* (1834) 6. Q.B. 481.

**Wide exercise of the jurisdiction to issue the writs.**

In a case where the application was for a Writ of Mandamus the following observations were made by Martin B.<sup>2</sup> :—

“Instead of being astute to discover reasons for not applying this great constitutional remedy for error and misgovernment, we think it our duty to be vigilant to apply it in every case to which, by any reasonable construction, it can be made applicable”.

And in the more recent case of *Rex v. North Worcestershire Assessment Committee, ex parte Hadley*,<sup>3</sup> where the application was for a Writ of Prohibition the following observations in equally emphatic terms were made by Lord Hewart C. J. :—

“.....In 1882—Brett, L. J. (as he then was), in *Reg. v. Local Government Board*,<sup>4</sup> said I think I am entitled to say this, that my view of the power of prohibition at the present day is that the Court should not be chary of exercising it, and that wherever the legislature entrusts to any body of persons other than to the superior Courts the power of imposing an obligation upon individuals, the Courts ought to exercise as widely as they can the power of controlling those bodies of persons, if those persons admittedly attempt to exercise powers beyond the powers given to them by Act of Parliament. It is perhaps an under-statement to say that nothing has happened between the year 1882 and the year 1929 to make those observations of Brett L. J. less apt, less well founded, or less desirable to-day.”

It is submitted that this principle of wide application is applicable to all such prerogative writs without distinction.

**The nature of and differences between these Writs.**

It has been said, in effect, of the Writ of Prohibition that its use is to prevent the continuance of proceedings in the absence of, or in excess of, jurisdiction, or in contravention of the laws of the land : whether in contravention of some statute or in contravention of the principles of the common law.<sup>5</sup>

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\* *Rochester Corporation v. R.* (1858) E. B. & E. 1024 at p. 1033.

\* (1929) 2 K. B. 397 at p. 405.

\* (1882) 10. Q. B. D. 303 at p. 321.

\* See *Halsbury* (Hailsham edn :) Arts. 1394 & 1397.



It has been said in effect of the Writ of Certiorari that its use is to remove the proceedings of inferior courts or judicial bodies for the purpose of quashing such proceedings.<sup>6</sup>

At the present day for practical purposes the only difference between a Writ of Prohibition and a Writ of Certiorari is one in relation to time. It was observed in one case by Atkin L. J. :—

“The matter comes before us upon rules for Writs of Prohibition and Certiorari which have been discharged by the Divisional Court. Both writs are of great antiquity forming part of the process by which the King’s Courts restrained courts of inferior jurisdiction from exceeding their powers. Prohibition restrains the tribunal from proceeding further in excess of jurisdiction ; Certiorari requires the record or the order of the court to be sent up to the King’s Bench Division, to have its legality inquired into, and, if necessary, to have the order quashed”. “.....I can see no difference in principle between certiorari and prohibition, except that the latter may be invoked at an earlier stage. If the proceedings establish that the body complained of is exceeding its jurisdiction by entertaining matters, which would result in its final decision being subject to being brought up and quashed by certiorari, I think that prohibition will lie to restrain it from so exceeding its jurisdiction.”<sup>7</sup>

In regard to the Writ of Mandamus, in England it has been said that its purpose is “to supply defects of justice.....to the end that justice may be done in all cases where there is a specific legal right and no specific legal remedy for enforcing such right.....”<sup>8</sup>

In British India the rights of any person to a remedy corresponding to the remedy by Writ of Mandamus in the United Kingdom has been codified in the Indian Specific Relief Act : under Section 45.

<sup>6</sup> See *Halsbury* (Hailsham Edn.) Art. 1431.

<sup>7</sup> 1924 I. K. B. 171 at p. 204. See also the judgment of Bankes L. J. in the same case. See also the *King v. Minister of Health, ex parte Davis* 1929 I.K.B. 619, at p. 627.

<sup>8</sup> See *Halsbury* (Hailsham Edn.) Art. 1269.

For this reason it is unnecessary here further to consider the English remedy by Writ of Mandamus at Common Law, since a Writ of Mandamus apart from such injunction as may be obtained under the Indian Specific Relief Act, is not obtainable in British India. As, on the other hand, a Writ of Prohibition or a Writ of Certiorari are under certain circumstances obtainable in British India similarly as they are obtainable in the United Kingdom, it will be useful, in order to appreciate the legal position in British India in regard to these writs, to note the grounds on which it has been held in the United Kingdom that these two writs are obtainable.

First it will be convenient to consider the origin of the power now possessed by each of the High Courts of Calcutta, Madras and Bombay to issue the High Prerogative Writs of Prohibition and of Certiorari.

**Power of certain Courts in British India to issue a Writ of Prohibition or a Writ of Certiorari.**

It has long been established that a Writ of Prohibition or a Writ of Certiorari may in some circumstances be issued by some Courts in British India. The jurisdiction of certain of the High Courts to issue these Writs has been tested and is clearly established.

Whether every High Court, including those recently established, has such jurisdiction may be a matter of some doubt.

It may be that no Court other than a High Court, will have any express jurisdiction or power to issue such Writs : and that a District Court has no jurisdiction or power in this respect. For present purposes it is unnecessary to go into the question how far the principles of the English Common Law may be administered by a District Court, in a case heard before such Court, as being part of the "Justice, Equity, and Good Conscience," which a District Court administers; or how far and in what manner the prerogative of the Crown will be enforced by a District Court. The observations which follow relate primarily to the High Court of Calcutta, where, by reason of its geographical position, any proceedings for the issue of either of the Writs now under discussion may normally be expected to be instituted in cases relating to Patent matters.

The High Courts of Madras and Bombay have precisely similar powers in cases where they have the requisite local jurisdiction.

### The Calcutta High Court.

(i) By Section 13 of the East India Company Act of 1772 (13 Geo. III, c. 63) powers were granted to the Supreme Court at Calcutta as follows :—

“Be it therefore enacted by the authority aforesaid that it shall and may be lawful for His Majesty, by Charter or Letters Patent under the Great Seal of Great Britain, to erect and establish a Supreme Court of Judicature at Fort William aforesaid.....and the same Court is hereby declared to have full power and authority to exercise and perform all Civil, Criminal, Admiralty and Ecclesiastical Jurisdiction and (etc. etc.) and to do all such other things as shall be found necessary for the Administration of Justice and the due execution of all or any of the Powers which by the said Charter shall, or may be granted and committed to the said Court”.

(ii) Then by Clause 4 and Clause 21 of the Charter of 1774 which followed the said Act, being the Charter Establishing the Supreme Court of Calcutta, it was expressly provided as follows :—

#### *Clause 4.*

“And it is our further will and pleasure that the said Chief Justice and the said Puisne Justices shall severally and respectively.....have such jurisdiction and authority as our Justices of our Court of King’s Bench have and may lawfully exercise within that part of Great Britain called England, by the common law thereof”.

#### *Clause 21.*

“And to the end that the said Court of Requests, and the said Court of Quarter Sessions, erected and established, at Fort William in Bengal, by the said charter of our said Royal Grandfather made the twenty-sixth year of his reign, and the Justices, Sheriffs, and other Magistrates thereby appointed for the said districts, may better answer the ends of their respective institutions, and act more conformably to law and justice, it is our further will and pleasure, and we do hereby further grant, ordain, and establish, that all and every the said Courts and Magistrates shall be subject to the order and control of the said Supreme Court of Judicature at Fort William in Bengal, in such sort, manner, and form, as the inferior Courts and Magistrates of, and in that part of Great Britain called England are, by law, subject to the order and control of our Court of King’s

Bench ; to which end, the said Supreme Court of Judicature, at Fort William in Bengal, is hereby empowered and authorized to award and issue a writ or writs of Mandamus, Certiorari, Proce-dendo, or error, to be prepared in manner above mentioned, and directed to such Courts or Magistrates as the case may require and to punish any contempt of a wilful disobedience thereunto by fine and imprisonment”.

This Charter read with the Act of 1772 makes it clear beyond doubt that the old Supreme Court had power to issue writs of Prohibition and Certiorari. The next question then is whether and how that power has been transferred to or inherited by the present High Court.

(iii) The material provision transferring the power of the Supreme Court to the High Court, when the Calcutta High Court was established in 1861, is to be found in Section 9 of the Indian High Courts Act of 1861 (24 & 25 Vict. c. 104) which is worded as follows :—“and.....the High Court to be established in each Presidency shall have and exercise all jurisdiction and every power and authority whatsoever in any manner vested in any of the Courts in the same Presidency abolished under this Act at the time of the abolition of such last mentioned courts.”

It is to be noted that nothing could be clearer than this for the purpose of transferring the powers of the abolished Supreme Court. These same powers have been continued to be given to the High Court of Calcutta in all material subsequent provisions.

(iv) In the Letters Patent of 1865, which followed on the Act of 1861, the reference to the exercise of “its original civil jurisdiction” can only mean that jurisdiction which has been conferred upon it prior to 1865 to the extent already mentioned.

(v) Then in 1915 when certain provisions as to the High Courts were embodied in the Government of India Act of 1915 (5 & 6 Geo. V. c. 61) the same powers were continued as before : it being expressly provided under Section 106(1) as follows :—

“The several High Courts.....have..... all such jurisdiction powers and authority as are vested in those courts respectively at the commencement of the Act,”

And that is the position at the present day. From what has been said, it is thus clear beyond doubt, that the Calcutta High Court to-day has by virtue of the transfer of the powers to it from the old Supreme Court, precisely the same power and jurisdiction to issue a Writ of Prohibition or a Writ of Certiorari as the Court of the King's Bench Division has in London.

### The Madras High Court.

Similar provisions are applicable in the case of the Madras High Court. The material chain of enactments being the following :

(i) Government of India Act of 1800 (39 & 40 Geo. III, c. 79) (Providing for the establishment of a Supreme Court at Madras with powers equal to those of the Supreme Court at Fort William in Bengal).

(ii) Letters Patent dated 26th December 1800. (Establishing the Supreme Court at Madras.)

(iii) Indian High Courts Act of 1861 (24 & 25 Vict. c. 104). (Section 9) (whereby the High Court of Madras inherited the jurisdiction of the Supreme Court at Madras.)

(iv) Letters Patent of the High Court of Madras of 1865.

(v) Government of India Act of 1915. (5 & 6 Geo. 5. c. 61) (Section 106(1)) (Repealing the High Courts Act but continuing the existing power of the Madras High Court.)<sup>9</sup>

### Indian cases showing the existence of this jurisdiction.

In the case of *Nundo Lall Bose v. Corporation of Calcutta*<sup>10</sup>

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\* The question of the immunity of His Excellency the Governor to the process of these High Prerogative Writs, which immunity was originally created by the East India Company Act of 1780 (21 Geo. III, c. 70), restricting—as a result of the clash between the executive and the judiciary in Calcutta—the plenary powers formerly granted to the Supreme Court at Calcutta, and the precise terms of Clause 4 of the Letters Patent dated 25th March 1774 of the Supreme Court at Calcutta, by which those plenary powers had been granted, and the terms of Section 13 of the East India Company Act of 1772 (13 Geo. III, c. 63) which preceded the issue of the Letters Patent, though the same immunity still exists both in regard to the Calcutta High Court and in regard to the Madras High Court (the powers of the Supreme Court of Madras having been created by reference to those of the Calcutta Supreme Court), is for present purposes immaterial.

<sup>10</sup> (1885) 11. Cal. 275.

the following definite pronouncement was made by Garth C. J. (at page 278) in regard to the issue of a writ of certiorari :—

“The authority of this Court to remove the proceedings of inferior courts in the exercise of their judicial functions is undoubted. It is an authority derived from the old Supreme Court and is similar to that which was exercised by the Court of Queen’s Bench in England ; and if the Commissioners (i.e. of the Corporation of Calcutta) in this case were exceeding their jurisdiction in making an assessment, it seems clear that we have the power to quash it upon certiorari”.<sup>11</sup>

And in the recent Calcutta case of *In re National Carbon Co. Inc.*<sup>12</sup> it was similarly held by Panckridge J. that the Calcutta High Court has power to issue a Writ of Prohibition or a Writ of Certiorari in a proper case.

It may be convenient here to note certain references to a line of Madras decisions culminating in certain recent cases, where it was similarly held that the Madras High Court had the same power and jurisdiction to issue a Writ of Prohibition or a Writ of Certiorari : and in which the nature of such jurisdiction and the grounds upon which such writs should be issued were discussed.<sup>13</sup>

#### Local extent of the jurisdiction of a High Court in the matter of a Writ of Certiorari or Prohibition.

It has been held that the jurisdiction of a High Court to issue a Writ of Certiorari or Prohibition is not restricted to the locality

<sup>11</sup> See also *ibid* at p. 282.

<sup>12</sup> (1934) 38. C. W. N. 729.

<sup>13</sup> i.e. *R. S. Naidu v. J. Ramier* (1926) 51. M. L. J. 701 ; *Ponnugonda Venkataratnam v. The Secretary of State for India in Council and others* (1930) 53. Mad. 979 ; *Venkata Narasimha Rao Bahadur v. The Municipal Council of Narasaraopet*. (1931) 60. Mad. L. J. 260 (at 261) ; *Muniswami Chetty v. The Board of Revenue, Land Revenue and Settlement, Madras and the Collector of Chittoor*. (1931) 61. M. L. J. 479 at p. 487 ; *Gorinadaswami Pillai v. Ramalingaswami Pillai*. (1931) 62. M. L. J. 644 ; (1932) 55. Mad. 942 at p. 948 ; *Shanmugar Mudaliar v. Subbaraya Mudaliar*. (1932) 63. M. L. J. 932 ; *Sri Sri Sri Rathnamula Pattamshadeci Zemindarini of Mandasa v. The Ryots of the Mandasa Zamindari*. (1933) 56. Mad. 579 ; *Mahomed Asan Maracair v. Bijli Sahib Bahadur*. (1934) 66. M. L. J. 367 ; *Sankaranarayana Pillai v. Ahmed Miran Sahib*. (1934) 66. M. L. J. 601.

within the limits of its ordinary original civil jurisdiction: but that the jurisdiction of the High Court in the matter of such a writ extends over all inferior tribunals amenable to its authority.<sup>14</sup>

### Circumstances in which the writs may be issued.

The writs will only issue under the following conditions:—

- (i) Where the body against which the writ is sought is such that it may properly be termed a judicial body.
- (ii) Where such body has acted without, or in excess of, its jurisdiction.
- (iii) Where there is no other sufficiently adequate remedy.
- (iv) Where the issue of the writ will constitute a remedy which will be effective.

### Prohibition or Certiorari—A Judicial Body.

The Writs of Prohibition or Certiorari can only be issued on a judicial body.

The writs will not issue against a body which is not a Court or judicial tribunal in any legal sense. And it is immaterial that the body may without lawful authority purport to act as a Court: the writs will not issue to a “pretended” Court.<sup>15</sup>

But “wherever any body of persons having legal authority to determine questions affecting the rights of subjects and having the duty to act judicially, act in excess of their legal authority they are subject to the controlling jurisdiction of the King’s Bench Division exercised in the writ” (i.e. of Prohibition).<sup>16</sup>

As to the nature of the bodies against whom a writ of Prohibition or Certiorari may be issued the matter has been fully discussed in a line of recent English Cases. The point was fully gone into in the last mentioned case *Rex v. Electricity Commissioners*<sup>17</sup> where the law on the subject after a full consideration of previous cases was

<sup>14</sup> See *Venkataram v. Secretary of State for India*, (1930) 53, Madras 979 at p. 999.

<sup>15</sup> See *Re Clifford and O’Sullivan* 1921, 2, A. C. 570; *R. v. Maguire and O’Shail* (1923) 2, I. R. 58; and see *Halsbury* (Hailsham Edn.) Art. 1407.

<sup>16</sup> *R. v. Electricity Commissioners* 1924 1, K. B. 171.

<sup>17</sup> 1924 1 K. B. 171 at p. 192.

clearly enunciated by Bankes L. J. in the following passage of his judgment :—

“There can, of course, be no exact precedent, as the Electricity Commissioners are a body of quite recent creation. It has, however, always been the boast of our common law that it will, whenever possible, and where necessary, apply existing principles to new sets of circumstances. A study of the decisions of the Courts in relation to writs of prohibition illustrates how true this is. In the case of *In re Clifford and O'Sullivan*<sup>18</sup> the Lord Chancellor quotes with approval the description of a writ of prohibition given in Short and Mellor<sup>19</sup> as “a judicial writ issuing out of a Court of superior jurisdiction and directed to an inferior Court for the purpose of preventing the inferior from usurping a jurisdiction with which it is not legally vested, or, in other words, to compel Courts entrusted with judicial duties to keep within the limits of their jurisdiction.” Originally no doubt the writ was issued only to inferior Courts using that expression in the ordinary meaning of the word “Court.” As statutory bodies were brought into existence exercising legal jurisdiction, so the issue of the writ came to be extended to such bodies. There are numerous instances of this in the books, commencing in quite early times. In the case of *Rex v. Inhabitants in Glamorganshire*<sup>20</sup> the Court expressed the general opinion that it would examine the proceedings of all jurisdictions erected by Act of Parliament, and if under pretence of such an Act they proceeded to encroach jurisdiction to themselves greater than the Act warrants the Court could send a certiorari to them to have their proceedings returned to the Court, to the end that the Court might see that they keep themselves within their jurisdiction, and if they exceed it to restrain them. It would appear from the judgments in *In re Ystradgynlais Commutation* and *In re Appledore Commutation*<sup>21</sup> that in both those cases the Court was willing to assume that a writ of prohibition would lie against the Tithe Commissioners. In *Chabot v. Lord Morpeth*<sup>22</sup> the Court certainly proceeded upon the assumption that a writ of prohibition might be issued to the Commissioners of

<sup>18</sup> 1921 2 A. C. 570 at p. 582.

<sup>19</sup> 2nd. Edn. (1908). p. 252.

<sup>20</sup> 1 Ld. Raym 580.

<sup>21</sup> 8. Q. B. 32 and 8 Q. B. 139.

<sup>22</sup> 15. Q. B. 446.



Woods and Forests. The same was the case in *Rex. v. Clerkenwell Commissioners of Taxes*<sup>23</sup> in reference to those Commissioners. In the cases of *In re Hall* and of *Rex v. Light Railway Commissioners*<sup>24</sup> writs were ordered to be issued to the Comptroller-General of Patents, and to the Light Railway Commissioners respectively. In *Board of Education v. Rice*<sup>25</sup> a writ of certiorari was directed to the Board of Education. In *Reg. v. London County Council*<sup>26</sup> this Court doubted, but did not decide, whether prohibition would lie against the County Council. Kay L. J. expressed his doubt as being whether the County Council would be exercising any judicial function in determining whether a churchyard which is now disused shall be considered as part of one parish or another parish. In *In re Grosvenor Hotel Co.*<sup>27</sup> the Court refused to issue a writ of prohibition to the Board of Trade and to their inspector, upon the ground that the examination and report of an inspector under sec. 56 of the Companies Act, 1882, was not a judicial proceeding in any proper sense of the term. These authorities are, I think, conclusive to show that the Court will issue the writ to a body exercising judicial functions, though that body cannot be described as being in any ordinary sense a Court."

And the matter was put beyond doubt in the judgment of Atkin L. J. in the same case in a certain passage which has since been repeatedly quoted and relied on in later cases, as follows :—<sup>28</sup>

"It is to be noted that both writs deal with questions of excessive jurisdiction, and doubtless in their origin dealt almost exclusively with the jurisdiction of what is described in ordinary parlance as a Court of Justice. But the operation of the writs has extended to control the proceedings of bodies which do not claim to be, and

<sup>23</sup> 1901. 2. K. B. 879.

<sup>24</sup> (1888) 21. Q.B.D. 137 and 1915. 3. K. B. 536. Actually this statement is not entirely accurate in respect of *In re Hall*. In that case the Court held on the facts that there were no reasons for the issue of the Writ of Prohibition asked for. The case is however authority that for sufficient reasons the Writ would have been issued on the Comptroller of Patents.

<sup>25</sup> 1911 A. C. 179.

<sup>26</sup> (1893) Q. B. 454.

<sup>27</sup> (1897) 76. L. T. 337.

<sup>28</sup> 1924 I. K. B. 171 at p. 205.

would not be recognised as, Courts of Justice. Wherever any body of persons having legal authority to determine questions affecting the rights of subjects, and having the duty to act judicially, act in excess of their legal authority they are subject to the controlling jurisdiction of the King's Bench Division exercised in these writs."

The same point that the body in order to be capable of being controlled by the issue of a Writ of Prohibition or Writ of Certiorari must be a body which is under a duty to act judicially, was also emphasised by Lord Hewart C. J. (citing with approval the judgment already referred to of Atkin L. J. in *Re v. Electricity Commissioners*) in the following passage of his judgment in the *King v. Legislative Committee of the Church Assembly, ex parte Haynes Smith*.<sup>30</sup>

"It is to be observed that in the last sentence which I have quoted from the judgment of Atkin L. J., the word is not "or" but "and". In order that a body may satisfy the required test, it is not enough that it should have legal authority to determine questions affecting the rights of subjects; there must be superadded to that characteristic the further characteristic that the body has the duty to act judicially. The duty to act judicially is an ingredient which, if the test is to be satisfied, must be present. As these writs in the earlier days were issued only to bodies, which without any harshness of construction could be called, and naturally would be called, Courts, so also to-day these writs do not issue except to bodies which act or are under the duty to act in a judicial capacity."

**Prohibition or Certiorari: where the Judicial Body has acted without or in excess of jurisdiction.**

There must be either a lack or an excess of jurisdiction in the judicial body in regard to the act which is to be prohibited if a Writ of Prohibition is to lie. Similarly there must be a lack or an excess of jurisdiction in the judicial body in regard to the order or

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<sup>30</sup> 1928. 1. K.B. 411 at p. 415. In that case it was held that the Legislative Committee of the Church Assembly was not a body having the duty to act judicially, and therefore Writs of Prohibition or Certiorari would not issue to it.

decision which is to be brought up on certiorari and quashed if a Writ of Certiorari is to lie.<sup>31</sup>

**Prohibition or Certiorari : absence of other adequate remedy.**

It has long been settled law that no Writ of Prohibition or Certiorari will be issued in a case where the applicant has some other adequate legal remedy.

The mere fact however that in the proceedings in respect of which the Writ of Prohibition or Certiorari is asked for, there is a right of appeal to which the Applicant may resort, is not conclusive. The true legal position was succinctly stated by Lord Williams J. in the case of *Dorman Long & Co. v. Jagadish Chandra Mahindra*<sup>32</sup> as follows :—

“Apart from the considerations with which I have dealt, these extraordinary remedies will not be used by the Court, where there is, as described in Sec. 45 of the Specific Relief Act, another specific and adequate legal remedy, such as a right of appeal. The existence of such a right of appeal, however, is not conclusive, because it may not be adequate, and in some circumstances the remedy given by the issue of such writs may be more speedy and more convenient and less costly.”<sup>33</sup>

**Prohibition or Certiorari : where the writ if issued will constitute a remedy which will be effective.**

The Court will not issue either of these high prerogative writs if it is apparent that such a writ will not be effective in the particular case.

In *Dorman Long & Co. v. Jagadish Chandra Mohindra*<sup>34</sup> an application was made for the issue of a Writ of Prohibition against the Controller of Patents to restrain him from proceeding with certain Proceedings then pending before him, being opposition Pro-

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<sup>31</sup> As to Prohibition see *Halsbury* (Hailsham Edn.) Vol. 9, Arts. 1397, 1398, 1399 and cases there cited ; as to Certiorari see *Halsbury* (Hailsham Edn.) Vol. 9, Arts. 1484, 1485 and 1486. As to jurisdiction to issue a Writ of Certiorari for fraud or error of law on the face of the proceedings see further *Halsbury* (*ibid*) Arts. 1490, 1491 and 1492.

<sup>32</sup> (1935) 39. C. W. N. 573 at p. 577.

<sup>33</sup> See also *Kiny v. North, ex parte Oakley* 1927 1 K. B. 491.

<sup>34</sup> (1935) 39. C. W. N. 537 (C.A.) at p. 576.

ceedings against the grant of a Patent. The ground on which the Writ was claimed was because the Controller had refused on the application of the opponent to issue a sub-poena for compelling the attendance of a witness before him in the opposition Proceedings. It was sought to restrain the Controller from continuing with the hearing of those proceedings without issuing the said sub-poena.

In that case the Writ of Prohibition applied for having been refused in the Court of first instance, the applicant appealed. Between the date of first hearing and the hearing of the appeal, the Controller gave judgment in the opposition proceedings before him, and thereby, as it was held, ceased to have *seisin* of the matter. The result was that, while the issue of the Writ of Prohibition would have been entirely effective at the date of the original hearing, the altered situation had become such that this would be no longer effective at the date of the hearing of the Appeal.

In the judgment delivered on the appeal, while it was clearly held that a Writ of Prohibition would lie against the Controller of Patents in India, and that the Controller ought to have issued the sub-poena in question, being under a duty to do so, yet the Court of Appeal took the view that to issue a Writ of Prohibition at that stage would be ineffective; in view of the fact that the position had altered since the hearing in the Court below, and that the Controller no longer had *seisin* of the proceedings in which the sub-poena was demanded. It would appear that it was primarily for this reason that the Court of Appeal refused to issue the Writ of Prohibition in that case. Lord Williams J. observing:—"Before however these extraordinary remedies are used, the Court must be sure that they will be effective."

### **Prohibition or Certiorari : discretion.**

There appears to be authority as to a Writ of Prohibition in the decisions of the English cases that in the United Kingdom the Court is not entitled to refuse the issue of a Writ of Prohibition for discretionary reasons: in a case where the defect of jurisdiction is clear.<sup>35</sup>

There appears to be on the other hand authority as to a Writ of Certiorari in the decisions of the English cases that in the United

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<sup>35</sup> See *Halsbury* (Hailsham Edn.) Vol. 9, Art. 1396 and cases cited.

Kingdom the issue of a Writ of Certiorari is a matter within the discretion of the Court.<sup>36</sup>

On the other hand there appear to be dicta in the more recent English cases tending to the view that in the case of either of these Writs the issue of the Writ is discretionary. This view is supported by the case already referred to in which both writs were treated as being similar in their operation.

### **Mandatory injunction under Sec. 45 of the Indian Specific Relief Act.**

If necessary a mandatory injunction may be obtained from a High Court on the Controller of Patents in a proper case, provided the circumstances of the case are such as to fall within the terms of the conditions stated in the section.

### **A Writ of Prohibition or Certiorari will lie in a proper case against the Controller of Patents.**

It is clear, it is submitted, that either a Writ of Prohibition or a Writ of Certiorari is held in the United Kingdom to lie against the Comptroller of Patents.

In the nature of things it is seldom that such a case arises.<sup>37</sup>

In India there is direct authority that a Writ of Prohibition or a Writ of Certiorari or a mandatory injunction under Sec. 45 of the Specific Relief Act may be issued in a proper case by a High Court on the Controller of Patents : the point having been expressly decided in the case of *In re National Carbon Co. Inc.*<sup>38</sup> by Panckridge J. and in the case of *Dorman Long & Co. v. Jagadish Chandra Mahindra*<sup>39</sup> by Lord Williams J.

<sup>36</sup> See *Halsbury* (Hailsham Edn.) Vol. 9, Art. 1432.

<sup>37</sup> See *Wingate's Application* (1931) 48. R. P. C. 416.

In a case where the Law Officer had allowed an amendment of a Specification which was complained of by the Applicant, a Writ of Prohibition was refused : on the ground that it was a matter within the jurisdiction and discretion of the Law Officer to decide whether or not or on what terms he should allow the amendment in question.

See *Van Gelder's Patent* (1889) 6. R. P. C. 22.

See also *Rex v. Muirhead and Comptroller General* (1927) 41. R. P. C. 28.

<sup>38</sup> (1934) 38. C. W. N. 729.

<sup>39</sup> (1935) 40. C. W. N. 573.

**CHAPTER XIX**  
**ENFORCEMENT BY OTHERS OF RIGHTS AGAINST**  
**THE PATENTEE—AND AGAINST A PERSON**  
**CLAIMING TO HAVE AN INTEREST IN**  
**A PATENT—SUIT FOR THREATS.**

**PART I**

**Application for Revocation or Compulsory Licences : recapitulation.**

The extent of the obligations of a Patentee in the management of his Patent after grant have already been considered in Chapter VIII : that is to say his obligations as to working, and as to supply, and as to manufacture within British India. The application in practice of remedies for the enforcement by others of their rights against a patentee in the event of his failing to fulfil such obligations has also been considered in Chapter XI, where the practice concerning applications for revocation or for compulsory licences was discussed. But for the fact that such matters came up conveniently for discussion when viewed from another angle in an earlier chapter, they might equally conveniently have been included in the present chapter. There would seem to be an idea prevalent in some quarters that when once a man has obtained the monopoly of a patent, he may profiteer or withhold supplies or fail to manufacture within British India as he pleases and to an unlimited extent. It has already been observed that this is not the case at all. That such an idea can be entertained by any members of the public can only be due to the fact, that there is not generally appreciated by the public either the nature of the obligations of the patentee or, equally, the extent of their own rights to have the patented article supplied on an adequate scale and on reasonable terms and manufactured in British India. In order to avoid repetition however it is enough now to refer here to the previous Chapters VIII and XI, and to emphasise the point that the remedies mentioned in Chapter XI are in truth practical remedies, which are available for the enforcement during the currency of a patent, by others, of the rights of those others (i.e. the public) against

a Patentee ; and are available for the assistance and protection of the industries of India.

In addition to these remedies already mentioned those others (i. e. the public) have also a further remedy by way of a Suit for Threats with which it is proposed now to deal in this chapter.

## PART II

### SUIT FOR THREATS

#### Previous English Law.

In England at Common Law a man has always had the right to bring an action for damages against a person, who has made to him a statement to the effect that there is a patent in existence and that he (the person to whom the statement is made) has infringed it or is infringing it, when such statement is untrue (either as to the existence of the Patent or as to the fact of infringement or both), and has been made maliciously, and has caused him or is such as will cause him (the person to whom the statement is made) damage. In such an action the Plaintiff might also succeed in obtaining an injunction. To such an action it has always been held to have been a good defence that the statement had been made *bona fide* and without motive, the person making it having an honest belief in the infringement and, it follows, in the existence of the Patent. This was the view taken by the Court in *Waren v. Weild* (1869) L. R. 4 Q. B. 730 at p. 737 and confirmed both by Jessel M. R. and by the Court of Appeal in the case of *Halsey v. Brotherhood* (1880) 15. Ch. D. 514 and (1881) 19. Ch. D. 386.

Originally it does not appear to have been considered to be a material issue whether or not the person making the statements complained of had or had not followed them up by taking judicial proceedings for infringement.<sup>1</sup>

<sup>1</sup> See and compare *Rollins v. Hinks* (1872) L. R. 13 Eq. 355 and *Armann v. Lund* (1874) L. R. 18 Eq. 330 with *Halsey v. Brotherhood* (supra). In *Rollins v. Hinks* and in *Armann v. Lund* it was held in effect that even if the statement being a statement of intention or threat to institute legal proceedings, was made *bona fide*, yet if the threat was not followed up by such proceedings being duly taken, then the person making the statement had no right to do so and the person to whom the statement was made had a right to an injunction restraining any repetition of such statements. But this doctrine does not appear to have been approved of in the case of *Halsey v. Brotherhood*. See *Edmunds* (1890 edn.) at p. 348.

Furthermore in addition to all such considerations of the Common Law and apart from the later Act of 1883, it has been pointed out that a patentee was under a certain duty which was imposed upon him by Section 4 of the Statute of Monopolies ; and it has been suggested that for the breach of such duty a person to whom threats were made had a right under such Section to sue the patentee in certain circumstances. The material part of that Section reads as follows :—

“IV. And be it further enacted by the Authority aforesaid, That if any Person or Persons at any Time after the End of Forty Days next after the End of this present Session of Parliament, shall be hindered, grieved, disturbed or disquieted, or his or their Goods or Chattels any way seized, attached, distrained, taken, carried away or detained, by occasion or pretext of any Monopoly, or of any such Commission, Grant, Licence, Power, Liberty, Faculty, Letters Patents, Proclamation, Inhibition, Restraint, Warrant of Assistance or other Matter or Thing tending as aforesaid, and will sue to be relieved in or for any of the Premises ; that then and in every such case, the same Person and Persons shall and may have his and their Remedy for the same at the Common Law, by any Action and Actions to be heard and determined in the Courts of King’s Bench Common Pleas and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their Goods or Chattels shall be so seized, attached, distrained, taken, carried away or detained ; wherein all and every such Person and Persons which shall be so hindered, grieved, disturbed or disquieted, or whose Goods or Chattels shall be so seized, attached, distrained, taken, carried away or detained, shall recover Three Times so much as the Damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed or disquieted, or by means of having his or their Goods or Chattels seized, attached, distrained, taken, carried away or detained, and double costs.” There is no record of any action having been brought under the section until the case of *Peck v. Hindes*<sup>2</sup> in which the Plaintiff attempted to sue in respect of a former unsuccessful infringement suit which he alleged fell brought within the meaning of the section.



It would appear, as is remarked in *Fletcher Moulton*,<sup>3</sup> a matter of some doubt whether mere threats would give a cause of action under the section and also whether the section applies to actions for the enforcement of Patent rights.

The English Act of 1883 was the first Statute to contain specific provisions in regard to threats. Under Section 32 of that Act it was provided as follows :—

“32. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats : Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.”

From the wording of that section it is seen that under the Act of 1883 all that it was necessary for a Plaintiff to establish in order to succeed in a suit under Section 32 was, firstly, that threats within the section had been made, secondly, that the acts of the Plaintiff complained of were not in fact an infringement and, thirdly, that the Defendant had failed with due diligence to commence and prosecute an action for infringement. It is clear that under the Act of 1883 the fact of the Defendant having made the threats under a *bona fide* belief that they were justified and a belief that the acts of the Plaintiff complained of were in fact an infringement was immaterial. Thus, as is pointed out by *Edmunds*<sup>4</sup> the doctrine originally enunciated by *Malins v. C. in Rollins v. Hinks* and in *Armann v. Lund*, which had been dissented from in *Halsey v. Brotherhood*, received legislative sanction and was unambiguously enacted as the law. It is also clear that under the Act of 1883 it was positively and expressly provided in effect that the Plaintiff might obtain an injunction even

<sup>3</sup> (1913 edn.) at p. 221.

<sup>4</sup> *Edmunds* (1890 : edn.) p. 350.

without proof of having suffered any damage. The Act thus created a new duty on the part of a patentee, beyond any duty under which he would have been under the Common Law, and a new tort in the case of a breach of such duty.

It has also been held that the right of action created by the section is restricted to an action against a patentee and that there was under the Act no right of action against a licensee.<sup>5</sup>

In 1907 the provisions of what had been Section 32 of the 1883 Act were embodied in Section 36 of the Act of 1907 which read as follows :—

“36. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats :

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.”

It is seen that the slight alterations are merely alterations of drafting and for purposes of clarity ; the phrase “infringement of the patent” being substituted for the words “manufacture, use, sale or purchase of the invention” : and while the old section referred to “such damage, if any, as may have been sustained thereby” the newer section by using the words “such damage, if any, as he has sustained thereby” made it clear that the Plaintiff could only recover damage actually suffered by himself. For all practical purposes the provisions in force in the United Kingdom under both acts may be treated as the same.

There have been numerous actions under these acts.<sup>6</sup>

\* See *Tender v. Stevenson* (1898) 15. R. P. C. 24.

\* See *Edmunds* (1890 edn.) p. 349 and *Fletcher Moulton* (1913 : edn.) p. 298 where the cases are referred to.

### **Present English Law.**

The provisions regarding threats are now contained in Section 36 (1) and (2), of the English Patents and Designs Acts 1907-1932, the whole of this section having been enacted in the year 1932 in substitution for the provisions above mentioned :—

“36 (1) Where any person, by circulars, advertisements or otherwise, threatens any person with an action for infringement of patent or other like proceedings, then, whether the person making the threats is or is not entitled to or interested in a patent or an application for a patent, any person aggrieved thereby may bring an action against him, and may obtain a declaration to the effect that such threats are unjustifiable and an injunction against the continuance of such threats and may recover such damage, if any, as he has sustained thereby, unless the person making the threats proves that the acts in respect of which the proceedings are threatened constitute or, if done, would constitute an infringement of a patent in respect of a claim in the specification, which is not shown by the Plaintiff to be invalid, or an infringement of rights arising from the acceptance of a complete specification in respect of a claim therein, which is not shown by the Plaintiff to be capable of being successfully opposed.

(2) The Defendant in any such action as aforesaid may apply, by way of a counter-claim in the action, for any relief to which he would be entitled in a separate action in respect of any infringement by the Plaintiff of the patent to which the threats relate.”.

As this recent English Section has not been adopted in British India, it is unnecessary in this work to consider it in detail or the points in which it differs from the provisions of the English Act of 1907. It follows that English decisions since the year 1932 and based on the current English section will not always be in point in regard to the construction of the provisions current in British India at the present day.

### **Previous Indian Law.**

The earliest Act in British India to contain any provisions in regard to threats, such as are now being considered, was the Act of 1911. The provisions of the English Act of 1883 in regard to threats were among those matters which had not been adopted in

the Indian Act of 1888. A reason is to be found on a perusal of the Objects and Reasons of the Act of 1911 (i.e. of Bill No. 9 of 1910) in which (in clause 3) it was observed that "although the Indian Act of 1888 was passed five years after the United Kingdom Statute of 1883, it was felt that the time was not yet ripe in this country for introducing the English practice in its entirety, as the volume of Patent work was then small." The same passage then continues :—"Now, however, that it is growing and is likely to do so at a much greater rate in future, it is thought advisable to bring the practice in this country more into conformity with that of the United Kingdom".....And in clause 7 of the same Objects and Reasons these provisions are specifically referred to as follows :—

"The following improvements in the law proposed by the Bill may here be enumerated". (Various matters under alphabetical sub-headings are then mentioned) "(G) Threats of legal proceedings will be actionable unless the patentee proceeds diligently with an infringement suit."

The actual provisions in the Act of 1911, under Section 36 thereof were as follows :—

"36. Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise, threatens any person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring a suit against him in a District Court having jurisdiction to try the suit, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats :

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes a suit for infringement of his patent."

These with only minor alterations made by the Act of 1930 are the provisions now in force.

### **Present Indian Law.**

In strict law it will be correct to say, (as was pointed out in *Fletcher Moulton on Patents* (1913 : edn.) at p. 219 in regard to the legal position in England), that in British India at the present day

"a person who is aggrieved by statements to the effect that he is infringing a patent may have one or more of three remedies." Firstly his rights at Common Law, to which reference has already been made : secondly his rights under Section 4 of the Statute of Monopolies : thirdly his rights under Section 36 of the Act of 1911. In practice it will be seldom, if ever, that such a person will need to resort to his rights at Common Law or his rights under the Statute of Monopolies. It is proposed accordingly in this Chapter to deal only with the matter in relation to Section 36 of the Indian Patents and Designs Act of 1911 already mentioned.

The wording of this section which contains the provisions now in force is as follows : though it differs but slightly from the section of the 1911 Act as originally passed, it may be set out here for convenience of reference in full, the passages underlined being those where alteration from the Act of 1911 was made by the Act of 1930.

"36. Where any person claiming to have an interest in a patent by circulars, advertisements or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring a suit against him in a District Court having jurisdiction to try the suit, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in a fact an infringement of the patent.

Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence".

#### **General effect of the section.**

The section is peculiarly framed and is somewhat peculiar in its effect. Commenting on the similar peculiarity of the effect of Section 32 of the English Act of 1883 Cozens Hardy M. R. in one case said :—

"Section 32 does not, as Mr. Gray in his ingenious argument has suggested, merely relieve a plaintiff from the obligation of establishing malice in the old common law action, but it confers an entirely new right of action, and one in which malice is not an issue between

the parties. As this Court in more than one case has pointed out, the Section is peculiarly framed. It purports to give, and does in the first part give, a right of action to the person who is threatened, but this is followed by a proviso which says that this section shall not apply, if the person making the threats with due diligence commences and prosecutes an action for infringement of his Patent ; that is to say, although the Plaintiff, the person who is threatened, may think he has a good cause of action and may issue his writ, claiming an injunction and damages in respect of the threats he cannot tell till a later period whether in fact the right of action given by Section 32 is or is not in existence, because the whole Section is not to apply if the person making such threats, that is the patentee, with due diligence commences and prosecutes an action for infringement of his Patent.”

It is important to note that as far as a Patentee is concerned, the section in no way stands in his way to prevent him giving any warnings or notices either to the general public or to individuals, if he is ready to follow up those warnings or notices by promptly instituting a suit. The section was only intended to prevent a Patentee from making statements throwing doubt on the right of other persons to carry on business in a particular manner or in connection with certain particular articles, as they were doing, and thereby causing such persons loss in such business, and yet refusing to have the vital question, whether or not such persons were entitled to carry on their business in the way they were doing, properly decided.

It would seem that the section is intended to relieve members of the public and persons, who compete in business with the patentee, from the disadvantages of a situation in which it might be to their interest but not to the interest of a patentee to have the issue of infringement promptly and definitely decided. In such a situation without the aid of Section 36 of the Indian Act of 1911, they might be unable satisfactorily to get the point decided, whether what they were doing was in fact an infringement or not. It is possible they might be entitled to sue at Common Law for a declaration in some form or other to the effect that they were entitled to carry on business as they were doing ; and they might in such suit at Common Law obtain an injunction in certain cases and, possibly, damages in

certain cases on the principles and in the circumstances already mentioned.<sup>8</sup> But it is clearly more satisfactory for such persons to have their rights clearly defined under the Act. At the same time it is also to the advantage of patentees that they should have the benefit of the proviso which is included in the section.

Since the questions both of infringement and of the validity of the Patentee's patent may be decided equally either in a suit by the Patentee for infringement or in a suit by the person threatened against the Patentee for threats, it is possible that in some instances it may be to the advantage of the Patentee to allow the matter to be decided in the threats suit without commencing any suit for infringement. More often than not however, the matter is fought out in an infringement suit.

### **The Tribunal.**

The suit in question under Section 36 is, under the wording of the Section, to be brought in a "District Court having jurisdiction to try the suit." The expression District Court as here used includes the original side of a High Court: for the reasons mentioned elsewhere in connection with Infringement Suits.<sup>9</sup>

Regarding the question of jurisdiction either for a High Court or for a District Court reference may be made to the observations already made in regard to jurisdiction in infringement suits in chapter XVII.

### **The Relief.**

The reliefs obtainable to which reference is made in Section 36, (injunction and damages) are precisely those obtainable in any suit in which the cause of action is a tort, where there is a prospect of the tort being repeated.

### **The Grounds.**

The grounds which it is necessary for the Plaintiff to establish, in order to succeed, may be considered under the following heads:—

- (i) What are threats.
- (ii) Falsity of the statement.
- (iii) Lack of diligence on the part of the Defendant in commencing and prosecuting a suit for infringement.

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<sup>8</sup> See page 806 above.

<sup>9</sup> See page 668 above.

**What are threats : in what form they may be made.**

It is immaterial in what form the statement is made, it may nevertheless amount to a threat within the meaning of the section.

It has been held that the words "or otherwise" are not to be construed merely as *ejusdem generis*.<sup>10</sup>

Letters even in answer to enquiries may amount to threats.<sup>11</sup>

Statements even in letters written by the Solicitors of the Defendant may amount to threats.<sup>12</sup>

The fact that such letters have been written "without prejudice" has been held to be immaterial.<sup>13</sup>

Oral statements may be threats.<sup>14</sup>

**What are threats : to whom the threats must be addressed.**

It has been held in England that it is immaterial to whom the threats have been addressed. The threat may be addressed to the Plaintiff, or his customers, or his manufacturers, or to the world in general.<sup>15</sup>

If the threat is addressed solely to the Plaintiff, it is immaterial that it has not been published to anyone else; since there is no question of libel or publication, the only question in this respect being whether or not the words are a threat within the meaning of the section. Also if the statement is addressed to a third party and not to the Plaintiff, it may none the less be a threat which may give a right of action under the section to the Plaintiff.<sup>16</sup>

<sup>10</sup> See *Skinner & Co. v. Perry* 10 R. P. C. 1. (C. A.).

<sup>11</sup> See *Skinner & Co. v. Perry* 10. R. P. C. 1. (C. A.).

<sup>12</sup> See *Engels v. Hubert* 19. R. P. C. 201; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.* 6. R. P. C. 502; *Crampton v. Patents Investment Co.* 5. R. P. C. 393. But see *Day v. Forster* 7. R. P. C. 54.

<sup>13</sup> See *Kurtz v. Spence* 5. R. P. C. 161 at p. 173.

<sup>14</sup> See *Farr v. Weatherhead & Harding* 49. R. P. C. 262; *Luna Advertising Co. Ltd. v. Burnham & Co.* 45. R. P. C. 258; *Ellis & Sons Ltd. v. Pogson* 40. R. P. C. 62; *Kurtz v. Spence* 5. R. P. C. 161.

<sup>15</sup> See *Fletcher Moulton* at p. 222; as to customers see *Craig v. Dowding* 25. R. P. C. 1; *Hoffnung & Co. v. Salisbury* 16. R. P. C. 375; *Burt v. Morgan* 4. R. P. C. 278; as to manufacturers see *Webb v. Levinstein* 15. R. P. C. 78; *Willoughby v. Taylor* 11. R. P. C. 45.

<sup>16</sup> See *Skinner v. Perry* 10. R. P. C. 1. (C. A.) and see *Driffeld Co. v. Waterloo Co.* 3. R. P. C. 46.



### What are threats : who must be threatened.

It is immaterial against whom the Defendant may have threatened that he will take the proceedings so threatened. It is provided expressly by the Section that any person aggrieved by the threats has the right of bringing the suit.<sup>17</sup>

### What are threats : what must be threatened.

Where a suit for infringement has been brought against an infringer a statement or notice to the public that it has been brought, is not a threat within the meaning of the section.<sup>18</sup>

Nor is a general statement or a general warning to the public that a patentee intends to protect his rights a threat.<sup>19</sup>

But in special circumstances where the statement though couched in general words may have been expected to be understood as a threat by particular persons, the Court has found that the form of the words is unimportant and that the words amounted to a threat ; the dividing line between a general warning and a threat is difficult, in view of these decisions to define.<sup>20</sup>

The Indian section expressly refers to a threatening with "legal proceedings or liability in respect of any alleged infringement of the patent". What is threatened must be something of the nature indicated. In this connection however it should be noted that it is not necessary that either legal proceedings or liability should be actually mentioned expressly in words if the effect of the statement is clear by implication. The following observations made by Clauson J. in one case are in point. In that case (which was brought under Section 36 of the English Acts 1907 to 1919 of which the wording is in this respect the same as in the Act now current), there

<sup>17</sup> Cf *Terrell* (8th edn : 1934) p. 360.

<sup>18</sup> See *Bevan v. Welsbach Incandescent Gas Light Co.* 20. R. P. C. 73 ; and *Incandescent Gas Light Co. Ltd. v. Sunlight Incandescent Co. Ltd.* 14. R. P. C. 180.

<sup>19</sup> See *Weldrex Ltd. v. Quasi-Arc Co. Ltd.* 39. R. P. C. 323. *Crouther v. United Flexible Metallic Tube Co.* 22. R. P. C. 549 ; *Willoughby v. Taylor* 11. R. P. C. 45 ; *Dick v. Haslam* 8. R. P. C. 196 ; *Brauer v. Sharpe* 3. R. P. C. 193.

<sup>20</sup> See *Cars v. Bland Light Syndicate Ltd.* 28. R. P. C. 33 ; *Craig v. Dowding* 25. R. P. C. 1 and 25. R. P. C. 259 (C. A.) ; *Douglas v. Pintsch's Patent Lighting Co.* 13. R. P. C. 673 ; *Johnson v. Edge* 9. R. P. C. 142 (C. A.).

had been an interview between an Agent of the Defendant Firm and an Agent of a Company which was a purchaser from the Plaintiff Company. The Plaintiff Coy. was a manufacturing Company being a manufacturer of electric signs. Speaking of that interview the learned judge observed :—

“The Plaintiffs are concerned with certain objects known as daylight signs. The Defendants appear also to be concerned with the same objects. The Plaintiffs supplied a daylight sign to a shop which was an agency of Messrs W. & A. Gilbey Limited, the daylight sign having the name of Messrs Gilbey on it. Thereupon Mr. Beams, who is admitted to be a representative of the Defendants, visited Mr. Burke, the Secretary to Messrs Gilbey. This is what took place. On the 15th of December, 1927, Mr. Beams called at Messrs Gilbey’s Office in Oxford Street and saw Mr. Burke. Mr. Beams said that he was representing the Defendants and that he had been instructed by them to call with reference to a sign which was exhibited outside the premises of their agents Messrs Hawes Stores. Mr. Beams then stated that this sign was an infringement of his firm’s Patent and he requested Messrs Gilbey to take steps to have the sign immediately removed from Messrs Hawes’ premises. Mr. Burke’s affidavit continues : “I asked the said Mr. Beams by what authority he made such statement and demand, and he then stated that his firm had during the year 1927 acquired the sole right of lettering on the front of signs under Letters Patent” the number of which he gave. The Plaintiffs are seeking here for an injunction to restrain the Defendants from threatening any person with legal proceedings or liability in respect of any alleged infringement of any Letters Patent in which the Defendants claim to have an interest. The question and the sole question I have to determine in considering whether I should grant until the trial the injunction that is asked is this : Do those facts which I have recited from Mr. Burke’s affidavit satisfy me that as a matter of fact Mr. Beams threatened Messrs Gilbey with legal proceedings or liability ; in other words, if I, or had this matter come before a Jury, the Jury, had been present at that interview, what could we have supposed that Mr. Beams intended to convey to Mr. Burke having regard to Mr. Beams’ statement that he had been instructed to call with reference to the matter, having regard to his statement that the sign was an infringement of his

firm's Patent, having regard to his request to the Company to take steps to have the sign immediately removed, and having regard to the fact that, when he was asked by what authority he was making this statement and demand, he referred to an interest in Letters Patent? I should myself have inferred, had I been present, that Mr. Beams was courteously pointing out to Mr. Burke, that Mr. Burke's company were under legal liability to the Defendants in respect of the Defendants' position as interested in a Patent, and I should have thought that, courteous and quiet though no doubt the interview was, the whole purport of it was to threaten Mr. Burke's Company with that which would result from legal liability, and I understand that to be threatening Messrs Gilbey with legal liability. I should myself be prepared even to go further, though I do not think it is necessary. I think that an interview of this kind, a serious interview between business men, although nobody speaks of solicitors and writs, has no real meaning except to convey to the person whom I regard as having been threatened that the threatener has legal rights and means to enforce them, and although, as I say, he does not refer in so many words to writs, means, "unless you bend to my will, I shall enforce my rights" in the way in which they are naturally enforced, *i.e.* by legal proceedings. It seems to me to be a question which depends entirely upon the inference which an ordinary man would draw from the attitude of the parties if he was present at the interview. Speaking for myself on these materials I am satisfied that the Defendants did threaten Messrs Gilbey with legal proceedings or liability."<sup>21</sup>

On the wording of the section it is difficult to understand what is meant by "threatening" a man "with liability" though these words occur both in the English Acts of 1883 and 1907 and in the present Indian Act of 1911. The passage about liability has now been omitted from the current English Statute. It may be that the framers of the section had in mind a situation of the same nature as that in the case in regard to which Clauson J. made the observations above mentioned; and that the intention was merely to cover a case where no reference to legal proceedings was mentioned but where by speaking of liability it might be implied that the Defendant meant to take action in regard to such liability.

**Falsity of the statement.**

It is necessary in order that the Plaintiff will succeed that he will establish that as stated in Section 36 "the alleged infringement to which the threats related was not in fact an infringement of the patent".

The falsity indicated in the words last quoted of Sec. 36, in regard to the statement of the Defendant, may be established by the Plaintiff in one of two ways. Either he may establish, broadly speaking, that, though the Defendant has a Patent and though that Patent is a valid Patent yet there has been in fact no infringement of it : or he may establish that, though the Defendant has a Patent such Patent is invalid.

Indeed the grounds necessary for the Plaintiff in a threats suit, to succeed, are the same as the grounds necessary for the success of a Defendant in a suit for infringement subject to one important exception.

**But the section postulates the existence of a Patent.**

While at first sight it might have seemed possible under the Section for a Plaintiff also to succeed by showing that the threats had been false in that there had been no infringement by him because the patent, of which the Plaintiff claimed to be Patentee or to have an interest, was in fact non-existent, it has been held in England that a Plaintiff cannot succeed in a threats suit under the section unless there is in fact a Patent in existence. This very point was fully argued and decided in a case in which the alleged threats had been made by a Defendant at a time when he was merely an applicant for a Patent and in whose case a grant had subsequently been refused. The case was brought under Section 36 of the English Act of 1907 as amended by the Act of 1919. It was held that the section pre-supposed the existence of a Patent. A material part of the observations of P. O. Lawrence J. on this point was as follows :—

"This is an action brought to restrain threats made by the Defendant in respect of an alleged infringement of an invention which, at the time when the threats were made, had been protected by a Complete Specification which had been accepted. The question to be determined is whether the remedy conferred by Section 36

of the Patents and Designs Act 1907, as amended by the Act of 1919, is available to the Plaintiff." (The learned Judge then stated the facts)....."In these circumstances, the question is whether the Plaintiffs are entitled to bring an action against Mr. Pogson under Section 36 as amended. As had been frequently pointed out, such an action is not an action to enforce any common law right. It is a statutory right of action conferred upon a person aggrieved where groundless threats of legal proceedings have been made. In order to succeed in such an action, it is essential that the Plaintiff should bring his case within the four corners of the Section. In my judgment, the Section presupposes the existence of a patent and does not apply to a case where there is no patent. The words are: "Where any person claiming to have an interest in a patent threatens", and so on, "any person with legal proceedings in respect of any alleged infringement of the patent", the person aggrieved, reading it shortly, may bring an action and obtain an injunction against the continuance of threats and may recover such damage as he has sustained if the alleged infringement to which the threats related was not, in fact, an infringement of the patent; and the proviso is that the section "shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence." Having regard to the language of that Section, I am of opinion that the Section contemplates the existence of a patent in which a person has or claims to have an interest; that is to say, the person need not necessarily be the patentee; it is sufficient for the purposes of the Section if he has, or claims to have, an interest in it. Mr. Whitehead contends that the Section applies even if there is no patent in existence, and that if a person claiming to have an interest in a patent, although there is no patent in existence, threatens another with legal proceedings or liability in respect of the infringement of a non-existent patent, any aggrieved person can under the Section bring an action in respect of such threats. In my judgment, that is not the right view.....In my opinion, there being no patent, he could not, in fact, threaten legal proceedings or liability in respect of an alleged infringement of *the* patent, nor could the person aggrieved recover damages by proving that the alleged infringement to which the threats related was not, in fact, an infringement of *the* Patent, in both cases because there is no patent in existence. Moreover, the proviso clearly could not apply to a

case where there was no patent in existence, as no action for an infringement of the patent could possibly be commenced or prosecuted with due diligence. For these reasons, I hold that the action fails, and must be dismissed with costs."<sup>22</sup>

This decision was confirmed on appeal, when Warrington L. J. in clear and emphatic language made the following observations:—  
"At common law it was an essential of a cause of action against a man uttering threats in respect of property that those threats should arise in malice. Malice was an essential to the cause of action. The Section creates a new cause of action altogether, of which malice is not an ingredient. But then it qualifies that cause of action in two ways. It, first of all, provides a special defence to the action, because it enables the defendant to prove, if he can, that the alleged infringement about which he was threatening was in fact an infringement; because the damages can only be recovered if it was not an infringement; but, besides that, it excludes the application of the Section altogether if an action for infringement of the patent is commenced and prosecuted with due diligence. Neither of those qualifications can apply if there is no patent at all. It seems to me that it is quite impossible to read the Section except in this way: that it presupposes the existence of a patent; the patent creates a monopoly, and one of the conditions under which the patentee, or the person interested in the patent, enjoys the monopoly, is that he should be subject to these actions for threats; but again his liability to be so subject is qualified in the two ways which I have mentioned; and the Section, if not read in the way the learned Judge has read it, would be very much wider than it is possible to suppose the Legislature intended."

**Lack of diligence on the part of the Defendant in commencing and prosecuting a suit for infringement.**

It will have been noted that the current Indian section contains the following proviso which as now worded was enacted by the Act of 1930:—

"Provided that this section shall not apply if an action for the infringement of the patent is commenced and prosecuted with due diligence."

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<sup>22</sup> See *Ellis & Sons Ltd. v. Poyson* (1923) 40. R. P. C. 62; and on appeal at p. 179.

Thus for a Plaintiff to succeed in a suit under the section it is necessary for him in addition to the grounds already discussed to establish that the Defendant has not commenced and prosecuted a suit for infringement with due diligence. The questions therefore arise what is "due diligence", what is "commencing and prosecuting", and what sort of suit, that is to say by whom, against whom, and for what kind of infringement, will do, within the meaning of the section, to prevent the section becoming operative.

### Due diligence.

It has been held in England that time is to be reckoned, in considering the question of due diligence, from the date of the threats and not from the date when the patentee knew of the infringement.<sup>23</sup>

It has also been held in England that the Patentee cannot be expected to start an action till he finds someone who persists in infringing.<sup>24</sup>

Further, as pointed out in *Fletcher Moulton on Patents* (1913 edn. p. 223) a patentee will not, it is submitted, become liable for threats within the section in a case, where, before there is any actual infringement, he issues a general warning that he intends to protect his patent rights in the event of any infringements being perpetrated in the future, even though he may not follow up the threats with any suit. For in such a case it would be impossible in the absence of any infringements or specific threats of infringement for him to bring any suit; and therefore he is unable to avail himself of the protection of the proviso; and it will be of no avail for a Plaintiff to rely on a ground that the Defendant did not commence a suit for infringement with due diligence. But such a case seems not strictly affected by the meaning of the proviso. Rather it is a case where there must be held to have been in fact no threats within the meaning of the section.

It has also been held in England that in considering the question of due diligence the patentee is generally entitled to proper time to decide as to his course of action even after threats have been made.<sup>25</sup>

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<sup>23</sup> See *Colley v. Hart* 7. R. P. C. 101 at p. 103; *Challender v. Royle* 4. R. P. C. 363 (C. A.).

<sup>24</sup> See *Colley v. Hart* 7. R. P. C. 101.

<sup>25</sup> See *Challender v. Royle* 4. R. P. C. 363 (C. A.).

*Amendment of the Specification by the person making the threats after the threats and before bringing his suit for infringement :—*

In England it has been suggested that there has not been a want of due diligence when the Defendant in the threats suit has waited while he has effected an amendment in his Specification before bringing an infringement suit.<sup>26</sup>

The question whether there has been due diligence is a question of fact.<sup>27</sup>

**“Commenced and prosecuted.”**

It has been held in England that where a suit has been commenced before the making of the threats but diligently prosecuted thereafter, this fulfils the proviso.<sup>28</sup>

It has been decided in England that it is not necessary that the infringement suit referred to in the section should be fought out to a finish or even is it necessary that it should come up for hearing. Thus though the Defendant in the threats suit has commenced but abandoned his infringement suit, he will nevertheless have the benefit of the proviso and escape liability for the alleged threats. Such a decision is certainly in keeping with what may be assumed to have been the intention of the section, which cannot be more than to prevent the evils of an indecisive position. As was said by Bowen L. J. : “the sword of Damocles either should not be suspended or should fall at once.”

**What infringement suit will give immunity under the proviso ?**

It has been held in England that it is not necessary, in order that the Defendant in the threats suit will have the benefit of the proviso of the section, that he should have brought an infringement

<sup>26</sup> See *Stepney Spare Motor Wheel Ltd. v. Hall* 28. R. P. C. 381 ; *Davies and Davies Patent* 28. R. P. C. 50. ; *Hall v. Stepney Spare Motor Wheel Ltd.* 27. R. P. C. 233 at p. 235 and comprising *Fusee Vesta Co. v. Bryant & May* 4. R. P. C. 191.

<sup>27</sup> For references to illustrative cases where it has been held there was due diligence and to cases where it has been held there was not, see *Fletcher Moulton* (1910 edn.) p. 225.

<sup>28</sup> See *Haskell Golf Ball Co. v. Hutchinson* 21. R. P. C. 497 ; *Berliner v. Edison Bell Phonograph Co. Ltd.* 16. R. P. C. 336 at p. 338 ; *Dunlop Pneumatic Tyre Co. Ltd. v. New Seddon Co. Ltd.* 14. R. P. C. 332 (C. A.) ; *Incandescent Gas Light Co. Ltd. v. Sunlight Incandescent Co. Ltd.* 14. R. P. C. at p. 188.



suit against the Plaintiff in the threats suit. It is sufficient in effect if the issue of infringement concerning the class of articles mentioned in the threats, and in which the Plaintiff in the threats suit is interested, is in issue in the infringement suit.<sup>29</sup>

Since the wording of the proviso in Section 36 of the Indian Act of 1911 now current (unlike the wording of the proviso in Section 36 of the English Act of 1907) makes no mention of the person by whom the infringement suit is to be brought, it would seem that in India it will be immaterial even whether the Defendant in the threats suit is Plaintiff in the infringement suit. And it would appear that the Defendant in the threats suit may still obtain the immunity of the proviso, provided the same question of infringement is in issue in the two suits, even where this matter of infringement has been brought in issue in an infringement suit, where all the parties are different to those in the threats suit.

#### As to procedure.

It is next proposed to consider a few points of procedure relating especially to the procedure in a suit for threats. As to other matters of procedure reference may be made to the observations previously made as to procedure in Infringement Suits.

#### Who may be sued.

It is not merely the Patentee who may be sued or a person who claims to be a Patentee, but anyone who claims an interest in the Patent.

Since in Section 36 of the Indian Act the material words used since the amendment of 1930 are "any person claiming to have an interest in a patent", it is clear that in British India (as in England under the Act of 1907 after it had been amended by the Act of 1919), if threats have been made by a licensee or a person who claims to be a licensee a suit for threats will lie under the section against such person.<sup>30</sup>

<sup>29</sup> See *Electric Lamp Manufacturing Co. Ltd. v. Osram Lamp Works Ltd.*, 28. R. P. C. 480; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.* 6 R. P. C. 502; *Challender v. Royle* 4. R. P. C. 363 (C.A.).

<sup>30</sup> See *Ellis & Sons Ltd. v. Pogson* (1923) 40 R. P. C. 62. Contrast as to the position under the English Act of 1907 prior to the amendment of 1919, *Diamond Coal Cutter Co. v. Mining Appliances Co.* (1915) 32 R. P. C. 569; and *Fletcher Moulton* (1913 : edn.) at p. 221; and see Clause 22 of the Objects & Reasons of Bill No. 33 of 1928 which culminated in the Act of 1930 : in Appendix 5 below.

**Who may sue.**

As already noted, any person aggrieved by threats may sue.

**Interlocutory Injunction.**

Reference may again be made to what has been observed, generally, in regard to interlocutory injunctions in Chapter XVII in connection with an infringement suit.

**Onus.**

The onus will be on the Plaintiff to prove that the threats have been made ; and the absence of infringement.

If the Plaintiff relies on threats made by agents of the Defendant the onus will also be on the Plaintiff to prove the authority of such agents.<sup>31</sup>

It would appear if a defence under the proviso to Section 36 is relied on by the Defendant, the onus of proving that the requisite infringement suit has been brought with due diligence will be on the Defendant. In practice however it will no doubt be safer for the Plaintiff to prove the absence of any such infringement suit or of such diligence.

**Plaint.**

Since the onus, as already noted, is on the Plaintiff to prove the threats and the absence of infringement, it appears that the Plaintiff may, if he knows the Patent or Patents on which the Defendant is relying for his threats, plead the non-validity of such in his Plaint. In most cases the Plaintiff will have the requisite knowledge : in all probability particulars of the Patent of the Defendant will have been given in the threats. It is submitted this will be the best course in British India, where a reply by a Plaintiff in answer to a Written Statement by a Defendant is not common practice. But if the Plaintiff does not know on what Patents the Defendant has been relying for his threats, it is not possible for him to plead specifically to the invalidity of specific Patents. In such case he may plead that he has not infringed any Patent of the Defendant. And if the Defendant in his Written Statement makes a case that certain Patents have been infringed, the Plaintiff may in British India either obtain leave to file a Reply attacking the validity of such Patents, in which event he will have to give particulars of such

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<sup>31</sup> See *Dowson Taylor & Co. v. 'Drosophone Co. Ltd.* 11 R. P. C. 656.

invalidity, or, it seems, according to the practice in British India, he may wait until the hearing to make his case of invalidity.<sup>32</sup>

To avoid the uncertainty of the situation that would arise where the invalidity of the Plaintiff's Patents has not been pleaded with full particulars in the Plaint, it is submitted that the Defendant in a threats suit should take the earliest opportunity either of obtaining the requisite amendment of the Plaintiff's Plaint or the requisite particulars or else of obtaining an order on the Plaintiff to file a Reply. For it will be highly inconvenient for the Defendant to go to trial without knowing what case of invalidity the Plaintiff intends to make at the hearing.

### Particulars.

The Defendant is entitled to proper particulars of objections in a case where the Plaintiff relies on the invalidity of the Defendant's Patent.<sup>33</sup>

### Reliefs obtainable in the suit itself : permanent injunction.

The reliefs obtainable in the suit by a successful Plaintiff are :—

1. A permanent injunction to restrain any repetition of threats.
2. Damages.
3. Costs.

It would appear that if the necessary grounds mentioned in Section 36 are established, whether or not any damages have been proved to have been suffered, the Plaintiff in the threats suit will be entitled to a permanent injunction to restrain any repetition of such threats.<sup>34</sup>

### Damages.

Where it is established that the Plaintiff by reason of the threats has suffered damage, a decree for damages in a specific sum

<sup>32</sup> For the English practice where a Reply by the Plaintiff is common form, see *Fletcher Moulton* (1913 : edn.) at p. 228 citing *Union Electrical Power Co. v. Electrical Power Storage Co.* 5. R. P. C. 329, and *Dowson Taylor & Co. v. Drosophone Co.* 12. R. P. C. 95.

<sup>33</sup> See *Fletcher Moulton* (1913 : edn.) p. 228.

<sup>34</sup> For the form in which the permanent injunction should be framed see *Ellam v. Martyn*. 16. R. P. C. 28 ; and see *Colley v. Hart* 6. R. P. C. 21 ; *Challender v. Royle* 4. R. P. C. 363 at p. 368.

may be obtained at the hearing, or an order for an enquiry as to damages.

In the majority of cases it may be impossible without an enquiry to calculate a precise figure for the damages suffered. In many cases even with an enquiry there may be no possibility of arriving at any more precise figure. In such case there will be no benefit in having an enquiry; and all that can be done is for some round figure to be decreed or an estimated basis, of what is considered reasonable having regard to all the circumstances of the case.

The amount of damages is not restricted to the bare actual loss shown to have been incurred on specific losses of sales, but the Plaintiff is also entitled to damages for general loss of business besides. It may be necessary for him however to show that such general loss of business has been caused by the threats and is not due to extraneous causes.<sup>35</sup>

Damages due to the loss of a profitable contract, through the negotiations being broken off directly because of the threats, even though no actual contract had as yet been entered into, have been held recoverable.<sup>36</sup>

#### Costs.

The ordinary principles as to orders for costs are applicable in threats suits. Costs usually follow the event.<sup>37</sup>

But in certain English cases, as where the defence has been successful only by reason of the immunity granted by the proviso to the section, though the suit has been dismissed, no order has been made as to costs.<sup>38</sup>

#### Certificate.

The provisions of Sec. 32 of the Indian Act being made expressly only applicable in the case of "a suit for infringement

<sup>35</sup> See *Ungar v. Sugg*, 8. R. P. C. 388 and 9. R. P. C. 113 (C. A.); *Skinner v. Perry*, 11 R. P. C. 406; *Cars v. Bland Light Syndicate Ltd.*, 28. R. P. C. 33, and at p. 41. Compare *Driffield Co. v. Waterloo Co.*, 3. R. P. C. 46; *Hoffnung & Co. v. Salisbury*, 16. R. P. C. 375; *Horne v. Johnston Bros.*, 38. R. P. C. 366; *Pittivel & Co. v. Brackelsbury Melting Processes Ltd.*, 49. R. P. C. 73.

<sup>36</sup> See *Solanite Sign Ltd. v. Wood*, 50. R. P. C. 315.

<sup>37</sup> See *Fletcher Moulton* (1913: edn.) p. 229: and *Craig v. Dowling* 25. R. P. C. 259 (C. A.).

<sup>38</sup> See *Fletcher Moulton* (1913 edn.) p. 229 note (f).

of a Patent", it would seem the better view that no certificate of validity questioned can be granted in India in a suit for threats, even though the issue of the invalidity of the Patent is put in issue and decided.<sup>39</sup>

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<sup>39</sup> For cases where this point has been raised in England see *Crampton v. Patents Investments Co.*, 5. R. P. C. 382, where a certificate was granted by Field J., but with considerable doubt and without prejudice to the validity of such certificate, and, *Fittervil & Co. v. Brackelsbury Melting Processes Ltd.*, 49. R. P. C. 73, where a certificate was refused. It may be noted that for the present purpose Sec. 35 of the English Act is worded similarly to Sec. 32 of the Indian Act. It is however in England open to the Defendant (the Patentee) to counterclaim for an injunction and damages for infringement. In a case where there is such a counterclaim it may be that in England a certificate of validity questioned may be granted; the suit then being treated (for the counterclaim) as "a suit for infringement of a Patent" within the Section. But in India it would seem that no such counterclaim is open to a Defendant in a suit for threats; and that accordingly no question arises whether a certificate can be granted in India in such a case,

## **CHAPTER XX**

### **PROCEDURE AS TO PROCEEDINGS BEFORE HIS EXCELLENCY THE GOVERNOR GENERAL IN COUNCIL—PETITIONS IN JURISDICTION OF FIRST INSTANCE—APPEALS FROM DECISIONS OF THE CONTROLLER.**

**Proceedings before H. E. The Governor General in Council.**

It has already been observed in Chapter V, that in the administration of the Patent system in British India considerable powers are vested in, and only to be exercised by, H. E. the Governor General in Council. Not least among such powers is the jurisdiction to dispose of appeals from the decision of the Controller of Patents in certain instances, and in others a jurisdiction of first instance which is unappealable.

The instances in which under the Indian Patents and Designs Act of 1911 (as amended up to date) a jurisdiction of first instance is given to H. E. the Governor General in Council are :—

Under Section 15 : in respect of Petitions for Extension of the term of a Patent.

Under Sections 21 and 21A : in respect of giving his approval for the use of a Patent by the Crown and in settling disputes under Section 21 (4) and in giving a certificate for secrecy under Section 21A (2).

Under Sections 22 and 23 : in respect of Petitions for a compulsory licence or revocation as the case may be.

Under Section 25 : in respect of notifications of revocation thereunder.

The instances in which under the act an appellate jurisdiction is given to H. E. the Governor General in Council are :—

Under Section 5 (2) : from the decision of the Controller where the Controller has refused to accept, or has refused to accept without amendment, an application for Patent,

Under Section 9 (3) : from the decision of the Controller in opposition proceedings.

Under Section 10 (1A) : from a direction by the Controller under that section in regard to joint applicants.

Under Section 16 (5) : from an order by the Controller on an application for Restoration of a lapsed Patent.

Under Section 17 (6) : from a decision by the Controller on an application for amendment.

And under Section 69(2) : from a refusal by the Controller to grant a patent on the ground of its being contrary to law or morality.

In either case it would seem that the procedure for the forwarding of the Petition or the Appeal, as the case may be, and for the disposal or hearing thereof appear to be substantially the same.

There is also a general power to give directions to the Controller on an application therefor made by the Controller in any case of doubt or difficulty in the administration of any of the provisions of the Act : under Section 68.

## PETITIONS

### Provisions as to Procedure.

With regard to Petitions of first instance there are no material provisions in the Act itself regulating these matters, the following Rule however is applicable :—

In regard to petitions for Extension ; Rule 25.

In regard to petitions for a compulsory licence or for revocation it appears that there are no Rules specifically applicable : nor in regard to the other matters mentioned earlier in this chapter where a jurisdiction of first instance is exercised by H. E. the Governor General in Council.

It is to be observed that even in such matters where the procedure prior to the disposal or hearing of the Petition is regulated as indicated, the procedure connected with the actual disposal or hearing of the Petition is unrestricted. The procedure for the disposal of the petition or other matter is thus, it may be assumed, a matter for the discretion of H. E. the Governor General in Council,

In practice any directions as to matters of procedure to be given are given by the Department of Industries and Labour. And if special directions should in any case be desired to be obtained it is suggested that application for such directions should be made by letter to the Secretary to the Government of India, Department of Industries and Labour (either at Delhi or at Simla).

## APPEALS

### Appeals from the decision of the Controller.

It will be convenient before proceeding to consider the provisions for Appeals existing in India, first to take a brief view of the provisions for Appeals from the Comptroller which have been developed from similar beginnings in England. This will enable the present position in India to be the better appreciated.

### Provisions now in force in England as to appeals from decisions of the Comptroller.<sup>1</sup>

Under Section 92A of the English Patents & Designs Act of 1932 it has been provided as follows :—

“92A. Tribunal for appeals from the Comptroller.—(1) For the purpose of hearing appeals from decisions of the Comptroller, which

<sup>1</sup> *The provisions which previously existed in England regarding the disposal of Appeals from the Comptroller were as follows :—*In the United Kingdom under the Act of 1883, which by the provisions of Sec. 82 of that Act first set up the Patent Office under the Comptroller General of Patents on the lines upon which it exists today, an appeal lay from various decisions of the Comptroller to the Law Officer of the Crown. At that time the Comptroller in the United Kingdom had no power to administer oaths or to examine witnesses, and evidence before him had to be given in the form of statutory declarations. See *Edmunds* (1890 : edn.) p. 589. In respect of the hearing of such appeals however the Law officer was expressly given the power of examining witnesses on oath : this was under Section 38 of the Act of 1883. The practice and Procedure on such Appeals from decisions of the Comptroller to the Law Officer was regulated by Rules known as the “Law Officer’s Rules” which were made by the Law Officer of the Crown under the powers conferred by virtue of Section 38 of the English Act of 1883. See *Edmunds* (1890 : edn.) p. 589. Such Appeals continued to be heard by the Law Officers under all subsequent English Statutes until the year 1932 when by the English Patents & Designs Act 1932, provisions were made for the hearing of such appeals by a special Appeal tribunal, being a certain Judge of the High Court ; which provisions are now operative.



by virtue of this Act, are subject to an appeal to the Appeal Tribunal, there shall be constituted a tribunal (in this Act referred to as the "Appeal Tribunal") to consist of a judge of the High Court to be nominated by the Lord Chancellor.

(2) The expenses of the Appeal shall be defrayed and the fees to be taken therein may be fixed as if the Tribunal were a court of the High Court, but subject as aforesaid appeals to the Tribunal shall not be deemed to be proceedings in the High Court.

(3) The Appeal Tribunal may :—

- (a) examine witnesses on oath and administer oaths for that purpose :
  - (b) make rules regulating appeals to the Tribunal and the practice and proceedings before the Tribunal under this Act ; and
  - (c) in any proceedings under this Act by order award to any party such costs as the Tribunal consider reasonable and direct how and by what parties they are to be paid and any such order may be made a rule of court ;
- so however that, as respects rights of audience and the awarding of costs, the like practice shall be observed as, before the commencement of the Patents & Designs Act, 1932, was observed in the hearing of appeals by the law officer.

(4) The appeal Tribunal may, if it thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the Tribunal, with the consent of the Treasury, may determine."

It is to be noted that this Appeal Tribunal though it is comprised of a person who in another capacity is one of H. M. High Court Judges, in this capacity as such Appeal Tribunal functions not as a Judge of the High Court but as the agent of the Crown exercising the Crown's prerogative. Just as, before the Act of 1932, such prerogative was exercised by the Comptroller and the Law Officer of the Crown.

The Practice and Procedure in England on the hearing of such appeals by the Appeal Tribunal is regulated in addition to the provisions in Section 92A (2), (3) and (4) of the English Acts 1907-1932, by Rules known as the Patents Appeal Tribunal Rules, 1932.\*

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\* See Appendix 3 below.

**Previous Indian Provisions.**

In India, ever since the Controller of Patents & Designs and the Patent Office were first created (which was under the Act of 1911 by virtue of Section 55 thereof), such Appeals as have been open under that Act from decisions of the Controller have lain to H. E. the Governor General in Council. In this respect there has been no change in the system throughout up to the present day.

**Appeals : provisions now in force in British India.**

Where an Appeal lies from a decision of the Controller, such appeal is, under the provisions of the Indian Patents & Designs Act of 1911 now in force, in every instance to H. E. the Governor General in Council.

By Section 70 of the Indian Patents & Designs Act of 1911, as amended by the Act of 1930, it is provided as follows :—

“70. (1) Where an appeal is declared by this Act to lie from the Controller to the Governor General in Council, the appeal shall be made within three months of the date of the order passed by the Controller, and shall be in writing, and accompanied by the prescribed fee.

(2) In calculating the said period of three months, the time (if any) occupied in granting a copy of the order appealed against shall be excluded.

(3) The Governor General in Council may, if he thinks fit, obtain the assistance of an expert in deciding such appeals, and the decisions of the Governor General in Council shall be final.”

By Rule 62 of the Indian 1933 Rules it is provided as follows :—

“62(1) An appeal to the Governor General in Council, under any provision of the Act from a decision of the Controller shall be lodged with the Controller in duplicate and shall state fully the reasons for appealing.

(2) The Controller shall forward one copy of the appeal to the Governor General in Council through the Secretary in the Department of Industries and Labour, who shall notify the appellant of its receipt.

(3) In appeals under Sections 9, 10(1A), 16 and 17 of the Act, the Governor General in Council may either dismiss the appeal

summarily or call upon the appellant or his agent to serve a copy of the appeal on the respondent or his agent.

(4) When so required by the Governor General in Council, the appellant or his agent shall forthwith furnish the respondent or his agent with a copy of the appeal and intimate to the Controller the date of supply of the copy.

(5) If a copy of the appeal is supplied to the respondent or his agent, the respondent or his agent may leave at the Office a reply in writing within one month of the date of receipt of a copy of the appeal. Every such reply shall deal in full with the statement of the appeal, and shall be in triplicate.

(6) If a reply is supplied under sub-rule (5), the Controller shall furnish the appellant or his agent with one copy thereof and forward one copy to the Governor General in Council.

(7) After considering the appeal and the reply, if any, the Governor General in Council may either allow the appeal or call upon the appellant or his agent to furnish a rejoinder and, if so called upon, the appellant or his agent shall leave at the Office a rejoinder in writing within one month of the date of such requisition. The rejoinder shall be confined strictly to matters in reply and shall be in triplicate. One copy of the rejoinder shall be sent by the Controller to the respondent or his agent and one copy to the Governor General in Council.

(8) On completion of these proceedings, if any, or at such other time as he may see fit, the Governor General in Council shall consider the appeal together with the reply and the rejoinder, if any, and decide the case. The decision of the Governor General in Council shall be communicated to the Controller and to the parties or their agents by the Secretary in the Department of Industries and Labour."

The appeal is required to be made on Form No. 5 (see Appendix No. 5 below).

The fee payable in respect of the filing of such an Appeal is Rs. 30 (as provided for in Item No. 52 of the First Schedule to the Act which relates to fees fixed in accordance with Section 57 of the Act).

### **Powers of H. E. the Governor General in Council in respect of such appeals.**

It has been held by the Calcutta High Court that in disposing of an appeal from a decision of the Controller under Section 9 of the Act, that is to say a decision in proceedings in opposition to the grant of a Patent, H. E. the Governor General in Council has power to remand the matter for re-hearing or for the taking of fresh evidence by the Controller. The material observations in the judgment of the Court (Lort-Williams and Jack JJ.), delivered by Lort Williams J., were as follows :—

“In this case, at first I was doubtful whether the right of appeal to the Governor General in Council was adequate to enable the tribunal to grant the remedy asked for by the applicants, that is to say, whether the Governor General in Council under this Act has power to remand the case to the Controller for further hearing or re-hearing or to hear further witnesses. The power of remand is not specifically given in the Act, whereas in the Code of Civil Procedure such power is specifically given to this and other Courts in India. Rule 62 of the Act which contains the provisions relating to appeals, makes no mention of any such power of remand. Mr. Barwell however has drawn our attention to an unreported case, in which he was engaged, which was tried by the Controller of Patents in Calcutta, and from which there was an appeal to the Governor General in Council in which an order of remand was made. Moreover, I am of opinion, that all Courts of Appeal have inherent powers of remand, and in this sense, I find it difficult to distinguish the power which has been given to the Governor General in Council as a Court of Appeal from the decisions of the Controller in Patent cases. In Fletcher Moulton on Patents, 1913, at page 284, there is a note to the effect that the law-officer has power to send the case back to the Controller for re-hearing. The authority for this is *Warman's Application*. In the matter of *Chamber's Application for a Patent*. Lord Buckmaster (then Sir S. C. Buckmaster, Solicitor-General) said :—“I always regard an appeal before me strictly as a re-hearing, and when it comes to hearing witnesses, it appears to me there is no meaning in an appeal if the witnesses are confined to what they said before. I understand that my predecessors have acted in the same way before as I have. I should certainly admit

any evidence on both sides, unless there was some very good reason why I should not."<sup>3</sup> It is to be remembered that the Law Officer in England was in the same position regarding appeals as the Governor General in Council is in India. It is clear, therefore, that if it be necessary, a remand may be ordered and further witnesses examined by the Controller, or the case may be ordered to be re-heard."

It will be noted that in this case the Appeal Bench of the Calcutta High Court unequivocally decided that the opponent in the Opposition Proceedings before the Controller was entitled to have the evidence of the witness he desired to call heard in the Opposition Proceedings. The Writ of Prohibition was only refused to be issued partly because the matter was no longer in the hands of the Controller, he having given his final decision, and therefore a writ on the Controller might be ineffective, and partly because the learned Judges considered that the Appeal Tribunal appointed under the Act, consisting of H. E. the Governor General in Council, would, in the ordinary course of procedure under the Act, itself have a re-hearing of the opposition proceedings, (as used to be done by the Law Officers in England), in which case it might itself hear the evidence of the witness in question; and considered that the Appeal Tribunal, alternatively, if it preferred that the evidence of the witness should be taken in the first instance by the Controller, had full power to remand the case for re-hearing to the Controller, with directions that evidence of the witness in question should be taken by him. Actually, in spite of the observations of the learned Judges, the statutory Appeal Tribunal finally did not in fact have any hearing itself of the Appeal or any re-hearing of the Opposition Proceedings and did not, either, remand the case to the Controller for re-hearing. The evidence of the witness in question was never heard. No opportunity for argument of the merits of the appeal

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<sup>3</sup> In spite of the above observations it would appear that the mode of the disposal of an Appeal by H. E. the Governor General in Council is not in all cases the same as that adopted by the Law Officers in England, which is referred to in the above judgment; on certain of the rare occasions when an Appeal has been sought to be put forward to H. E. the Governor General in Council, though the case has been one of the highest importance to the parties as well as to the public in India, a procedure has been adopted for its disposal whereby there has been no hearing of the Appeal at all and nothing more than a disposal of the Appeal on paper.

was ever afforded to the Appellant or his representatives; and none of the parties or their representatives were heard by anyone on the appeal. After more than one year had elapsed from the date of the filing of the appeal against the decision of the Controller, the Appellant, that is to say the opponent to the grant of the Patent in question, was briefly informed by an official communication in writing to the effect that H. E. the Governor-General in Council saw no reason to interfere with the decision of the Controller.

If the procedure followed in that case were to be taken as a precedent in future for the disposal of appeals from the Controller under the Indian Patents and Designs Act, it is submitted that such a practice would not be in keeping with the Act.

With whatever degree of care a case may have been considered on paper by the various departments and officials of Government to whom it may have been circulated during the year which may elapse (as in the last mentioned case) before the final decision is given, it may be doubted, it is respectfully submitted, whether such a method of disposing of an appeal from the Controller merely on paper, without any hearing of the parties or their representatives—so fundamentally different from the procedure of a full hearing of the appeal which has always been adopted under similar provisions of the English Act in England ever since the office of Comptroller of Patents was first created—can in truth be considered a proper compliance with the provisions of the Indian Patents and Designs Act, which expressly enacted that there should be from such decisions of the Controller, a right of appeal.<sup>4</sup>

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<sup>4</sup> See also at p. 433 above. The process of appeal to H. E. the Governor General is in practice cumbersome, expensive and delayed. In practice it appears to take at least a year or more from the date of the decision of the Controller appealed against, before such an appeal is disposed of, no matter how small may be the point to be decided. It may be that it is considered at present that the scarcity of such appeals does not warrant any alteration in the system. This may be so at present, though the scarcity itself may be partially due to the difficulties which lie in the path of an appellant under the present system. Certainly when the volume of Patent business increases, it would seem desirable that a system similar to the system now in force in the United Kingdom might be adopted; of having such appeals decided by an Appeal Tribunal for which a Judge of a High Court is chosen. In the meantime it may be considered whether the early introduction of such a system now, when there would be but little pending business to be interfered with and the switch-over from one system to the other could be made with no difficulty, might not be a more simple matter administratively than a change later, if such change is in any event to be effected.

It is respectfully submitted that H. E. the Governor-General in Council, for the disposal of such appeals from decisions of the Controller, has ample powers under the current Indian Act to have a full hearing of the parties or their representatives on such an appeal—as in England; and that only by thus affording a full hearing of such an appeal will the rights of the parties be fully protected and the provisions of the Act, which create this right of Appeal, be satisfactorily fulfilled.

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# APPENDICES





## APPENDIX I

### THE STATUTE OF MONOPOLIES OF 1623

being 21 Jac. I. C. 3.

An act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.<sup>1</sup>

Forasmuch as Your most excellent Majesty, in your Royal Judgment, and of your blessed Disposition to the Weal and Quiet of your Subjects, did in the year of our Lord God One Thousand six hundred and ten, publish in Print to the whole Realm, and to all posterity, that all Grants and Monopolies, and of the Benefit of any Penal Laws, or of Power to dispense with the Law, or to compound for the Forfeiture, are contrary to Your Majesty's Laws, which Your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental Laws of this your Realm : And whereas Your Majesty was further graciously pleased, expressly to command, that no Suiter should presume to move your Majesty for matters of that Nature ; yet nevertheless upon Misinformations, and untrue Pretences of Publick Good, many such Grants have been unduly obtained, and unlawfully put in Execution, to the great Grievance and Inconvenience of Your Majesty's Subjects, contrary to the Laws of this Your Realm, and contrary to Your Majesty's most Royal and Blessed Intention so published as aforesaid ; For avoiding whereof, and preventing of the like in time to come, may it please Your Majesty, at the humble Suit of the Lords Spiritual and Temporal, and the Commons, in this present Parliament assembled, that it may be declared and enacted ; and be it declared and enacted by the Authority of this present Parliament, That all Monopolies, and all Commissions, Grants, Licences, Charters and Letters Patents heretofore made or granted, or hereafter to be made or granted, to any Person or Persons, Bodies Politick or Corporate whatsoever, of or for the sole buying, selling, making, working or using of any Thing within this Realm, or the Dominion of Wales, or of any other Monopolies

Monopolies etc.

void.

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<sup>1</sup> The effect of the Statute is discussed at page 13 above.

or of Power, Liberty or Faculty, to dispense with any others, or to give Licence or Toleration to do, use or exercise any Thing against the Tenor or Purport of any Law or Statute ; or to give or make any Warrant for any such Dispensation, Licence or Toleration to be had or made ; or to agree or compound with any others for any Penalty or Forfeitures limited by any Statute ; or of any Grant or Promise of the Benefit, Profit or Commodity of any Forfeiture, Penalty or Sum of Money, that is or shall be due by any Statute, before Judgment thereupon had ; and all Proclamations, Inhibitions, Restraints, Warrants of Assistance and all other Matters and Things whatsoever, any way tending to the instituting, erecting, strengthening, furthering or countenancing of the same or any of them ; are altogether contrary to the laws of this Realm, and so are and shall be utterly void and of none effect, and in no wise to be put in Use or Execution.

II. And be it further declared and enacted by the Authority aforesaid, That all Monopolies, and all such Commissions, Grants, Licences, Charters, Letters Patents, Proclamations, Inhibitions, Restraints, Warrants of Assistance, and all other Matters and Things tending as aforesaid, and the Force and validity of them and of every of them, ought to be and shall be for ever hereafter examined, heard, tried and determined by and according to the Common Laws of this Realm, and not otherwise.

[See page 13 above.]

III. And be it further enacted by the Authority aforesaid, That any Person and Persons, Bodies Politick and Corporate whatsoever, which now are or hereafter shall stand and be disabled and incapable to have, use, exercise or put in Use any Monopoly, or any such Commission, Grant, Licence, Charter, Letters Patents, Proclamation, Inhibition, Restraint, Warrant of Assistance or other Matter or Thing tending as aforesaid, or any Liberty, Power or Faculty, grounded or pretended to be grounded upon them or any of them.

IV. And be it further enacted by the Authority aforesaid, That if any Person or Persons at any Time after the End of Forty Days next after the End of this present Session of Parliament, shall be hindered, grieved, disturbed or disquieted, or his or their Goods or

Party grieved by  
pretext of Monopoly  
&c.

Monopolies &c.  
how tried.

Monopolies &c.  
forbidden.

Chattels any way seized, attached, distrained, taken, carried away or detained, by occasion or pretext of any Monopoly, or of any such Commission, Grant, Licence, Power, Liberty, Faculty, Letters Patents, Proclamation, Inhibition, Restraint, Warrant of Assistance or other Matter or Thing tending as aforesaid, and will sue to be relieved in or for any of the Premises ; that then and in every such case, the same Person and Persons shall and may have his and their Remedy for the same at the Common Law, by any Action or Actions

**Remedy.**

to be grounded upon this Statute ; the same Action and Actions to be heard and determined

in the Courts of King's Bench, Common Pleas and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their Goods or Chattels shall be so seized, attached, distrained, taken, carried away or detained ; wherein all and every such Person and Persons which shall be so hindered, grieved, disturbed or disquieted, or whose Goods or Chattels shall be so seized, attached, distrained, taken, carried away or detained, shall recover Three

**Treble Damages.**

Times so much as the Damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed or disquieted, or by means of having his or their Goods or Chattels seized, attached, distrained, taken, carried away or detained, and double Costs ; and in such Suits, or for the staying or delaying thereof, no Essoin, Protection, Wager of

**Double Costs.**

Law, Aid Prayer, Privilege, Injunction or Order of Restraint, shall be in any wise prayed, granted, admitted or allowed, nor any more than one Impar lance : And if any Person or Persons shall after Notice given that the Action depending is grounded upon this Statute, cause or procure any

**Delaying Action.**

Action of the Common Law, grounded upon this Statute, to be stayed or delayed before Judgment, by colour or means of any Order, Warrant, Power or Authority, save only of the Court wherein such action as aforesaid shall be brought and depending, or after Judgment had upon such Action, shall cause or procure the Execution of or upon any such Judgment to be stayed or delayed by colour or means of any Order, Warrant, Power or Authority, save only by Writ of Error or Attaint ; that then the said Person and Persons so offending shall incur and sustain the Pains, Penalties and Forfeitures ordained

and provided by the Statute of Provision and Praemunire made  
**Praemunire.** in the Sixteenth Year of the Reign of King  
 16 R. 2. c. 5. Richard the Second.

V. Provided nevertheless, and be it declared and enacted,  
 That any Declaration before mentioned shall not extend to any  
 Letters Patents and Grants of Privilege for the Term of One and  
 twenty Years or under, heretofore made, of the sole working or  
 making of any manner of new Manufacture within this Realm, to  
 the first and true Inventor or Inventors of such Manufactures,  
 which others at the time of the making of such Letters Patents and  
 Grants did not use, so they be not contrary to  
**Proviso for new** the Law, nor mischievous to the State, by rais-  
**Manufactures for 21** ing of the Prices of Commodities at home, or  
**Years.** hurt of Trade, or generally inconvenient ; but that the same shall be  
 of such Force as they were or should be, if this Act had not been  
 made, and of none other ; And if the same were made of more than  
 One and twenty Years, that then the same for the Term of One and  
 twenty Years only, to be accounted from the Date of the first  
 Letters Patents and Grants thereof made, shall be of such Force as  
 they were or should have been, if the same had been made but for  
 Term of One and twenty Years only, and as if this Act had never  
 been had or made, and of none other.

VI. Provided also, and be it declared and enacted, That any  
 Declaration before mentioned shall not extend to any Letters  
**For 14 Years.** Patents and Grants of Privilege for the Term of  
 Fourteen Years or under, hereafter to be made,  
 of the sole working or making of any manner of new Manufactures  
 within this Realm, to the true and first Inventor and Inventors of  
 such Manufactures, which others at the time of making such Letters  
 Patents and Grants shall not use so as also they be not contrary to  
 the Law, nor mischievous to the State, by raising Prices of Commo-  
 dities at home, or Hurt of Trade, or generally inconvenient ; the  
 said Fourteen Years to be accounted from the Date of the first  
 Letters Patents, or Grant of such Privilege hereafter to be made,  
 but that the same shall be of such Force as they should be, if this  
 Act had never been made, and of none other.

*[The effect of Sec. 6 is discussed at pages 14 and 15 above. See  
 also page 112 et seq : as to the meaning of the phrase "manner*

*of new manufacture.” Compare Sec. 2 (8) and Sec. 2 (10) of the Indian Act of 1911.]*

VII. Provided also, and it is hereby further intended, declared and enacted by Authority aforesaid, That this Act or any Thing therein contained shall not in any wise  
**Proviso.** extend or be prejudicial to any Grant or Privilege, Power or Authority whatsoever heretofore made, granted, allowed or confirmed by any Act of Parliament, now in force so long as the same shall so continue in force.

VIII. Provided also, that this Act shall not extend to any Warrant, or Privy Seal made or directed, or to be made or directed by His Majesty, His Heirs or Successors to the Justices of the Court of the King’s Bench or Common Pleas, and Barons of the Exchequer, Justices of Assize, Justices of Oyer and Terminer and Gaol-delivery, Justices of the Peace and other Justices for the time being, having Power to hear and determine Offences done against any Penal Statute, to compound for the Forfeiture of any Penal Statute, depending in Suit and Question before them or any of them respectively, after Plea pleaded by the Party Defendant.

IX. Provided also, and it is hereby further intended, declared and enacted, That this Act or any Thing therein contained shall not in any wise extend or be prejudicial unto the City of London, or to any City, Borough or Town Corporate within this Realm, for or concerning any Grants, Charters or Letters Patents, to them or any of them made or granted, or for or concerning any Custom or Customs used by or within them or any of them ; or unto any Corporations, Companies or Fellowships of any Art, Trade, Occupation or Mystery, or to Companies or Societies of Merchants within this Realm, erected for the Maintenance, Enlargement or ordering of any Trade of Merchandize ; but that the same Charters, Customs, Corporations, Companies, Fellowships and Societies, and their Liberties, Privileges, Powers and Immunities, shall be and continue of such Force and Effect as they were before the making of this Act, and of none other ; any Thing before in this Act contained to the contrary in any wise notwithstanding.

X. Provided also, and be it enacted, That this Act, or any

Declaration, Provision, Disablement, Penalty, Forfeiture or other thing before mentioned, shall not extend to any  
**Proviso for Let- Letters Patents or Grants of Privilege hereto-**  
**ters Patents that con- fore made, or hereafter to be made, of, for or**  
**cern Printing &c. concerning Printing, nor to any Commission, Grant or Letters**  
 Patents heretofore made, or hereafter to be made, of, for or concern-  
 ing the digging, making or compounding of Salt-petre or Gunpowder,  
 or the casting or making of Ordnance, or Shot for Ordnance, nor  
 to any Grant or Letters Patents heretofore made, or hereafter to  
 be made of any Office or Offices heretofore erected made or  
 ordained, and now in being and put in Execution, other than such  
 Offices as have been described by any his Majesty's Proclamation  
 or Proclamations ; But that all and every the same Grants, Commis-  
 sions and Letters Patents and all other Matters and Things tending  
 to the maintaining, strengthening and Furtherance of the same, or  
 any of them, shall be and remain of the like Force and Effect, and  
 no other and as free from the Declarations, Provisions, Penalties  
 and Forfeitures contained in this Act, as if this Act had never been  
 had nor made, and not otherwise.

XI. Provided also, and be it enacted, That this Act or any  
 Declaration, Provision, Disablement, Penalty, Forfeiture or other  
 Thing before mentioned, shall not extend to  
**For Commissions any Commission, Grant, Letters Patents or**  
**for Allum Mines. Privilege heretofore made, or hereafter to be**  
 made, of, for or concerning the digging, compounding or making of  
 Allum or Allum Mines, but that all and every the same Commis-  
 sions, Grants, Letters Patents and Privileges shall be and remain  
 of the like Forces and Effect, and no other, and as free from the  
 Declarations, Provisions, Penalties and Forfeitures contained in  
 this Act, as if this Act had never been had nor made, and not  
 otherwise.

XII. Provided also, and be it enacted, That this Act, or  
 any Declaration, Provision, Penalty, Forfeiture or other Thing  
 before mentioned, shall not extend or be pre-  
**For Liberties of judicial to any Use, Custom, Prescription,**  
**Newcastle upon Tine. Franchise, Freedom, Jurisdiction, Immunity,**  
 Liberty or Privilege heretofore claimed, used or enjoyed by the  
 Governors and Stewards, and Brethren of the Fellowship of the

Haft-men of the Town of Newcastle upon Tine, or by the ancient Fellowship, Guild or Fraternity, commonly called Hoaft-men, for or concerning the selling, carrying, lading, disposing, shipping, venting or trading of or for any Sea-coals, Stone-coals or Pitcoals forth or out of the Haven and River of Tine ; or to any Grant made by the said Governor and Stewards, and Brethren of the Fellowship of the said Hoaft-men, to the late Queen Elizabeth of any Duty or Sum of Money to be paid for or in respect of any such Coals as afore-said ; nor to any Grants, Letters Patents or

**And Licences of keeping Taverns.** Commission, heretofore granted, or hereafter to be granted, of, for or concerning the licensing of the keeping of any Tavernor Taverns, or selling, utterly or retailing of Wines to be drunk or spent in the Mansion House or Houses, or other Place in the Tenure or Occupation of the Party or Parties so selling or uttering the same or for or concerning the making of any Compositions for such Licences, so as the Benefit of such Compositions be reserved and applied to and for the Use of His Majesty, His Heirs or Successors, and not to the private Use of any other person or persons.

(Proviso for Letters Patents to Sir Robert Mansel Knight, or to James Maxwell Esquire, concerning the Exportation of Calve Skins §. 13).

(And for Letters Patents granted to Abraham Baker for making of Smalt, &c. And for Privilege granted to Edward Lord Dudley for melting of Iron Ewer, &c. §. 14.)

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## **APPENDIX II**

### **CONCERNING REPEALED ENGLISH STATUTES**

For the purposes of this Book it is unnecessary to insert in full the English Statutes which have been repealed. The extra quantity of this matter would make the book unduly bulky and the increased utility to the reader would be but small in comparison.

For the reader's convenience, however, the references to the principal Statutes, which have been so repealed, are collected and noted here :—

1. Lord Brougham's Act 1835. An Act to amend the Law touching Letters Patent for Inventors. (10th September 1835) : 5 & 6 Will. 4, c. 83.

(This Act was repealed by Section 113 of the Act of 1883.)

2. 2 & 3 Vict., c. 67. An act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching Letters Patent for Inventions." (24th Aug. 1839.)

3. 7 & 8 Vict., c. 69. An Act for amending an Act passed in the Fourth Year of the Reign of his late Majesty, intituled "An Act for the better Administration of Justice in his Majesty's Privy Council," and to extend its Jurisdiction and Powers. (See Sections 2, 3, 4, 5, 6 & 7 only as relating to Patents.) (6th August 1844).

(Section 2, 3, 4 & 5 were repealed by Section 113 of the Act 1883 ; and Sections 6 & 7 were repealed by Statute Law Revocation (No. 2) Act of 1874.)

4. 14 Vict. c. 8. The Protection of Inventions Act, 1851 : An Act to extend the Provisions of the Designs Act, 1850, and to give Protection from Piracy to Persons exhibiting new Inventions in the Exhibition of the Works of Industry of all Nations in One thousand eight hundred and fifty-one. (11th April 1851.)

(This Act was repealed by the Statute Law Revocation Act, 1875.)

5. 14 & 15 Vict. c. 82. An Act to simplify the Forms of Appointment to certain Offices, and the manner of passing Grants under the Great Seal. (7th August 1851.)

(This Act was repealed by 47 & 48 Vict. c. 30 Section 5.)

6. 15 Vict. c. 6. An Act for extending the Term of the Provisional Registration of Inventions under "The Protection of Inventions Act 1851."

(This Act was repealed by the Statute Law Revocation Act, 1875.)

7. 15 & 16 Vict. c. 83. The Patent Law Amendment Act 1852. An Act for amending the Law of granting Patents for Inventions. (1st July 1852.)

(This Act was repealed by Section 113 of the Patents & Designs Act of 1883.)

8. 16 Vict. c. 5. An Act to substitute Stamp Duties for Fees on passing Letters Patent for Inventions, and provide for the Purchase for the public Use for certain Indexes of Specification. (21st February 1853.)

(This Act was repealed by Section 113 of the Patents & Designs Act, 1883.)

9. 16 & 17 Vict. c. 115. An Act to amend certain Provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified Copies of Letters Patent and Specifications to certain Offices in Edinburgh and Dublin, and otherwise to amend the said Act. (20th August 1853.)

(This Act was repealed by Section 113 of the Patents & Designs Act, 1883.)

10. 22 Vict. c. 13. An Act to amend the Law concerning Patents for Inventions with respect to Inventions for improvements in Instruments and Munitions of War. (8th April 1859.)

(This Act was repealed by Section 113 of the Patents & Designs Act, 1883.)

11. 28 Vict. c. 3. The Industrial Exhibitions Act, 1865: An Act for the Protection of Inventions and Designs exhibited at certain Industrial Exhibitions in the United Kingdom. (27th March 1865.)

12. 33 & 34 Vict. c. 27. The Protection of Inventions Act, 1870: An Act for the Protection of Inventions exhibited at International Exhibitions in the United Kingdom. (14th July 1870.)

(This Act was repealed by Section 113 of the Patents and Designs Act, 1883.)

13. 43 and 44 Vict. c. 10. The Great Seal Act, 1880: An Act to amend the Law respecting the Manner of passing Grants under the Great Seal, and respecting Officers connected therewith. (2nd August 1880.)

(This Act was repealed by Section 113 of the Patents and Designs Act, 1883.)

14. 45 and 46 Vict. c. 72. The Revenue Friendly Societies and National Debt Act, 1882. An Act for amending the Laws relating to Customs and Inland Revenue, and Postage and other Stamps, and for making further Provision respecting the National Debt, and Charges payable out of the Public Revenue, or by the Commissioners for the Reduction of the National Debt; and for other purposes.

15. 46 and 47 Vict. c. 57. The Patent Designs and Trade Marks Act, 1883. An Act to amend and consolidate the Law relating to Patents for Inventions, Registrations of Designs and of Trade Marks.

(The whole of this Act, except Sec. 26 (5), Sec. 26 (6) and Sec. 26 (7), Sec. 29, Sec. 47(2) and Sec. 47(3) and Sec. 48 thereof, was repealed by Sec. 98 of the Patents and Designs Act, 1907).

16. 48 and 49 Vict. c. 63. The Patents, Designs, and Trade Marks (Amend-

ment) Act 1885. An Act to amend the Patents and Designs and Trade Marks Act 1883.

(This Act was repealed by Section 98 of the Act of 1907.)

17. 49 and 50 Vict. c. 37. The Patents Act, 1886. An Act to remove certain doubts respecting the construction of the Patents, Designs and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. (25th June 1886.)

(This Act was repealed by Section 98 of the Act of 1907.)

18. 51 and 52 Vict. c. 50. The Patents, Designs and Trade Marks Act 1888. An Act to amend the Patents, Designs and Trade Marks Act 1883.

(This Act was repealed by Section 98 of the Act of 1907.)

Note the four last mentioned Acts were cited as "The Patents, Designs and Trade Marks Acts, 1883 to 1888."

19. The Patents Act 1901 : 1 Edw. 7. c. 18. (This Act was repealed by Section 98 of the Act of 1907.)

20. The Patents Act 1902 : 2 Edw. 7. c. 34. An Act to amend the law with reference to applications for patents and compulsory licences, and other matters connected therewith. (18th Dec. 1902.)

(This Act was repealed by Section 98 of the Act of 1907.)

21. The Patents and Designs (Amendment) Act, 1907 : 7 Edw. 7. c. 28.

(This Act was repealed by Section 98 of the Patents and Designs Act, 1907.)

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**APPENDIX III**  
**CURRENT ENGLISH STATUTES AND RULES**

## CONTENTS

**N. B.** *None of these are directly operative in India since, of course, the Statutes and Rules here referred to have no legal effect at all in India. It will however frequently be found useful in practice by practitioners in India to refer to these English Statutes and English Rules e.g. for comparison with the Indian Act and Rules and in connection with references to English cases, the principles of which may be enforced in the Courts in India.*

1. English Patents and Designs Acts 1907-1932.
2. English Register of Patent Agents Rules  
(Statutory Rules and Orders No. 820 of 1932 : dated 4th October 1932).
3. English Patents Rules 1932.  
(Statutory Rules and Orders No. 873 of 1932 : dated 25th October 1932).
4. English Patents Appeal Tribunal Rules, 1932.  
(Statutory Rules and Orders No. 887 of 1932 : dated 31st October 1932).
5. Certain English Rules of the Supreme Court being Order 53A and certain other Rules which relate directly to Patents.

# THE PATENTS AND DESIGNS ACT, 1907

(7 Edw. 7, c. 29.)

(As amended up to 12th July 1932)

## Arrangement of Sections.

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*An act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks.*

[Printed (in accordance with 22 & 23 Geo. 5, c. 32, s. 14) as amended up to 12th July, 1932 by the Patents and Designs Act, 1914 (4 & 5 Geo. 5, c. 18) the Patent and Designs Act, 1919 (9 & 10 Geo. 5, c. 80), the Patents and Designs (Convention) Act, 1928 (18 Geo. 5, c. 3) and the Patents and Designs Act, 1932 (22 & 23 Geo. 5, c. 32.)]

## PART I

### PATENTS

#### Application for and Grant of Patent

1. **Application.**—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

[Sec. 3 of the Indian Act.]

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

[Sec. 3(2) of the Indian Act.]

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

[Sec. 3(3) of the Indian Act.]

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

2. **Specifications.**—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the Comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

(5) Where the invention in respect of which an application is made is a chemical invention, then subject to the prescribed rules, typical samples and specimens shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification, and the applicant shall be at liberty, where he so desires, and subject to the prescribed rules, so to furnish any typical samples and specimens, unless the Comptroller in any particular case considers that it is undesirable that any should be received.

[Compare Sec. 4 of the Indian Act.]

**3. Proceedings upon application.**—(1) The Comptroller shall refer every application to an examiner.

[Compare Sec. 5 of the Indian Act.]

(2) If the examiner reports that the nature of the invention is not fairly described, or as respects a complete specification that the nature of the invention or the manner in which it is to be performed is not therein particularly described and uncertain, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, be deemed to have been made on the date on which the requirement is complied with.

(3) The Comptroller may, where the application was accompanied by a specification purporting to be a complete specification, if the applicant so requests, treat the specification as a provisional specification and proceed with the application accordingly.

(4) The Comptroller may, where the applicant before acceptance of the complete specification so requests and upon payment by the applicant of the prescribed fee, direct that the application shall be deemed to have been made on such date within a period of six months running from the date when the application was actually made, as the applicant may request.

(5) The applicant may appeal from any decision of the Comptroller under this section to the Appeal Tribunal, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(6) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

**4. Provisional protection.**—An invention may, during the period between the date of an application for a patent therefor and the date of sealing a patent on that application be used and published without prejudice to that patent, and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

In this section the expression "date of an application for a patent" means, as respects an application which is post-dated or ante-dated under this Act, the date to which the application is so post-dated or ante-dated, and means, as respects any other application, the date on which it is actually made.

**5. Time for leaving complete specification.**—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within twelve months from the date of the application :

Provided that where an application is made for an extension of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

**6. Comparison of provisional and complete specification.**—(1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner,

(2) If the examiner reports that the nature of the invention or the manner in which it is to be performed is not particularly described and ascertained in the complete specification or that the complete specification or drawings have not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may—

(a) refuse to accept the complete specification until it has been amended to his satisfaction ; or

(b) (with the consent of the applicant) cancel the provisional specification and direct that the application shall be deemed to have been made on the date at which the complete specification was left and proceed with the application accordingly :

Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and allow an application for the additional invention included in the complete specification to be made and direct that the application shall be deemed to have been made on the date at which the complete specification was left.

(4) An appeal shall lie from the decision of the Comptroller under this section to the Appeal Tribunal, who shall, if required, hear the applicant and the Comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

[In India there are no separate provisional specifications and complete specifications but only one class of specification. There are no provisions corresponding to these sections in the Indian Act.]

**7. Investigation of previous publications in United Kingdom on applications for patents.**—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed

to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date which the patent applied for would bear if granted and left pursuant to any application for a patent made in the United Kingdom and dated within fifty years next before such date.

(2) If on investigation it appears that the invention claimed has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the Comptroller is not so satisfied, he shall, unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public :

Provided that the Comptroller, if satisfied that the invention claimed has been wholly and specifically claimed or wholly and specifically described in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) If it is within the knowledge of the Comptroller that the invention claimed has been made available to the public by publication in the United Kingdom, before the date which the patent applied for would bear if granted, in any document (other than a United Kingdom specification or a specification described in the invention for the purposes of an application for protection made in any country outside the United Kingdom more than fifty years next before that date, or any abridgement of, or extract from, any such specification published under the authority of the Comptroller or of

the Government of any country outside the United Kingdom), the provisions of sub-sections (2), (3) and (4) of this section shall apply in relation to a claim or description of the invention in that document in like manner as those provisions apply in relation to a description thereof in a prior specification to which the investigation has extended.

(6) An appeal shall lie from the decision of the Comptroller under this section to the Appeal Tribunal.

[Compare Sec. 5 of the Indian Act.]

8. **Investigation of specifications published subsequently to application.**—(1) In addition to the investigation under the last preceding section, the examiner shall make an investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed in any specification published on or after the date which the patent applied for would bear if granted and deposited pursuant to an application made in the United Kingdom for a patent which if granted would bear prior date to the date which the patent applied for would bear if granted.

(2) Where on such further investigation it appears that the invention claimed has been wholly or in part claimed in any such specification, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

(3) An appeal shall lie from the decision of the Comptroller under this section to the Appeal Tribunal.

(4) The investigations and reports required by this and the last preceding section shall not be held in any way to guarantee the validity of any patent and no liability shall be incurred by the Board of Trade or any officer thereof by reason of or in connection with any such investigation or report or any proceedings consequent thereon.

[Compare Sec. 5 of the Indian Act.]

8A. **Time for acceptance of complete specification.**—Unless



a complete specification is accepted within eighteen months from the date of an application the application shall become void unless—

- (a) an appeal under any of the foregoing provisions of this Act has been lodged in respect of the application ; or
- (b) in the case of an application for a patent of addition an appeal under any of the foregoing provisions of this Act has been lodged in respect either of that application or of the application for the original patent ; or
- (c) the time within which such an appeal as aforesaid may be lodged has not expired :

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for, but not exceeding three months.

**9. Advertisement on acceptance of complete specification.—**On the acceptance of the complete specification the Comptroller shall advertise the acceptance ; and the application and specifications, with the drawings samples and specimens (if any), shall be open to public inspection.

[Sec. 6 of the Indian Act.]

**10. Effect of acceptance of complete specification.—**After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification : Provided that an applicant shall not be entitled to institute any proceeding for infringement until the patent has been sealed.

[Compare Sec. 7 of the Indian Act.]

**11. Opposition to grant of patent.—**(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification or within such further period, not exceeding one month, as the Comptroller may on an application made to him within the said period of two months and subject to payment of the prescribed fee, allow, give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds ;—

- (a) that the applicant obtained the invention or any part thereof from him, or from a person of whom he is the legal representative ; or
- (b) that the invention has prior to the date which the patent applied for would bear if granted been published in any complete specification, or in any provisional specification followed by a complete specification, deposited pursuant to any application made in the United Kingdom and dated within fifty years next before such date, or has been made available to the public by publication in any document (other than a United Kingdom specification or a specification describing the invention for the purpose of an application for protection made in any country outside the United Kingdom more than fifty years next before such date, or any abridgement of, or extract from any such specification published under the authority of the Comptroller or of the Government of any country outside the United Kingdom) published in the United Kingdom before such date ; or
- (bb) that the invention has been claimed in any complete specification for a United Kingdom patent which though not published at the date which the patent applied for would bear if granted was deposited pursuant to an application for a patent which is or will be of prior date to such patent ; or
- (c) that the nature of the invention or the manner in which it is to be performed is not sufficiently and fairly described and ascertained in the complete specification ; or
- (d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention either forms the subject of an application made by the opponent for a patent which if granted would bear a date in the interval between the date of the application and the leaving of the complete specification, or has been made available to the public by publication in any document published in the United Kingdom in that interval ; or
- (e) that in the case of an application under section ninety-

one of this Act the specification describes or claims an invention other than that for which protection has been applied for in a foreign state or any part of His Majesty's dominions outside the United Kingdom and that such other invention either forms the subject of an application made by the opponent for a patent which if granted would bear a date in the interval between the leaving of the application in the foreign state or part of His Majesty's dominions outside the United Kingdom and the date of the application in the United Kingdom, or has been made available to the public by publication in any document published in the United Kingdom in that interval,

but on no other ground.

[Compare Sec. 9(1) of the Indian Act.]

(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

[Sec. 9(2) of the Indian Act.]

(3) The decision of the Comptroller shall be subject to appeal to the Appeal Tribunal who shall, if required, hear the applicant and the opponent, if the opponent is, in the opinion of the Tribunal, a person entitled to be heard in opposition to the grant of the patent and shall decide the case.

[Compare Sec. 9(3) of the Indian Act.]

**12. Grant and sealing of patent.**—(1) If there is no opposition or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the Comptroller shall cause the patent to be sealed with the seal of the Patent Office.

Provided that—

- (a) where an applicant under a joint application has died, the patent may, with the consent of his personal representative, be granted to the survivors or survivor of the joint applicants ;

- (b) where an applicant has agreed in writing to assign the patent when granted or, in the case of joint application, his interest in the patent when granted, the patent may, upon proof of the agreement to the satisfaction of the Comptroller, be granted to the assignee or, in the case of an assignment by a joint applicant of his interest to an assignee not being the other joint applicant, to the assignee jointly with the other applicant or his assignee.

(2) Where disputes arise between joint applicants or their assigns as to proceeding with an application, the Comptroller, if satisfied that one or more of such persons ought to be allowed to proceed alone, may allow him or them to proceed with the application and may grant a patent to him or them, so, however, that all parties interested shall be entitled to be heard before the Comptroller.

(3) An appeal shall lie from the decision of the Comptroller under this section to the Appeal Tribunal.

(4) A patent shall be sealed as soon as may be, and not after the expiration of twenty-one months from the date of application, provided that—

- (a) where the Comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said twenty-one months shall be allowed for the sealing of the patent :
- (b) where the sealing of a patent is delayed by an appeal to the Tribunal or by any proceedings taken for obtaining the decision of the Comptroller under the provisions of sub-section (2) of this section, or by opposition to the grant of the patent, that patent and any patent of addition the sealing whereof is delayed in consequence of the delay in the sealing of that patent may be sealed at such time as in the first-mentioned case the Tribunal, or in either of the two last-mentioned cases the Comptroller, may direct :
- (c) where the patent is granted to the legal representative of an applicant who has died before the expiration of

the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death, or at such later time as the Comptroller may think fit :

- (d) where it is proved to the satisfaction of the Comptroller that hardship would arise in connection with the prosecution by an applicant of an application for a patent in any country outside the United Kingdom unless the maximum period which would otherwise be allowed for sealing the patent is extended, that period may be extended subject to payment of the prescribed fee to such an extent as appears to the Comptroller to be necessary in order to prevent that hardship arising :
- (e) where for any reason a patent cannot be sealed within the period allowed by this section, that period may, on the payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed.

[Compare Sec. 10 of the Indian Act.]

**13. Date of payment.**—Except as otherwise expressly provided by this Act, a patent shall be dated as of the date of the application : Provided that no proceedings shall be taken in respect of an infringement committed before the acceptance of the complete specification.

[Compare Sec. 11 of the Indian Act.]

**14. Effect, extent and form of Patent.**—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man :

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim ; and it shall not be competent for any person

in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

[Compare Sec. 12 of the Indian Act.]

**15. Fraudulent applications for patents.**—(1) A patent granted on the application of the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

(2) Where a patent has been revoked by the court on the ground that it has been obtained in fraud of the true and first inventor, or where the grant has been refused by the Comptroller under the provisions of paragraph (a) of sub-section (1) of section eleven of this Act, or revoked on the same ground under the provisions of section twenty-six of this Act, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention in lieu of and bearing the same date as the patent so revoked, or as would have been borne by the patent if the grant thereof had not been refused.

(3) Where in proceedings before the Comptroller under this Act for opposition to the grant of a patent or for revocation of a patent, the Comptroller has found that an invention was in part obtained from the opponent or the applicant for revocation and has required that the specification be amended by exclusion of that part of the invention, he may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent for that excluded part of the invention bearing the date of the opposed application or the date of the patent sought to be revoked as the case may be.

(4) No action shall be brought for any infringement of a patent granted under the provisions of either of the last two foregoing sub-sections committed before the date of sealing the patent.

[Compare Sec. 13 of the Indian Act.]

**16. Single patent for cognate inventions.**—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and

has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same, and in determining other questions under this Act, the court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed in the complete specification.

[There being no provisional specifications in India, there is no corresponding provision in the Indian Act.]

### **Term of Patent.**

17. **Term of patent.**—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be sixteen years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the Comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

[Compare Sec. 14 of the Indian Act.]

18. **Extension of term of patent.**—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent;

Provided that the Court may allow such a petition to be presented at such time, not being later than the time limited for the expiration of the patent, as the court may in its discretion think fit.

(2) Any person may give notice to the court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

(4) The court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding five years, or, in exceptional cases, ten years, or may order the grant of a new patent for such term as may be specified in the order and containing any restrictions, conditions, and provisions the court may think fit.

(6) Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the court in considering its decision may have regard solely to the loss or damage so suffered by the patentee :

Provided that this sub-section shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's dominions.

[Compare Sec. 15 of the Indian Act.]

**19. Patents of addition.**—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee,



as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

(2) Where an application containing such a request is made, a patent of addition may be granted for such term as aforesaid.

(3) Where an invention, being an improvement in or modification of an original invention, is the subject of an independent patent and the patentee in respect of the independent patent, being also the patentee in respect of the patent for the original invention, so requests, the Comptroller may make an order for the revocation of the independent patent and a patent of addition may be granted in respect of the improvement or modification bearing the same date as the date of the independent patent so revoked.

(4) A patent of addition shall remain in force during the term limited in the patent for the original invention or until the previous cesser thereof and no longer, but may be extended under the last foregoing section for any period for which the patent for the original invention is extended thereunder, and in respect of a patent of addition no fees shall be payable for renewal :

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the court or Comptroller so orders, become an independent patent, and the fees payable, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(5) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

[Compare Sec. 15A of the Indian Act.]

### **Restoration of lapsed Patents.**

20. **Restoration of lapsed patents.**—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the

Comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Comptroller shall hear the case and issue an order either restoring the patent or dismissing the application :

Provided that the Comptroller may, if he thinks fit, as a condition of issuing an order under this section restoring a patent require that an entry shall be made in the register of patents in respect of any document or instrument in respect of which the provisions of this Act as to entries in the register have not been complied with.

(6) In every order under this section restoring a patent such provision as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the Official Journal (Patents).

(7) An appeal shall lie from the decision of the Comptroller under this section to the Court.

[Compare Sec. 16 of the Indian Act.]

#### **Amendment of Specification.**

**21. Amendment of specification by Comptroller.**—(1) An applicant at any time after acceptance of his complete specification or a patentee at any time may, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the Comptroller in either case shall be subject to an appeal, where the person making the request to amend is a patentee, to the court, and, where the person making the request to amend is an applicant for a patent, to the Appeal Tribunal and the court or the Tribunal, as the case may be, shall, if required, hear the person making the request to amend, and, where notice of opposition has been given the person giving that notice, if he is in the opinion of the court or of the Tribunal, as the case may be, entitled to be heard in opposition to the request, and, where there is no opposition the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification:

Provided that the court shall be entitled in construing a specification as amended to refer to the specification as accepted and published.

(8) This section shall not apply when and so long as any

action for infringement or proceeding before the court for the revocation of a patent is pending.

[Compare Sec. 17 of the Indian Act.]

**22. Amendment of specification by the court.**—In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner, and subject to such terms as to costs, advertisements or otherwise, as the court may think fit :

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

[Compare Sec. 18 of the Indian Act.]

**23. Restriction on recovery of damages.**—Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the date of the decision allowing the amendment, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

[Compare Sec. 19 of the Indian Act.]

### **Compulsory Licences and Revocation.**

**24. Provisions as to patents indorsed "licences of right".**—

(1) At any time after the sealing of a patent the Comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words "licences of right", and a corresponding entry to be made in the register, and thereupon—

(a) any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in default of agreement, may be settled by the Comptroller on the application of either the patentee or the applicant :

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this sub-section as if they had been imposed by the Comptroller thereunder in like manner as if the terms had been settled by the Comptroller :

(b) in settling the terms of any such licence the Comptroller shall be guided by the following considerations—

(i) he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights ;

(ii) he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom ;

(iii) he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted :

Provided that, in considering the question of equality of advantage, the Comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom :

(c) any such licence the terms of which are settled by the Comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the

patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation :

- (d) every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register :
- (e) If in any action for infringement of a patent so indorsed the infringing defendant is ready and willing to take a licence upon terms to be settled by the Comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement :

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods :

- (f) the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The Comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the Official Journal (Patents), and shall satisfy himself that the patentee is not precluded by contract from making such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary :

Provided that a patentee shall not be deemed to be so preclu-

ded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences.

(3) Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the Comptroller within the prescribed time and in the prescribed manner, and the Comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement, if already made, to be cancelled.

(4) Where a patent of addition is in force any request made under this section for an indorsement either of the original patent or of the patent of addition shall be treated as a request for the indorsement of both patents, and if refused as respects the one shall be refused as respects the other also, and where a patent of addition is granted in respect of a patent which is indorsed under this section the patent of addition shall also be so indorsed.

(5) All indorsements of patents under this section shall be entered on the register of patents and shall be published in the Official Journal (Patents), and in such other manner as to the Comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.

(6) The Comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made :

Provided that before acting on any application for the cancellation of an indorsement, the Comptroller shall advertise the application in the prescribed manner and shall satisfy himself that there is no existing licence or that all existing licensees consent to the application.

(7) Any person may within the prescribed time and in the prescribed manner, give notice at the Patent Office of opposition to an application for the cancellation of an indorsement, and where any such notice is given the Comptroller shall, after giving notice of the opposition to the applicant and after giving to the applicant and to the opponent an opportunity of being heard, decide on the case,

(8) Any decision of the Comptroller under this section shall be subject to an appeal to the Court.

[There are no provisions under the Indian Act for the endorsement of a Patent for "licenses of right." See page 305 above.]

**25. Revocation of Patent.**—(1) Revocation of a patent may be obtained on petition to the court.

(2) A patent may be revoked upon any of the following grounds :—

- (a) that the invention was the subject of a valid prior grant ;
- (b) that the true and first inventor was not the applicant or one of the applicants for the patent ;
- (c) that the patent was obtained in fraud of rights of the person applying for the order or of any person under or through whom he claims ;
- (d) that the invention is not a manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies ;
- (e) subject as in this sub-section provided, that the invention is not new ;
- (f) that the invention is obvious and does not involve any inventive step having regard to what was known or used prior to the date of the patent ;
- (g) that the invention is not useful ;
- (h) that the complete specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed ;
- (i) that the complete specification does not sufficiently and clearly ascertain the scope of the monopoly claimed ;
- (j) that the complete specification does not disclose the best method of performance of the invention known to the applicant for the patent at the time when the specification was left at the Patent Office ;
- (k) that the patent was obtained on a false suggestion or representation ;



- (l) that the invention claimed in the complete specification is not the same as that contained in the provisional specification, and that the invention claimed, so far as it is not contained in the provisional specification was not new at the date when the complete specification was filed, or the true and first inventor was not the applicant, or one of the applicants, for the patent, or, in the case of an application made under section ninety-one of this Act, that the invention claimed in the complete specification is not the same as that for which protection has been applied for in the foreign state or part of His Majesty's dominions outside the United Kingdom ;
- (m) that the primary or intended use or exercise of the invention is contrary to law ;
- (n) that the patentee has contravened or has not complied with the conditions contained in the patent ;
- (o) that prior to the date of the patent the invention was secretly worked on a commercial scale and not merely by way of reasonable trial or experiment in the United Kingdom by the patentee or others, not being a Government department or the agents or contractors of, or other person authorised in that behalf by, a Government department ;
- (p) that in the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine the specification includes claims which under section thirty-eight A of this Act cannot lawfully be made ; or

upon any other ground upon which a patent might, immediately before the first day of January one thousand eight hundred and eighty-four, have been repealed by *scire facias* :

Provided that this sub-section shall have effect, as respects the ground of revocation specified in paragraph (e) thereof, subject to the provisions of sub-section (1) of section fifteen, sub-section (12) of section thirty, section forty-one and section forty-five of this Act.

[Compare and contrast Sec. 26 of the Indian Act.]

(3) Every ground on which a patent may be revoked shall be available as a ground of defence in an action for infringement of a patent.

[Sec. 29(2) of the Indian Act.]

(4) A petition for revocation of a patent may be presented—

(a) by the Attorney-General or any person authorised by him ; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

[Sec. 26(2) of the Indian Act.]

**26. Power of Comptroller to revoke patents.**—(1) Any person who would have been entitled to oppose the grant of a patent or is the successor in interest of a person who was so entitled may within twelve months from the date of sealing the patent apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of a patent might have been opposed :

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or expla-

nation, or dismissing the application ; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

[The provisions for "belated oppositions" here referred to have no counterpart in the Indian Act. See page 432 above.]

(3) A patentee may at any time, by giving notice in the prescribed manner to the Comptroller, offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

[Sec. 24 of the Indian Act.]

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court.

**27. Provisions for the prevention of abuse of monopoly rights.**—(1) Any person interested may at any time after the expiration of three years from the date of sealing a patent apply to the Comptroller alleging in the case of that patent that there has been an abuse of the monopoly rights thereunder and asking for relief under this section.

(2) The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances :—

(a) If the patented invention (being one capable of being worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working :

Provided that, if an application is presented to the Comptroller on this ground, and the Comptroller is of opinion that the time which has elapsed since the sealing of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the Comptroller may make an order adjourning the application for such period as will in his opinion be sufficient for that purpose.

- (b) If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement :
- (c) If the demand for the patented article in the United Kingdom is not being met to an adequate extent and on reasonable terms :
- (d) If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted :
- (e) If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached to the patentee, whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process :
- (f) If it is shown that the existence of the patent, being a patent for an invention relating to a process involving the use of materials not protected by the patent or for an invention relating to a substance produced by such a process, has been utilised by the patentee so as unfairly to prejudice in the United Kingdom the manufacture, use or sale of any such materials :

Provided that, for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay.

(3) On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the Comptroller may exercise any of the following powers as he may deem expedient in the circumstances :—

- (a) He may order the patent to be indorsed with the words “licences of right” and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the Comptroller of this power shall entitle every existing licensee to apply to the Comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the Comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the Comptroller may make such order ; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee :
- (b) He may order the grant to the applicant of a licence on such terms as the Comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given on the register ;

In settling the terms of a licence under this paragraph the Comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

- (c) If the Comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the Comptroller may think just, but subject as hereinafter provided :
- (d) If the Comptroller is satisfied that the monopoly rights have been abused in the circumstances specified in paragraph (f) of the last foregoing sub-section, he may order the grant of licences to the applicant and to such of his customers and containing such terms as the Comptroller may think expedient :
- (e) If the Comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the Comptroller may, on reasonable cause shown in any case, by subsequent order extend the interval so specified :

Provided that the Comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or part of his Majesty's dominions outside the United Kingdom ;

(f) If the Comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may make an order refusing the application and dispose of any question as to costs thereon as he thinks just.

(4) In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding sub-section, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but, subject thereto, the licence shall be so framed as—

(a) to secure to the patentee the maximum royalty compatible with the licensee working the invention within the United Kingdom on a commercial scale and at a reasonable profit ;

(b) to guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the Comptroller if the licensee fails to expend the amount specified in the licence as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order.

(5) In deciding to whom such an exclusive licence is to be granted the Comptroller shall, unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent.

(6) The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the Comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give

proper compensation to be fixed by the Comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention.

(7) Every application presented to the Comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The application must be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

(8) The Comptroller shall consider the matters alleged in the application and declarations, and, if satisfied that the applicant has a bona fide interest and that a prima facie case for relief has been made out, he shall direct the applicant to serve copies of the application and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent and shall advertise the application in the Official Journal (Patents).

(9) If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall, within such time as may be prescribed or within such extended time as the Comptroller may on application further allow, deliver to the Comptroller a counter statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.

(10) The Comptroller shall consider the counter statement and declarations in support thereof and may thereupon dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the Comptroller himself appoints a hearing. In any case the Comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.

(11) All orders of the Comptroller under this section shall be subject to appeal to the court, and on any such appeal the Attorney-General or such other counsel as he may appoint shall be entitled to appeal and be heard.



(12) In any case where the Comptroller does not dismiss an application as hereinbefore provided, and

- (a) if the parties interested consent ; or
- (b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Comptroller conveniently be made before him ;

the Comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the Comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the Comptroller under this section, and where a question or issue of fact is so referred, the arbitrator shall report his findings to the Comptroller.

(13) For the purpose of this section, the expression "patented article" includes articles made by a patented process.

[Compare Secs. 22 & 23 of the Indian Act : and Chapter VIII at p. 268 et seq above.]

### Register of patents.

28. **Register of patents.**—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be prima facie evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent, or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

[Sec. 20 of the Indian Act.]

**Crown**

**29. Right of Crown to use patented inventions.**—(1) A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves or by such of their agents, contractors, or others as may be authorised in writing by them at any time after the application, make, use or exercise the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or licence concluded between the inventor or patentee and any person other than a Government department, shall be inoperative so far as concerns the making, use or exercise of the invention for the services of the Crown :

Provided further that, where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, any Government department (such invention not having been communicated directly or indirectly by the applicant for the patent or the patentee), any Government department, or such of their agents, contractors, or others as may be authorised in writing by them, may make, use and exercise the invention, so recorded or tried for the service of the Crown, free of any royalty or other payment to the patentee, notwithstanding the existence of the patent. If in the opinion of the department the disclosure to the applicant or the patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(2) In case of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator

upon such terms as it may direct. The Court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant and such Government department. The court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent.

(3) The right to use an invention for the services of the Crown under the provisions of this section or any provisions for which this section is substituted shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown.

(4) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under the laws relating to the customs or excise.

[Compare Sec. 21 of the Indian Act.]

**30. Assignment to Secretary for War or Secretary for Air or the Admiralty of certain inventions.**—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or Secretary of State for Air or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary

of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify, the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

[Compare Sec. 21A of the Indian Act.]

### **Legal Proceedings**

31. **Hearing with assessor.**—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it think fit, and shall on the request of all of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs.

(2) The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

[Sec. 35 of the Indian Act.]

32. **Power to counterclaim for revocation in an action for infringement.**—A defendant in an action for infringement of a patent may, without presenting a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent,

[There is no provision corresponding to this section in the Indian Act. See pp. 454 and 733 above.]

**32A. Power of court in infringement action as regards relief in respect of particular claims.**—Where the court in any action for infringement of a patent finds that any claim in the specification, in respect of which infringement is alleged, is valid, but that any other claim therein is invalid, then, notwithstanding anything in section twentythree of this Act :—

- (a) if the patentee furnishes proof to the satisfaction of the court that the invalid claim was framed in good faith and with reasonable skill and knowledge, or if the patent is dated before the commencement of the Patents and Designs Act, 1932, the court shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendment of the specification as it may deem desirable, grant relief in respect of any valid claim which is infringed without regard to the invalidity of any other claim in the specification and in exercising such discretion the court may take into consideration the conduct of the parties in inserting the invalid claim in the specification or permitting that claim to remain there ;
- (b) if the patentee does not furnish proof as aforesaid, and the patent is dated after the commencement of the Patents and Designs Act, 1932, the court shall not grant any relief by way of damages or costs, but may grant such other relief in respect of any valid claim which is infringed as to the court seems just, and may impose such terms as to amendment of the specification as a condition of granting any such relief as it may deem desirable ;
- (c) if a counterclaim for revocation of the patent has been made in the action on the ground of the invalidity of any claim in the specification, the court may postpone the operation of any order made thereon during such time as may be requisite for enabling the patentee to effect any amendment of the specification pursuant to terms imposed upon him and may attach any such other

condition to any order to be made on the counterclaim as the court may deem desirable.

[Compare Sec. 35A of the Indian Act.]

**33. Exemption of innocent infringer from liability for damages.**—A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the number of the patent :

Provided that nothing in this section shall affect any proceedings for an injunction.

[Sec. 30 of the Indian Act.]

**34. Order for Inspection etc. in action.**—In an action for infringement of a patent, the plaintiff shall be entitled to relief by way of injunction and damages but not to an account of profits, but subject as aforesaid the court may on the application of either party make such order for an injunction or inspection, and impose such terms and give such directions respecting the same and the proceedings thereon as the court may see fit.

[Compare and contrast Sec. 31 of the Indian Act. And see p. 776 above.]

**35. Certificate of validity questioned and costs thereon.**—In an action for infringement of a patent, the court may certify that the validity of any claim in the specification of the patent came in question ; and if the court so certifies, then in any subsequent action for infringement of such claim the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client so far as that claim is concerned.

[Compare Sec. 32 of the Indian Act.]

**36. Remedy in case of groundless threats of legal proceedings.**—(1) Where any person, by circulars, advertisements, or otherwise, threatens any person with an action for infringement of patent or other like proceedings, then, whether the person making the threats is or is not entitled to or interested in a patent or an application for a patent, any person aggrieved thereby may bring an action against him, and may obtain a declaration to the effect that such threats are unjustifiable and an injunction against the continuance of such threats and may recover such damage, if any, as he has sustained thereby, unless the person making the threats proves that the acts in respect of which the proceedings are threatened constitute or, if done, would constitute an infringement of a patent in respect of a claim in the specification which is not shown by the plaintiff to be invalid or an infringement of rights arising from the acceptance of a complete specification in respect of a claim therein which is not shown by the plaintiff to be capable of being successfully opposed.

[Compare Sec. 36 of the Indian Act.]

(2) The defendant in any such action as aforesaid may apply, by way of a counterclaim in the action, for any relief to which he would be entitled in a separate action in respect of any infringement by the plaintiff of the patent to which the threats relate.

### Miscellaneous

**37. Joint ownership of a patent.**—(1) Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence otherwise than with their consent or in accordance with directions given under this section, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

(2) The Comptroller may, upon application for relief under this sub-section being made to him in the prescribed manner by any one or more of joint patentees, and after giving to the other joint



patentees an opportunity of being heard, give such directions in accordance with the application as to the sale or lease of the patent for the invention, or as to the grant of licences in respect thereof, or otherwise, as to the use and development of the rights thereunder as appear to him to be just and expedient, and it shall be the duty of all the joint patentees to give effect to any directions so given.

(3) If any person who is under obligation to give effect to any such directions as aforesaid fails to execute any instrument or to do any act or thing requisite for giving effect thereto within fourteen days after being requested in writing so to do by any of the joint patentees, the Comptroller may, by direction given under the last foregoing sub-section, empower any person to execute that instrument or to do that act or thing in the name and on behalf of the person in default.

(4) Nothing in this section shall be taken to authorise the use of an invention or the giving of any directions in such manner as to prejudice or affect the mutual rights or obligations of trustees or the personal representatives of a deceased person, or any rights or obligations arising out of those relationships.

(5) An order of the Comptroller giving any directions or refusing an application made under this section shall be subject to appeal to the court.

[Compare Sec. 37 of the Indian Act.]

**38. Avoidance of certain conditions attached to the sale, etc., of patented articles.**—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

- (a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees ; or
- (b) to require the purchaser, lessee or licensee to acquire from the seller, lessor, licensor, or his nominees, any article or class of articles not protected by the patent ;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy :

Provided that this sub-section shall not apply if—

- (i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid ; and
- (ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under sub-section (1) (i).

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party ; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is

determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

- (a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person ; or
- (b) be construed as validating any contract which would, apart from this section, be invalid ; or
- (c) affect any right of determining a contract or condition in a contract exerciseable independently of this section ; or
- (d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

**38A. Chemical products and substances intended for food or medicine.**—(1) In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and ascertained or by their obvious chemical equivalents :

Provided that in relation to a substance intended for food or medicine a mere admixture resulting only in the aggregation of the known properties of the ingredients of that substance shall not be deemed to be a method or process of manufacture.

(2) In an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.

(3) In the case of any patent for an invention intended for or capable of being used for the preparation or production of food or medicine, the Comptroller shall, unless he sees good reason to the contrary, grant to any person applying for the same, a licence limited to the use of the invention for the purposes of the preparation or production of food or medicine but not otherwise; and, in settling the terms of such licence and fixing the amount of royalty or other consideration payable, the Comptroller shall have regard to the desirability of making the food or medicine available to the public at the lowest possible price consistent with giving to the inventor due reward for the research leading to the invention.

Any decision of the Comptroller under this sub-section shall be subject to appeal to the court.

[There are no provisions in the Indian Act similar to the provisions of this Section. See page 139 above.]

**41. Provisions as to anticipation.**—(1) An invention covered by a patent shall not be deemed to have been anticipated by reason only of its being made available to the public by publication in the United Kingdom—

- (a) in a specification left pursuant to an application made in the United Kingdom and dated not less than fifty years before the date of the patent; or
- (b) in a specification describing the invention for the purpose of an application for protection in any country outside the United Kingdom made not less than fifty years before that date, or
- (c) in any abridgement of or extract from any such specification published under the authority of the Comptroller or of the Government of any country outside the United Kingdom, or
- (d) in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted or any part thereof having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without the knowledge and consent of the true inventor, and that the matter published was derived or obtained from the true inventor, and if the true inventor learnt of the publication before the date of his application for the patent that he applied for and obtained protection for the invention with all reasonable diligence after learning of the publication :

Provided that the protection afforded by this sub-section shall not extend to a patentee who has or whose predecessors in title (which expression shall include the applicant for the patent) have commercially worked the invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the date of the application for the patent.

[Compare and contrast Sec. 38 of the Indian Act.]

42. **Disconformity.**—A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

43. **Patent on application of representative of deceased inventor.**—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must contain a declaration by the legal representative that he believes the deceased to be the true and first inventor of the invention.

[See page 338 above.]

44. **Loss or destruction of patent.**—If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may at any time seal a duplicate thereof.

[Sec. 39 of the Indian Act.]

**44A. Request for information as to patent or patent application.**—A person making a request to the Comptroller in the prescribed manner as respects any patent specified in the request or as respects any application for a patent so specified, for information to be furnished to him by the Comptroller of any such matters as may be prescribed affecting that patent or application, shall be entitled, subject to payment of the prescribed fees, to have information furnished to him accordingly.

**45. Provisions as to exhibitions.**—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, or the reading of a paper by an inventor before a learned society or the publication of the paper in the society's transactions, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

- (a) the exhibitor, before exhibiting the invention, or the person reading such paper or permitting such publication, gives the Comptroller the prescribed notice of his intention to do so ; and
- (b) the application for a patent is made before or within six months from the date of the opening of the exhibition, or the reading or publication of such paper.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

[Compare Sec. 40 of the Indian Act.]

**46. Publication of journal, indexes, etc.—**(1) The Comptroller shall issue periodically a journal of patented inventions, as well as reports of patent cases decided by courts of law, reports of decisions of the Comptroller, of the law officer, or of the Appeal Tribunal, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

(3) The Comptroller shall continue, in such form as he deems expedient, the indexes and abridgements of specifications hitherto published, and shall prepare and publish such other indexes, abridgements of specifications, catalogues, and other works relating to inventions, as he thinks fit.

[There are no provisions in the Indian Act similar to those of this section. But see regarding the publications of the Indian Patent office page 65 above.]

**47. Patent Museum.—**(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

[Compare Sec. 41 of the Indian Act.]

**48. Special provisions as to vessels, aircraft and land vehicles.—**(1) Subject to the provisions of this section, the rights of a patentee shall not be deemed to be infringed—

- (a) by the use on board a foreign vessel of the patented invention in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, if the vessel comes into the territorial jurisdiction waters of the United Kingdom temporarily or accidentally only, and the invention is used exclusively for the actual needs of the vessel;

(b) by the use of the patented invention in the construction or working of a foreign aircraft or land vehicle or of the accessories thereof if the aircraft or vehicle comes into the United Kingdom temporarily or accidentally only.

(2) This section shall apply only to vessels, aircraft, and land vehicles of a foreign state with respect to which His Majesty by Order in Council declares that the laws thereof confer corresponding rights with respect to the use of inventions in vessels, aircraft and land vehicles of the United Kingdom when coming into the foreign state or the territorial waters thereof.

(3) For the purposes of this section—

Vessels and aircraft shall be deemed to be vessels and aircraft of the country in which they are registered, and land vehicles shall be deemed to be vehicles of the country within which the owners are ordinarily resident :

The Isle of Man shall be deemed to be part of the United Kingdom.

(4) His Majesty may by Order in Council apply this section to vessels, aircraft and land vehicles of a part of His Majesty's dominions outside the United Kingdom in the like manner as to vessels, aircraft and land vehicles of a foreign state.

[Compare Sec. 42 of the Indian Act.]

## PART II

### DESIGNS

*(N. B. Sections 49—61 comprising Part II, since they relate exclusively to Designs, have here been omitted.)*



## PART III

### GENERAL

#### **Patent Office, and Proceedings thereat.**

**62. Patent Office.**—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Acts, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent office being sent to or done at any branch office which may be established.

[Compare Sec. 55 of the Indian Act.]

**63. Officers and clerks.**—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

[Compare Sec. 56 of the Indian Act.]

**64. Seal of Patent Office.**—Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence,  
[Compare Sec. 55(3) of the Indian Act.]

**Fees.**

**65. Fees.**—There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

[Compare Sec. 57 of the Indian Act.]

**Provisions as to Registers and other Documents  
in Patent Office.**

**66. Trust not to be entered in registers.**—There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

[Compare Sec. 58 of the Indian Act.]

**67. Inspection of and extracts from registers.**—Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act, and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

[Compare Sec. 59 of the Indian Act.]

**68. Privilege of reports of examiners.**—Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed:

Provided that, on application being made by any person in the prescribed form, the comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent where either—

(a) the complete specification has been accepted; or

- (b) the complete specification has been published and the application has become void.

[Compare Sec. 60 of the Indian Act.]

**69. Prohibition of publication of specification, drawings, etc., where application abandoned, etc.—**(1) Where an application for a patent has been abandoned, or become void, the application, the specification and the drawings samples and specimens (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2) .....(*Relates only to Designs.*)

[Compare Sec. 61(1) of the Indian Act.]

**70. Power for comptroller to correct clerical errors.—**The comptroller may, on request in writing accompanied by the prescribed fee,—

- (a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification ;
- (b) cancel the registration of a design either wholly or in respect of any particular goods in connection with which the design is registered ;
- (c) correct any error in an application for the registration of or in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs :

Provided that where a request is made for a correction under paragraph (a) of this section and it appears to the comptroller that the correction would materially alter the meaning or scope of the document to which the request relates, and ought not to be made without notice to persons affected thereby, he shall require a notice of the nature of the proposed correction to be advertised in the prescribed manner, and any person may within the prescribed time and in the prescribed manner give notice at the Patent Office of opposition to the request and, where any such notice is given, the comptroller shall, after giving notice of the opposition to the applicant and after giving to the applicant and to the opponent an opportunity of being heard, decide on the case.

[Compare Sec. 62 of the Indian Act.]

**71. Registration of assignments, etc.** (1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent or to the copyright in a registered design, he shall make application to the comptroller in the prescribed manner to register his title, and the comptroller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design and shall cause an entry to be made on the register of the assignment, transmission or other instrument effecting the title.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, he shall make application to the comptroller in the prescribed manner to register his title, and the comptroller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest.

(3) The person registered as the proprietor of a patent or design shall subject to the provisions of the Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to or otherwise deal with the patent or design and to give effectual receipts for any consideration for any such assignment licence or dealing:

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

(4) Except in applications made under section seventy-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) aforesaid, shall not be admitted in evidence in any court in proof of the title to a patent or copyright in a design or to any interest therein unless the court otherwise directs.

[Compare Sec. 63 of the Indian Act.]

**72. Rectification of registers by court.**—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry to either such

register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

[Compare Sec. 64 of the Indian Act.]

### **Powers and Duties of Comptroller.**

**73. Exercise of discretionary power by comptroller.**—Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

[Compare Sec. 67 of the Indian Act.]

**73A. Costs and security for costs**—(1) The comptroller shall, in any proceedings before him under this Act, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of court.

(2) If any party giving notice of any opposition under this Act, or applying to the comptroller for the revocation of a patent or for the cancellation of the registration of a design or for the grant of a compulsory licence in relation to a patent or to a registered design or giving notice of appeal from any decision of the comptroller under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or in the case of appeal to the Appeal Tribunal or the court, the Appeal Tribunal or the court may require such party to give security for the costs of the proceedings or appeal, and in default of such security being given may proceed to treat the proceedings or appeal as abandoned.

[Compare Sec. 74A of the Indian Act.]

74.

.....(Repealed.)

75. **Refusal to grant patent, etc., in certain cases.**—If any application is made to the comptroller to grant a patent for an invention which is so obviously contrary to well-established natural laws that the application is frivolous or to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality the comptroller may refuse the application, or may, in the case of an invention any particular use of which would, in his opinion, be contrary to law, require as a condition of granting a patent the insertion in the specification of such disclaimer as respects that particular use of the invention or any such other reference to the illegality thereof as he thinks fit.

An appeal shall lie from the decision of the comptroller under this section to the Appeal Tribunal.

[Compare Sec. 69 of the Indian Act.]

76. **Annual reports of comptroller.**—The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates an account of all fees, salaries, and allowances, and other money received and paid under this Act.

[Compare Sec. 66 of the Indian Act.]

### **Evidence &c.**

77. **Evidence before comptroller.**—(1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) The comptroller shall in respect of discovery and production of documents and, where any evidence is taken *viva voce*, in respect of requiring the attendance of witnesses and taking evidence

on oath, be in the same position in all respects as an official referee of the Supreme Court.

[Compare Sec. 65 of the Indian Act.]

**78. Certificate of comptroller to be evidence.**—A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

[Compare Sec. 71 of the Indian Act.]

**79. Evidence of documents in Patent Office.**—Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

80. ....(Repealed.)

**81. Applications and notices by post.**—Any application, notice or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

[Sec. 73 of the Indian Act.]

**82. Excluded days.**—Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

**83. Declaration by infant, person of unsound mind, etc.**—(1) If any person is, by reason of infancy, unsoundness of mind, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

[Compare Sec. 74 of the Indian Act.]

**83A. Enforcement of order for grant of licence.**—Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee or proprietor of a registered design as the case may be and all other necessary parties.

### **Register of Patent Agents.**

**84. Registration of patent agents.**—(1) No person shall practice, describe himself, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—

- (a) in the case of an individual, he is registered as a patent agent in the register of patent agents ;
- (b) in the case of a firm, every partner of the firm is so registered ;
- (c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November, nineteenth hundred and seventeen, every director and the manager (if any) of the company is so registered :
- (d) in the case of a company which commenced to carry on business as a patent agent before that date, a manager or director of the company is so registered ;

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) If any person contravenes the provisions of this section, he shall be liable on conviction under the summary Jurisdiction Acts to a fine not exceeding twenty pounds or in the case of a second or subsequent conviction to a fine not exceeding fifty pounds, and in the case of a company every director, manager, secretary, or other



officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.

(3) Notwithstanding anything in any enactment prescribing the time within which proceedings may be brought before a court of summary jurisdiction, proceedings for an offence under this section may be commenced at any time within twelve months from the date on which the alleged offence was committed.

(4) For the purposes of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.

(5) Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.

(6) No person not registered before the fifteenth day of July, nineteen hundred and nineteen, shall be registered as a patent agent unless he be a British subject.

85. **Agents for patents.**—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or (during the term of his suspension) any person who has been suspended from acting as a patent agent, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in

respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

[There are no provisions in the Indian Act corresponding to these relating to a Register of Patent Agents. There is no Registration of Patent Agents in India. See pages 91—105 above.]

#### **Powers, etc. of Board of Trade.**

##### **86. Power for Board of Trade to make general rules.—**

(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

- (a) For regulating the practice of registration under this Act :
- (b) For classifying goods for the purposes of designs :
- (c) For making or requiring duplicates of specifications, drawings, and other documents :
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents :
- (f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (g) For regulating the keeping of the register of patent agents under this Act :
- (h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the Official Journal (Patents), and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

[Compare Sec. 77 of the Indian Act.]

**87. Proceedings of the Board of Trade.**—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

**88. Provision as to Order in Council.**—An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

### Offences.

**89. Offences.**—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to

any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent" "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

[Compare Sec. 78 of the Indian Act.]

90. **Unauthorised assumption of Royal Arms.**—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds :

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

**International and Colonial Arrangements.**

**91. International and Colonial arrangements.**—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state or his legal representative or assignee shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the foreign state.

**Provided that—**

- (a) The application is dated, in the case of a patent within twelve months, and in the case of a design or trade mark within six months, from the application for protection in the foreign state ; and
- (b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) Where the same applicant has made two or more applications for protection of inventions in any foreign state to which the provisions of this section apply, and the comptroller is of opinion that the whole of the inventions in respect of which the applications were made are such as to constitute a single invention and may properly be included in one patent, he may, if a separate application dated within twelve months from the date of the earliest of the foreign applications is made in respect of each of the foreign applications, accept one complete specification in respect of the whole of those inventions and grant a single patent thereon. The patent shall bear the date of the earliest of the foreign applications, but in considering the validity thereof and in determining other questions under this Act, the court or the comptroller, as the case may be, shall have regard to the respective dates of the foreign applications relating to the several matters claimed in the specification.

(3) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

- (a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention ; or
- (b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or
- (c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(4) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905 : Provided that—

- (a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within eighteen months from the application for protection in the foreign state, or in the case of applications made in accordance with the provisions of subsection (2) of this section from the earliest of the applications for protection in the foreign state, shall with the drawings, samples and specimens (if any) be open to public inspection at the expiration of that period ; and
- (b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(5) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(6) Where it is made to appear to His Majesty that the legislature of any part of His Majesty's dominions outside the

United Kingdom has made satisfactory provision for the protection of inventions, designs, or trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that part of His Majesty's dominions, with such variations or additions, if any, as may be stated in the Order.

[Compare the reciprocal arrangements contained in Sec. 78 of the Indian Act. There are no international arrangements under the Indian Act for reciprocity between India and foreign states. See pages 352-365 above.]

### Definitions

92. **Provisions as to "the court".**—(1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Northern Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, except in the case of a petition for the revocation of a patent under section twenty-five of this Act, and subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose. An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent.

92A. **Tribunal for appeals from the Comptroller.**—(1) For the purpose of hearing appeals from decisions of the Comptroller, which, by virtue of this Act, are subject to an appeal to the Appeal Tribunal, there shall be constituted a tribunal (in this Act referred to as the "Appeal Tribunal") to consist of a judge of the High Court to be nominated by the Lord Chancellor.

(2) The expenses of the Appeal Tribunal shall be defrayed and the fees to be taken therein may be fixed as if the Tribunal were a court of the High Court, but subject as aforesaid appeals to the Tribunal shall not be deemed to be proceedings in the High Court.

(3) The Appeal Tribunal may—

- (a) examine witnesses on oath and administer oaths for that purpose ;
- (b) make rules regulating appeals to the Tribunal and the practice and proceedings before the Tribunal under this Act ; and
- (c) in any proceedings under this Act by order award to any party such costs as the Tribunal consider reasonable and direct how and by what parties they are to be paid and any such order may be made a rule of court ;

so however that, as respects rights of audience and the awarding of costs, the like practice shall be observed as, before the commencement of the Patents and Designs Act, 1932, was observed in the hearing of appeals by the law officer.

(4) The Appeal Tribunal may, if it thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the Tribunal, with the consent of the Treasury, may determine.

**93. Definitions.**—In this Act, unless the context otherwise requires,—

“Prescribed” means proscribed by general rules under this Act :

“His Majesty’s dominions outside the United Kingdom” includes any territory under His Majesty’s protection or in respect of which a mandate on behalf of the League of Nations is being exercised by His Majesty, but does not include the Isle of Man or the Channel Islands :

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entered on the register as the grantee or proprietor of the patent :

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies, and includes an alleged invention :

“Inventor” and “applicant” shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :



**"Design"** means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye ; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical device :

**"Article"** means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial any partly natural :

**"Copyright"** means the exclusive right to apply a design to any article in any class in which the design is registered :

**"Proprietor of a new or original design"**—

- (a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed ; and
- (b) Where any person acquires the design or the right to apply the design to any article either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and
- (c) In any other case, means the author of the design ; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person :

**"Working on a commercial scale"** means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable under all the circumstances.

**"The Comptroller"** means the Comptroller General of Patents, Designs and Trade Marks.

**"Date of application"** has the meaning assigned to it in section four of this Act.

**"Patent of addition"** means a patent granted under the provisions of section nineteen of this Act.

**"The Appeal Tribunal"** means the tribunal constituted under the provisions of section 92A of this Act.

**"The Statute of Monopolies"** means the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof".

[Compare Sec. 2 of the Indian Act for the definitions under the Indian Act.]

**Application to Scotland, Northern Ireland, and  
the Isle of Man.**

**94. Application to Scotland.**—In the application of this Act to Scotland—

- (1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:
- (2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:
- (3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made accord-

ing to the forms and practice existing at the commencement of this Act :

- (4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs ; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court :
- (5) Notwithstanding anything in this Act, the expression "the Court" shall in reference to proceedings in Scotland for the extension of the term of a patent mean any Lord Ordinary of the Court of Session :
- (6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt :
- (7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly :
- (8) The expression "injunction" means "interdict."

**95. Application to Northern Ireland.**—In the application of this Act to Northern Ireland—

- (1) All parties shall, notwithstanding anything in this Act, have in Northern Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Northern Ireland only :
- (2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Northern Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term "the court" means the High Court in Northern Ireland :

- (3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

96. **Isle of Man.**—This Act shall extend to the Isle of Man, subject to the following modifications :—

- (1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts :
- (2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court :
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

#### **Repeal, Savings, and Short Title.**

97. **Saving for Prerogative.**—Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

[Sec. 79 of the Indian Act.]

98. **Repeal and Savings.**—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

- (a) As respects the enactments mentioned in Part I of that schedule, as from the commencement of this Act ;
- (b) As respects the enactments mentioned in Part II of that schedule, as from the date when rules of the Supreme

**Court regulating the matters dealt with in those enactments come into operation ;**

- (c) **As respects the enactments mentioned in Part III of that schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;**

**and the enactments mentioned in Part II and Part III of that schedule shall, until so repealed, have effect as if they formed part of this Act :**

**Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed. but any such convention, Order in Council, rule or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered, or amended, as if it had been made under this Act.**

(2) **Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.**

**99. Short title and commencement.**—This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January, one thousand nine hundred and eight.

**[Compare Sec. 1 of the Indian Act.]**

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## SCHEDULES

Sect. 65.

## FIRST SCHEDULE

Fees on Instruments for Obtaining Patents and Renewal.

(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection ...	1	0	0			
On filing complete specification ...	4	0	0			
				5	0	0

or

On filing complete specification with first application ...	5	0	0
On the sealing of the patent in respect of investigation as to anticipation. ...	1	0	0

(b) *Further before end of four years from date of patent*

On certificate of renewal ...	50	0	0
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(c) *Further before end of eight years from date of patent*

On certificate of renewal ...	100	0	0
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*Or in lieu of the fees of £50 and £100 the following annual fees :*

Before the expiration of the—	£	s.	d.
fourth year from the date of the patent ...	10	0	0
fifth " " " " ...	10	0	0
sixth " " " " ...	10	0	0
seventh " " " " ...	10	0	0
eighth " " " " ...	15	0	0
ninth " " " " ...	15	0	0
tenth " " " " ...	20	0	0
eleventh " " " " ...	20	0	0
twelfth " " " " ...	20	0	0
thirteenth " " " " ...	20	0	0

## SECOND SCHEDULE

## Enactment Repealed

## PART I.

Sec. 98

Session and Chapter	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6) and (7) of section, 26, section twenty-nine, subsections (2) and (3) of section forty-seven and section forty-eight.
48 & 49 Vict. c. 63	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37	The Patents Act, 1886.	The whole Act.
51 & 52 Vict. c. 50	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7, c. 18	The Patents Act, 1901.	The whole Act.
2 Edw. 7, c. 34	The Patents Act, 1902.	The whole Act.
7 Edw. 7, c. 28	The Patents & Designs (Amendment) Act, 1907.	The whole Act.
8 Edw. 7, c. 4	The Patents, & Designs Act, 1908.	The whole Act.

## PART II.

46 & 47 Vict. c. 57	The Patents, Designs Trade Marks Act, 1883.	Subsection (5), (6) and (7) of section twenty-six and section twenty-nine.
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## PART III.

46 & 47 Vict. c. 57	The Patents, Designs, and Trade Marks Act, 1883.	Subsection (2) and (3) of section forty-seven and section forty-eight.
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## NOTE

**A Note concerning the English Statutes which preceded the current English Act of 1932.**

The following are the References to certain English Patent Statutes (operative only in the United Kingdom), which have preceded and contributed to the English Patents and Designs Acts 1907-1932.

1. *The Statute of Monopolies of 1623 : 21 Jac. 1. c. 3.*

(See Appendix No. 1.)

2. *The Patents and Designs Act, 1907 : 7 Edw. 7 c. 29 ("An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks".) (28th August 1907.)*

3. *The Patents and Designs Act, 1914 : 4 & 5 Geo. 5. c. 18 ("An Act to amend section ninety-one of the Patents and Designs Act, 1907".) (7th August 1914.)*

(Note : This was for the sole purpose of inserting the words "or his legal representative or assignee" in the said Section 91 : in view of the Convention held in Washington in 1911.)

4. *The Patents and Designs Act, 1919 : 9 & 10 Geo. 5 c. 80. ("An Act to amend the Patents & Designs Acts") (23rd December 1919.)*

5. *The Patents and Designs (Convention) Act, 1928 : 18 Geo. 5. c. 3. ("An Act to make such amendments of the Patents and Designs Acts 1907 and 1919 as are necessary to enable effect to be given to a Convention for the Protection of Industrial Property.") (28th March 1928).*

6. *The Patents and Designs Act 1933 : 22 & 23 Geo. 5. c. 32 ("An Act to amend the Patents and Designs Acts 1907 to 1928") (12th July 1932).*

The dominant Statute of Monopolies above referred to has co-existed side by side with all subsequent Patent legislation in the United Kingdom.



The effect of the remaining five statutes above-mentioned has been embodied in the form of a consolidated act which (as expressly authorised under Section 15 of the Patents and Designs Act, 1932) may be conveniently referred to as the English Patents and Designs Acts 1907-1932. The resultant text of this Act in this consolidated form has been set out above from page 853. It is this consolidated Act which (together with the Statute of Monopolies itself) contains the current English statutory law regarding Patents.

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## **REGISTER OF PATENT AGENTS RULES, 1932.**

Dated October 4, 1932.

(S. R. & O. 1932, No. 820.)

By virtue of the provisions of the Patents and Designs Acts, 1907 to 1932, the Board of Trade do hereby make the following Rules:—

1. These Rules may be cited as the Register of Patent Agents Rules, 1932, and shall come into force on the 1st day of November, 1932.

2. **Interpretation.**—(1) In these Rules unless the context otherwise requires, the expression—

“the Acts” means the Patents and Designs Acts, 1907 to 1932;

“the Board” means the Board of Trade;

“the Institute” means the Chartered Institute of Patent Agents;

“the Register” means the Register of Patent Agents kept under the Acts and these Rules.

(2) The Interpretation Act, 1889, shall apply to the interpretation of these Rules as it applies to the interpretation of an Act of Parliament.

3. **Register.**—The register shall be kept by the Institute, subject to the provisions of these Rules and shall contain in one list all patent agents who are registered under the Acts and these Rules.

Such list shall be made out according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his business address, the date of registration, his qualification for registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the Council of the Institute may consider worthy of mention in the register. The register shall be in the form given in Appendix A, with such variations as may be required.

4. **Printed copies to be published annually, and to be evidence of contents of register.**—The Institute shall cause a correct copy of the register, but with the names arranged alphabetically, to be printed under their direction and published and placed on sale. Such correct copy shall be printed and published not later than the end of the first week of March in each year. A copy of the register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Acts or any Act repealed by the Acts.

5. **Registrar.**—The Council of the Institute shall continue in office or appoint a Registrar, hereinafter referred to as the Registrar, who shall keep the register in accordance with the provisions of the Acts and these Rules, and, subject thereto, shall act under the directions of the Council of the Institute, or the Board.

6. **Final qualifying examination for registration.**—No person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as the Institute shall from time to time prescribe.

7. **Intermediate and final qualifying examinations to be held by the Institute.**—The Institute shall hold at least once in every year an intermediate examination and a final qualifying examination, and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say,

(a) the subjects for and the mode of conducting the examination of candidates;

- (b) the times and places of the examinations, and the notices to be given of such examinations;
- (c) the certificates, if any, to be given to persons of their having passed the examinations;
- (d) the appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and
- (e) any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

**8. Qualifications of persons for intermediate examination.**—Any person must, in order to be entitled to present himself for the intermediate examination, be:

A British subject who has passed one of the preliminary examinations which the Institute shall by regulation prescribe and has been engaged for three years as a pupil or technical assistant to one or more patent agents practising in the United Kingdom; provided that (a) the Institute may by regulation prescribe conditions under which such term of three years may be reduced or dispensed with, and (b) any British subject for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Northern Ireland or as a Law Agent before the Court of Session in Scotland shall be entitled to present himself for the intermediate examination without passing any of the preliminary examinations referred to above and without having been engaged as a pupil or technical assistant to a registered patent agent.

**9. Qualifications of persons for final examination.**—Any person must, in order to be entitled to present himself for the final qualifying examination, be:

A British subject who has passed the intermediate examination prescribed by Rule 7 and has been engaged for five years as a pupil or technical assistant to one or more patent agents practising in the United Kingdom; provided that (a) the Institute may by regulation prescribe conditions under which such term of five years may be reduced, and (b) any British subject for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Northern Ireland, or as a Law Agent before the Court of Session in Scotland, shall be entitled to present himself for the final qualifying examination if he have passed the intermediate examination referred to in Rule 8.

**10. Corrections of names and addresses in register.**—The Registrar shall from time to time insert in the register any alteration which may come to his knowledge in the name and address of any person registered.

**11. Erasure of names of deceased persons.**—The Registrar shall erase from the register the name of any registered person who is dead.

**12. Erasure of names of persons who have ceased to practise.**—The Registrar may erase from the register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not, within three months after sending the notice, receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar, before the second notice is sent, receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice, receive any answer thereto from the said person, that person shall, for the purpose of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly: provided that the name of a person erased from the register under this Rule may be restored to the register by direction of the Institute if the Institute is of opinion that for any cause it is just so to direct.

**13. Erasure of names for non-payment of fees.**—If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered person shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the register: provided that the name of a person erased from the register under this Rule may be restored to the register by direction of the Institute on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute may in each particular case direct.

**14. Registrar to act on evidence.**—In the execution of his duties the Registrar shall in each case act on such evidence as appears to him sufficient.

**15. Erasure of incorrect or fraudulent entries.**—The Board may order the Registrar to erase from the register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

**16. Erasure of names of persons convicted of crimes, and persons found guilty of conduct discreditable to a patent agent.**—If any registered person shall be convicted in His Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanour, or after due inquiry, is proved to the satisfaction of the Board to have been guilty of conduct discreditable to a patent agent, or having been entitled to practise as a Solicitor or Law Agent shall have ceased to be so entitled, the Board may suspend such person from acting as agent in respect of any business under the Acts for such time as to the Board may seem fit or may order the Registrar to erase from the register the name of such person: provided that no person shall be adjudged by the Board to have been guilty of conduct discreditable to a patent agent unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

**17. Restoration by Board of erased name.**—Where the Board direct the erasure from the register of the name of any person, or of any other matter, the name of the person or the matter shall not be again entered in the register, except by order of the Board.

The Board may in any case in which they think fit order the restoration to the register of such name or matter erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board may from time to time fix, and the Registrar shall restore the name or matter accordingly.

**18. Inquiry by Board of Trade before erasure of name from register.**—For the purpose of exercising in any case their powers of erasing from and of restoring to the register the name of a person, or any matter, the Board shall appoint a committee consisting of such persons as they shall think fit. Every application to the Board for the erasure from, or restoration to, the register of the name of any person or any other matter shall be accompanied by a fully detailed and documented statement in support and shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board, and the report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board.

The Registrar shall in all cases be entitled to be heard by the committee who may also require the attendance before them of the complainant or the party making the application.

It shall be the duty of the Institute to present all the relevant facts to the committee unless the Board otherwise direct.

**19. Restoration by Institute of erased name.**—The name of any person erased from the register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board, be restored to the register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

**20. Appeal to Board of Trade.**—Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board.

**21. Notice of appeal.**—A person who intends to appeal to the Board under these Rules (in these Rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

**22. Case on appeal.**—The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

**23. Transmission of notice of appeal to Board of Trade.**—The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the Comptroller, Industrial Property Department, Board of Trade, 25, Southampton Buildings, London, W.C. 2.

**24. Directions as to hearing appeal.**—The Board may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

**25. Notice of hearing of appeal.**—Seven days' notice, or such shorter notice as the Board may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute or the Registrar as the case may be.

**26. Hearing and decision of appeal.**—The appeal may be heard and decided by the Board, and such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

**27. Fees.**—The fees set forth in Appendix B to these Rules shall be paid in respect of the several matters, and at the times and in the matter therein mentioned.

**28. Alteration of regulations.**—Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board, and if, at any time, the Board by an order signify their disapproval thereof, such regulation shall cease to be of any force or effect.

**29. Report to Board of Trade.**—The Institute shall once every year in the month of March transmit to the Board a report stating the number of applications for registration which have been made in the preceding twelve months, the nature and results of the examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules as the Board may from time to time require.

**30. Repeal.**—The Register of Patent Agents Rules, 1920, are hereby repealed without prejudice to anything done under such Rules or to any application or other matter pending thereunder at the date of the coming into force of these Rules.

WALTER RUNCIMAN,  
President of the Board of Trade.

Dated the 4th day of October, 1932.

[There is no Register of Patent Agents in India. Accordingly there are in India no Rules corresponding to the above.]

**APPENDIX A.****Form of Register.****APPENDIX B.****FEEs.**

Nature of Fee.	When to be paid.	To whom to be paid.	Amount.
For registration of name of patent agent.	On application and before registration.	To the Registrar at the Institute.	£ s. d. 5 5 0
Annual fee to be paid by every registered person.	On or before November 30th of each year in respect of the year commencing January 1st following.	Do. do.	3 3 0
On entry of a candidate for the intermediate examination.	At time of entering name.	Do. do.	2 2 0
On entry of a candidate for the final qualifying examination.	Do. do.	Do. do.	3 3 0

Dated the 4th day of October, 1932.

WALTER RUNCIMAN,  
President of the Board of Trade.

**PATENTS RULES, 1932.**

Dated October 25, 1932.

(S. R. &amp; O. 1932, No. 873.)

By virtue of the provisions of the Patents and Designs Acts, 1907 to 1932, the Board of Trade do hereby make the following Rules:—

**SHORT TITLE AND COMMENCEMENT.**

1. **Short title and commencement.**—These Rules may be cited as the Patents Rules, 1932, and shall come into force on the 1st day of November, 1932.

[Compare Rule 1 of the Indian Patents and Designs Rules, 1933: see Appendix V below.]

**INTERPRETATION.**

2. **Interpretation.**—(1) In these Rules unless the context otherwise requires:—

“the Acts” means the Patents and Designs Acts, 1907 to 1932;

“the Board” means the Board of Trade;

“United Kingdom” includes the Isle of Man;

“Foreign Application” means an application by any person for protection of his invention in a Foreign State or any part of His Majesty’s dominions outside the United Kingdom to which by any Order in Council for the time being in force the provisions of Section 91 of the Acts are applicable;

“Convention Application” means an application in the United Kingdom under Section 91 of the Acts;

“Office” means the Patent Office;

“Journal” means the Official Journal (Patents).

(2) The Interpretation Act, 1889, shall apply to the interpretation of these Rules as it applies to the interpretation of an Act of Parliament.

[Compare Rule 2 of the Indian Patents and Designs Rules, 1933.]

**FEES.**

3. **First Schedule.**—The fees to be paid in relation to Patents shall be those prescribed in the First Schedule to these Rules.

**FORMS.**

4. **Second and Third Schedules.**—The forms herein referred to are those contained in the Second and Third Schedules to these Rules and such forms shall be used in all cases to which they are applicable, and may be modified as directed by the Comptroller to meet other cases.

[Compare Rule 6 of the Indian Patents and Designs Rules, 1933.]

**DOCUMENTS.**

5. **Size, etc., of documents.**—All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board shall be written, type-written, lithographed or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent black ink upon strong wide-ruled white paper, and except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall be left at the Office, if required by the Comptroller. Such duplicates may be carbon copies of the original documents provided they are on paper of good quality and the typing is black and distinct.

At the top of the first page of a specification a space of about two inches should be left blank.

[Compare Rule 7 of the Indian Patents and Designs Rules, 1933.]

**6. Leaving and serving documents.**—Any application, notice, or other document authorized or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Acts or these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Any written communication addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Acts or these Rules, at the address appearing on the application or notice of opposition or given for service as hereinafter provided shall be deemed to be properly addressed.

[Compare Rule 3 of the Indian Patents and Designs Rules, 1933.]

**7. Address for service.**—Every applicant or opponent in any proceedings to which these Rules relate, and every person who is or shall hereafter become a patentee, shall furnish to the Comptroller an address for service in the United Kingdom. Such address may be treated, for all purposes connected with such proceedings or patent as the actual address of such applicant, opponent or patentee.

If any patentee desires to have two addresses for service entered in the register a request therefor shall be made on Patents Form No. 31 in respect of each patent.

[Compare Rule 4 of the Indian Patents and Designs Rules, 1933.]

### AGENCY.

**8. Agency.**—With the exception of the signing of the following documents, namely, applications for patents, for a complete specification to be treated as a provisional specification, for postdating of applications, for the revocation of patents, for the grant of a licence under a patent, for the indorsement of a patent "licences of right," for the refusal of a request for the indorsement of a patent "licences of right," for the cancellation of such indorsement, for the restoration of lapsed patents, requests for leave to amend applications or specifications, authorizations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all communications to the Comptroller under the Acts and these Rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorized to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Acts from, any person whose name, by reason of his having been adjudged guilty of conduct discreditable to a patent agent, has been erased from the register of patent agents kept under the provisions of the Acts and not since restored, or (during the term of his suspension) any person who has been suspended from acting as a patent agent.

[Compare Rules 8 and 9 of the Indian Patents and Designs Rules, 1933.]

### APPLICATIONS FOR THE GRANT OF PATENTS.

**9. Form of application.**—An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patents Forms, Nos. 1, 1A, 1B or 1B\* as the case may be. An application for a Patent of Addition shall be made on Patents Forms Nos. 1C, 1C\*, 1C\*\*, 1C\*† or 1C\*\*\*, and an application for a Secret Patent on Patents Form No. 1D. An application for the grant of a Patent of Addition in lieu of an independent patent shall be made on Patents Form No. 13B.

[Compare Rule 10 of the Indian Patents and Designs Rules, 1933.]



**10. Application by representative of deceased inventor.**—In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of the will, or the letters of administration granted of the estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title to be regarded as legal representative and be supported by such further evidence as the Comptroller may require.

[Compare Rule 10 of the Indian Patents and Designs Rules, 1933.]

**11. Order of recording applications.**—Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same are delivered in the ordinary course of post.

Applications left at the Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

[Compare Rule 12 of the Indian Patents and Designs Rules, 1933.]

**12. One invention.**—(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

**Applications for separate patents by way of amendment.**—Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Every such lastmentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Acts and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings or any of them to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connexion with his applications into such number of complete specifications as may be necessary to enable the applications to be proceeded with as two or more separate applications for patents for different inventions.

[Compare Rule 10 of the Indian Patents and Designs Rules, 1933.]

**13. Claims.**—The statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specifications.

[Compare Rule 10 of the Indian Patents and Designs Rules, 1933.]

#### **APPLICATIONS UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.**

**14. Convention applications.**—Every Convention application shall contain a declaration that a foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the Foreign States or parts of His Majesty's dominions outside the United Kingdom in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the filing of the first foreign application, and must be accompanied by a complete specification, and signed by the person by whom such first foreign application was made or by his legal representative or assignee.

**15. Foreign specification, etc., to accompany application.**—In addition to the specification left with every Convention application a copy or copies of the specification or specifications and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or part of His Majesty's dominions outside the United Kingdom in respect of the foreign application or applications, duly certified by the official chief or head of the Patent Office of such Foreign State or part of His Majesty's dominions outside the United Kingdom as aforesaid, or otherwise verified to the satisfaction of the Comptroller, must be left at the Office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, translations, drawings or documents shall be made on Patents Form No. 5.

**16. Division of Convention applications.**—Where the same applicant has filed one complete specification in respect of the whole of the inventions in respect of which two or more Convention applications have been made and the Comptroller is of opinion that the whole of those inventions does not constitute a single invention, the applicant may divide the complete specification into such number of complete specifications as may be necessary to enable the applications to be proceeded with as two or more separate Convention applications.

**17. Proceedings.**—Save as provided by Rule 94 all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by these Rules.

[Regarding Rules 14-17 above, compare Rule 11 of the Indian Patents and Designs Rules, 1933.]

## DRAWINGS.

**18. General.**—Drawings, when furnished, must accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 25. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed may appear in the specification itself.

**19. Requirements as to paper, etc.**—Drawings must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness, without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings may not be used.

**20. Size of drawings and arrangement of figures.**—Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to 8½ inches or from 16 inches to 16½ inches wide, the narrower sheets being preferable. A clear margin must be left half an inch from the edges of the sheet.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets. They should be separated by a sufficient space to keep them distinct.

**21. Drawings to be suitable for reproduction.**—Drawings must be prepared in accordance with the following requirements:—

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines must be as few as possible, and must not be closely drawn.
- (d) Shading lines must not contrast too much in thickness with the general lines of the drawing.

- (e) Sections and shading must not be represented by solid black or washes.
- (f) They must be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, etc., may appear as affects this purpose. If the scale is given, it must be drawn, and not denoted by words. No dimensions may be marked on the drawings.
- (g) The figure must be drawn in an upright position in regard to the top and bottom of the sheet.
- (h) Reference letters and numerals, and index letters and numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters or numerals must be used in different views of the same parts. Where the reference letters or numerals are shown outside the figure, they must be connected with the parts referred to by fine lines.

**22. Drawings to bear name of applicant, etc., but no descriptive matter.—**

Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after one or more provisional specifications or Convention applications, the numbers and years of the application) in the left-hand top corner; the number of sheets of drawings sent and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter shall appear on the drawings.

**23. Copies of drawings.**—A facsimile or "true copy" of the original drawings shall be filed at the same time as the original drawings, prepared strictly in accordance with these Rules, except that the reference letters or numerals and leading lines thereto should be in black-lead pencil. In the case of a hand-made drawing this copy may be on tracing cloth. Where drawings are filed in connexion with a Convention application a second "true copy" of the original drawings must be filed.

**Marking of originals and true copies.**—The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

**24. Condition of drawings on delivery.**—Drawings must be delivered at the Office free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

**25. Provisional drawings used for complete specification.**—If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for his complete specification, he shall refer to them in the complete specification as those left with the provisional specification.

[Regarding Rules 18-25 above, compare Rules 15-18 of the Indian Patents and Designs Rules, 1933.]

**EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.**

**26. Extension of time for leaving complete specification.**—An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

**REQUEST FOR POSTDATING AN APPLICATION.**

**27. Request for postdating an application.**—Where a person making application for a patent desires in pursuance of the provisions of sub-section (4) of Section 3 of the Acts before the acceptance of the complete specification that his application should be deemed to have been made on a date within a period of six months running from the date when the application was actually made, he shall make application on Patents Form No. 4.

**PROCEDURE UNDER SECTION 7 OF THE ACTS.**

**28. Provisional report in case of complete anticipation.**—When the Examiner in prosecution of the investigation prescribed by sub-section (1) of Section 7 of the Acts finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications referred to in the sub-section, he shall, without any further prosecution of the investigation, make a provisional report to that effect,

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-section (4) of the said Section. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made, and the specification shall be dealt with as provided in sub-section (3) or sub-section (4) of the said Section, as the case may require.

**29. Time for leaving amended specification.**—The time within which an applicant may leave his amended specification under sub-section (2) of Section 7 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of sub-section (1) of the said Section.

Application for an extension of time for leaving the amended specification shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

**30. Hearing by the Comptroller under sub-section (4).**—When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-section (1) of Section 7, and the time allowed for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification referred to in that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what prior specification or specifications by way of notice to the public, and in the event of the invention claimed being wholly and specifically claimed or wholly and specifically described in any specification to which the investigation has extended, whether he should refuse to grant a patent, and shall inform the applicant accordingly. As an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the references will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 29.

**31. Reference to prior specification.**—When under sub-section (4) of Section 7 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—

Reference has been directed in pursuance of Section 7, sub-section (4) of the Patents and Designs Acts, 1907 to 1932, to specification No. \_\_\_\_\_ of 1 \_\_\_\_\_.

Where the reference is inserted as the result of a provisional report under Rule 28, a statement to that effect shall be added to the reference.

**32.** The procedure to be followed when anticipating documents within sub-section (5) of Section 7 are brought to the notice of the Comptroller shall be that set out in Rules 28 to 31 with the necessary modifications.

#### PROCEDURE UNDER SECTION 8 OF THE ACTS.

**33. Procedure under Section 8.**—Where on the additional investigation provided for by Section 8 of the Acts it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply

for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

Application for an extension of time for making such an application shall be made on Patents Form No. 7, but no such extension of time shall be granted which would extend beyond the date prescribed by the Acts for the acceptance of the specification, and any fees payable under these Rules for the extension of time for acceptance of a specification shall be paid in addition to the fees for an extension of time under this Rule.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

**34. Hearing by Comptroller.**—If, at the expiration of the said two months, or such extended time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and if so, what prior specification or specifications by way of notice to the public and shall inform the applicant accordingly. As an alternative to the insertion of a reference to a prior specification, the Comptroller may prescribe or permit such amendments of the specification as will be to his satisfaction and, in such case, the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the amendments or to the insertion of a reference. If no communication is received within the prescribed time or such further time as may be allowed, the reference will be inserted. Application for an extension of the time fixed by the Comptroller under this Rule shall be made in the manner prescribed in Rule 29.

**35. Reference to prior specification.**—When, under sub-section (2) the Comptroller determines that reference to a prior specification ought to be made, by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—

“Reference has been directed, in pursuance of Section 8, sub-section (2), of the Patents and Designs Acts, 1907 to 1932, to specification No.        of 1.”

**36. Advertisement of amendments.**—When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the Journal.

### DISCLOSURE OF RESULT OF SEARCH.

**37. Disclosure of result of search.**—Application under Section 68 of the Acts for disclosure of the result of a search made under Sections 7 and 8 of the Acts shall be made on Patents Form No. 9.

### CHEMICAL INVENTIONS.—TYPICAL SAMPLES AND SPECIMENS.

**38. Chemical inventions.—Typical samples and specimens.**—Where under Section 2, sub-section (5), of the Acts, before the acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require or allow typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

A schedule specifying the nature of such samples or specimens may be inserted in the complete specification or appended thereto.

The fact that such samples or specimens have been furnished shall also be notified to the public by a statement to that effect at the head of the complete specification and in connexion with the advertisement of acceptance of such specification in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding three inches, and of an external diameter of  $1\frac{1}{2}$  inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are supplied, they must unless otherwise directed by the Comptroller be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such lastmentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

#### ACCEPTANCE OF SPECIFICATIONS.

**39. Extension of time for accepting complete specification.**—An application for extension of time for accepting a complete specification shall be made on Patents Form No. 8.

**40. Notice and advertisement of acceptance.**—On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the Journal.

[Compare Rule 19 of the Indian Patents and Designs Rules, 1933.]

**41. Inspection of specification, etc.**—After such acceptance in the case of a complete specification the application and specification or specifications with the drawings, foreign documents (if any) and samples or specimens (if any) may be inspected at the Office upon payment of the fee prescribed by these Rules.

#### OPPOSITION TO GRANT OF PATENT.

**42. Extension of period for leaving notice of opposition.**—An application made under sub-section (1) of Section 11 for an extension of the period within which a notice of opposition may be filed shall be made upon Patents Form No. 10A, and shall state the ground or grounds on which the application for an extension of the said period is based.

**43. Notice of opposition.—Copy to applicant.**—A notice of opposition to the grant of a patent shall be given on Patents Form No. 10, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

**44. Counter-statement.**—If the applicant is desirous of contesting the opposition, he shall within fourteen days of the receipt of such copies, or such further time as the Comptroller may allow, leave at the Office a counter-statement fully setting out the grounds upon which the opposition is contested and deliver to the opponent a copy thereof.

[Regarding Rules 43 and 44 above, compare Rule 21 of the Indian Patents and Designs Rules, 1933.]

**45. Opponent's evidence.**—The opponent may within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence by way of statutory declaration in support of his case and, on so leaving, shall deliver to the applicant a copy thereof.

**46. Applicant's evidence.—Evidence in reply.**—Within fourteen days from the delivery of such evidence to the applicant, or if the opponent does not leave any evidence, within fourteen days from the expiration of the time within which the opponent's evidence might have been filed, or within such further time as the Comptroller may in either case allow, the applicant may leave at the Office evidence by way of statutory declarations in support of his case, and on so leaving, shall deliver to the opponent a copy thereof; and within fourteen days from such delivery or within such further time as the Comptroller may allow, the opponent may leave at the Office statutory declarations in reply and, on so leaving, shall deliver to the applicant a copy thereof. Such lastmentioned declarations shall be confined to matters strictly in reply.

**47. Closing of evidence.**—No further evidence shall be delivered by either party except by leave, or on requisition, of the Comptroller.

**48. Translations of documents in foreign languages.**—Where a document in a foreign language is referred to in any statement or declaration filed in connection with an opposition, an attested translation in duplicate shall be furnished.

**49. Hearing.**—On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard he shall forthwith notify the Comptroller to that effect. If either party desires to be heard he must notify the Comptroller on Patents Form No. 11. The Comptroller may refuse to hear either party who has not left Patents Form No. 11 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification or publication already mentioned in the proceedings, he shall give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Comptroller shall decide the case and notify his decision to the parties.

[Compare Rule 22 of the Indian Patents and Designs Rules, 1933.]

**50. Costs in uncontested cases.**—In the event of an opposition being uncontested by the applicant, the Comptroller in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the opposition was filed.

### SEALING OF PATENT AND PAYMENT OF FEE.

**51. Payment of sealing fee.**—If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by Section 12 of the Acts pay the sealing fee by leaving at the Office Patents Form No. 12, and paying thereon the prescribed fee.

**52. Extension of time of sealing.**—Where for any reason a patent cannot be sealed within the period allowed by sub-section (4) (a), (b) or (c) of Section 12 of the Acts, the applicant may apply to the Comptroller on Patents Form No. 13 for an extension of such period not exceeding three months.

**53. Further extension for prosecuting applications abroad.**—Where the maximum extension of time for sealing a patent has been allowed under sub-section 4 (e) of Section 12 and a further extension of time for sealing is required under sub-section 4 (d) of that Section, application for such further extension shall be made on Patents Form No. 13A. Such application shall be made before the expiration of the extended period allowed under sub-section 4 (e).

[Regarding Rules 51-53 above, compare Rule 23 of the Indian Patents and Designs Rules, 1933.]

**54. Grant of patent to assignee.**—An application for the grant of a patent to an assignee or to a joint applicant and assignee shall be made on Patents Form No. 1E, and shall be accompanied by an attested copy of the agreement to assign. The original agreement shall also be produced for the Comptroller's inspection. The Comptroller may call for such other proof of title or written consent as he may require.

**FORM OF PATENT.**

**55. Form of patent.**—A patent, except in the cases provided for in Rules 56 and 57, may be in the Form A, in the Third Schedule to these Rules.

**56. Form of patent of addition.**—A patent of addition may be in the Form B, in the Third Schedule to these Rules.

**57. Form of patent to legal representatives of deceased inventor and others.**—Where a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to shew clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

[Regarding Rules 55-57 above, compare Rule 24 of the Indian Patents and Designs Rules, 1933.]

**RENEWAL FEES.**

**58. Renewal fees.**—If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by lodging at the Office Patents Form No. 14 and paying thereon the prescribed fee. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 15.

**59. Certificate of payment of fee.**—On due compliance with the terms of Rule 58, the Comptroller shall issue a Certificate that the prescribed fee has been duly paid.

**60. Notice as to renewal fees.**—At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the register of patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

**RESTORATION OF LAPSED PATENTS.**

**61. Restoration of lapsed patents.**—Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time the patentee may apply to the Comptroller on Patents Form No. 16 for an order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable.

**62. Opposition.**—At any time within two months from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 17. Such notice shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

**63. Further procedure.**—Upon such notice of opposition being given and a copy thereof transmitted to the applicant the provisions of Rules 44 to 50 shall apply to the case.

**64. Hearing.**—If no opposition to the application is entered the Comptroller shall at the expiration of the opposition period appoint a time for hearing the applicant and, if satisfied with the evidence adduced, issue an Order restoring the patent.



[Regarding Rules 61-64 above, compare Rules 26 and 27 of the Indian Patents and Designs Rules, 1933.]

**65. Order.**—In every Order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage:—

- (1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the Order.
- (2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the Order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was *bona fide* manufactured or made, or such mechanism, machine, machinery, process or operation was *bona fide* made or carried on, his or their executors, administrators, successors, or vendees or his or their assigns, respectively.
- (3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding paragraph to use or employ any machine, machinery, mechanism, process, or operation of any improved or additional machine, machinery, mechanism, process, or operation or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

**66. Compensation.**—The Order shall further provide that if any person within one year after the date thereof make an application to the Comptroller for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the *bona fide* belief that such patent had become and continued to be void, it shall be lawful for the Comptroller, after hearing the parties concerned to assess the amount of such compensation if in his opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

[Regarding Rules 65-66 above, compare Rule 28 of the Indian Patents and Designs Rules, 1933.]

#### AMENDMENT OF SPECIFICATION UNDER SECTION 21 OF THE ACTS.

**67. Request for leave to amend.**—A request to the Comptroller for leave to amend an accepted specification, except when such request is made under Rule 33 or 34, shall be made on Patents Form No. 118. The request must be accompanied by a King's Printer's or official copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the Journal, and in such other manner as the Comptroller may in each case direct,

**68. Notice of opposition.—Copy for the applicant.**—A notice of opposition to the amendment shall be given on Patents Form No. 19. Such notice shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

**69. Further proceedings.**—Upon such notice of opposition being given and copy thereof transmitted to the applicant the provisions of Rules 44 to 50 shall apply to the case.

[Regarding Rules 67-69 above and Rules 72 and 73 below, compare Rules 29-31 of the Indian Patents and Designs Rules, 1933.]

**70. Requirements on amendment.**—Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Office a new specification and drawings as amended, to be prepared in accordance with Rules 5 and 18 to 24.

**71. Advertisement of amendment.**—Particulars of all amendments of specifications allowed and made under Section 21 shall be advertised forthwith by the Comptroller in the Journal.

[Regarding Rules 70 and 71 above, compare Rule 32 of the Indian Patents and Designs Rules, 1933.]

#### **AMENDMENT OF APPLICATION OR SPECIFICATION BEFORE ACCEPTANCE.**

**72. Request for leave to amend specification before acceptance.** A request for leave to amend a specification which has not been accepted, other than when such request is made under Rules 33 or 34, shall be made on Patents Form No. 18A.

**73. Request for leave to amend an application for a patent.**—A request for leave to amend an application for a patent shall be made on Patents Form No. 18B.

[Regarding Rules 72 and 73 above, also Rules 67-69 above, compare Rules 29-31 of the Indian Patents and Designs Rules, 1933.]

#### **LICENCES OF RIGHT.**

**74. Request for indorsement "licences of right."**—A request to the Comptroller to indorse a patent with the words "licences of right" shall be made upon Patents Form No. 20. Such request shall be accompanied by a statutory declaration and such other evidence as the Comptroller may deem necessary to show that the patentee is not precluded by contract from making such request.

**75. Application for refusal of request.**—Upon receipt of such request it shall be advertised in the Journal and any person alleging that such request has been made contrary to some contract, in which he is interested, may apply to the Comptroller upon Patents Form No. 21, within one month from the date of the advertisement, for the refusal of the request or at any time after indorsement for cancellation of the indorsement. Such application shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks, and in the case of an application for cancellation of the indorsement by Patents Form No. 14 with payment thereon of the unpaid moiety of all renewal fees which have become due since the indorsement. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee.

**76. Further procedure.**—Upon such application being made and a copy thereof transmitted to the patentee, the provisions of Rules 44 to 50 shall apply to the case.

**77. Application to settle terms of licence.**—An application to the Comptroller for settlement of the terms of a licence under a patent which has been indorsed "licences of right" shall be made upon Patents Form No. 22.

Such application shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the terms of the licence which he is prepared to grant or accept. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee or the applicant for the licence, as the case may be. Upon such application being made and a copy thereof transmitted to the patentee or applicant for the licence, as the case may be, the provisions of Rules 44 to 50 shall apply to the case with the necessary modifications.

**78. Application for cancellation of indorsement.**—An application by a patentee for the cancellation of an indorsement under Section 24 of the Acts shall be made upon Patents Form No. 23 and shall be advertised by the Comptroller in the Journal and in such other manner, if any, as he deems desirable. Such application shall be accompanied by Patents Form No. 14 with payment thereon of the unpaid moiety of all renewal fees which have become due since the indorsement.

**79. Opposition.**—At any time within one month from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 24. Such notice shall be accompanied by an unstamped copy thereof, and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case, and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

**80. Further procedure.**—Upon such notice of opposition being given and a copy thereof transmitted to the patentee, the provisions of Rules 44 to 50 shall apply to the case.

#### PROCEDURE UNDER SECTION 26 OF THE ACTS.

**81. Application under Section 26 of the Acts.—Copy for patentee.**—An application for the revocation of a patent under Section 26 of the Acts shall be made on Patents Form No. 25. Such application shall be accompanied by an unstamped copy thereof, and a statement in duplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the application and of the statement will be transmitted by the Comptroller to the patentee.

**82. Procedure.**—Upon such application being made and a copy thereof transmitted to the patentee the provisions of Rules 44 to 50 shall apply to the case.

**83. Surrender of patent.**—(1) A notice of an offer by a patentee to surrender his patent under Section 26 of the Acts shall be given on Patents Form No. 26, and shall be advertised by the Comptroller in the Journal and in such other manner as he deems desirable.

**Notice of opposition.**—(2) At any time within one month from the first of such advertisements in the Journal any person may give notice of opposition to the Comptroller on Patents Form No. 26A. Such notice shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the patentee.

Upon such notice of opposition being given and a copy thereof transmitted to the patentee, the provisions of Rules 44 to 50 shall apply to the case.

[Compare Rule 33 of the Indian Patents and Designs Rules, 1933.]

#### PROCEDURE UNDER SECTION 27 OF THE ACTS.

**84. Application for compulsory licence or revocation of a patent.**—An application to the Comptroller for an Order under Section 27 of the Acts shall be made on Patents Form No. 27 and shall set out fully the nature of the applicant's interest, the facts upon which he bases his case, and the relief which he seeks. The application shall be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.

**85. Advertisement of application.—Service of documents.**—If the Comptroller upon consideration of the application decides that it may proceed, it shall be advertised in the Journal and the applicant shall upon receipt of directions from the Comptroller serve a copy of the application and of the declarations upon the patentee and upon any other persons appearing from the Register to be interested in the patent. The applicant must notify the Comptroller when such service has been effected.

**86. Counter-statement.**—The patentee or any person desirous of opposing the application shall within fourteen days from the advertisement of the application in the Journal, or such further time as the Comptroller may allow, deliver to the Comptroller a counter-statement verified by statutory declaration fully setting out the grounds on which the application is opposed. A copy of the counter-statement and of the declaration or declarations shall within the same time be delivered to the applicant by the opponent.

**87.** No further evidence shall be delivered by either party except by leave, or on requisition, of the Comptroller.

**88. Application for hearing.**—If any of the parties desire a hearing a request therefor shall be made upon Patents Form No. 28 which must be left at the Office within fourteen days from the date of the delivery of the counter-statement and declaration.

**89. Hearing.**—Upon receipt of such request, the Comptroller shall appoint a time for hearing the case and shall give all the parties ten days' notice at the least of such appointment. Any party who does not desire to be heard shall forthwith notify the Comptroller to that effect. Every person who desires to be heard, except the person applying for the hearing must notify the Comptroller on Patents Form No. 11 and the Comptroller may refuse to hear any person who has not left Patents Form No. 11 prior to the date of the hearing. If no application for a hearing has been received and the Comptroller is of opinion that a hearing is necessary, he shall appoint a time for hearing the case and proceed as though a request for hearing had been made under Rule 88. After hearing the party or parties or without a hearing if no hearing is necessary, the Comptroller shall decide the case and notify his decision to the parties.

**90. Application by licensee to surrender a licence under Section 27 (3) (a).**—An application by an existing licensee, under a patent which has been indorsed "licences of right" under the provisions of Section 27, sub-section (3) (a) of the Acts, for an Order of the Comptroller entitling the licensee to surrender his licence in exchange for a licence to be settled by the Comptroller, shall be made upon Patents Form No. 22 as provided in Rule 77 and the further proceedings thereon shall be regulated in accordance with the provisions contained in Rule 77.

#### PROCEDURE UNDER SECTION 37 OF THE ACTS.

**91. Application for relief under Section 37 (2).**—An application made by a co-patentee for relief under sub-section (2) of Section 37 shall be made upon Patents Form No. 40 and shall state the ground or grounds upon which such application for relief is made, and upon any such application the Comptroller may give such directions as to the procedure to be adopted as he may think fit.

#### PATENTS FOR FOOD OR MEDICINE.

**92. Patents for food or medicine.**—An application to the Comptroller under Section 38A(3) of the Acts for a licence to use an invention for the purpose of the preparation or production of food or medicine shall be made on Patents Form No. 29. The procedure to be followed shall be the same as that prescribed in Rules 84 to 89 for an application under Section 27 of the Acts.

#### REGISTER OF PATENTS.

**93. Entry of grant.**—Upon the sealing of a patent the Comptroller shall cause to be entered in the register of patents the name, address, and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the sealing thereof, together with the address for service and such other particulars as the Comptroller may deem necessary.

[Compare Rule 49 of the Indian Patents and Designs Rules, 1933.]

**94. Entry in respect of Convention application.**—The patent granted on any Convention application shall be entered in the register bearing the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application. The date of the application in this country shall also be entered in the register.

[Compare Rule 50 of the Indian Patents and Designs Rules, 1933.]

**95. Alteration of address.**—If a patentee send to the Comptroller on Patents Form No. 30 notice in respect of a patent of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly.

[Compare Rule 53 of the Indian Patents and Designs Rules, 1933.]

**96. Application for entry of subsequent proprietorship.—Form and signature of request.**—Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee or licensee, application for the entry in the register of his name as proprietor or part proprietor of the patent, or of a notice of such interest, as the case may be, shall be made on Patents Form No. 32 or Patents Form No. 33, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor or part proprietor, or by his agent, and in the case of a body corporate by its duly authorised officer or agent.

[Compare Rules 54 and 53 of the Indian Patents and Designs Rules, 1933.]

**97. Production of documents of title and other proof.**—Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such application, except such documents as are matters of record in the United Kingdom, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the application, and he may call for such other proof of title or written consent as he may require.

An official or certified copy of a document which is a matter of record in the United Kingdom shall in like manner be produced to the Comptroller.

[Compare Rule 56 of the Indian Patents and Designs Rules, 1933.]

**98. Copies for office.**—The application shall be accompanied by an attested copy of the assignment or other document required to be produced by the preceding Rule.

**99. Entry of notice of interest.**—The notice of interest in a patent of any person other than the proprietor or part proprietor entered in the register in pursuance of the application shall be such as may appear applicable to the circumstances of the particular case.

**100.—Entry of notification of document.**—Application for entry in the register of notification of any document (not already provided for) purporting to affect the proprietorship of a patent shall be made on Patents Form No. 34. Such application shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

[Compare Rule 58 of the Indian Patents and Designs Rules, 1933.]

**101. Entry of date of payment of fees on issue of certificate.**—Upon the issue of a certificate of payment under Rule 59 the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

[Compare Rule 51 of the Indian Patents and Designs Rules, 1933.]

**102. Hours of inspection of register.**—The register of patents shall be open to the inspection of the public, on payment of the prescribed fee, on every day on which the office is open to the public during the time it is so open except at such times when the use of the register may be required for any official purpose.

[Compare Rule 59 of the Indian Patents and Designs Rules, 1933.]

**CORRECTION OF CLERICAL ERRORS.**

**103. Correction of clerical errors.**—A request for the correction of a clerical error in or in connexion with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 35.

In any case where the Comptroller requires notice of the nature of the proposed correction to be advertised, such advertisement shall be made by publication of the request and the nature of the proposed correction in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

Any person may at any time within one month from the date of such advertisement in the Journal give notice at the Patent Office of opposition to the proposed correction.

Notice of opposition to the correction shall be made on Patents Form No. 35A. Such notice shall be accompanied by an unstamped copy thereof and a statement in duplicate setting out fully the nature of the opponent's interest, the facts on which he bases his case and the relief which he seeks. A copy of the notice and of the statement will be transmitted by the Comptroller to the applicant.

Upon such notice of opposition being given and a copy thereof transmitted to the applicant, the provisions of Rules 44 to 50 shall apply to the case.

**CERTIFICATES.**

**104. Certificates and certified copies of documents.**—A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorized by the Acts or any of these Rules to make or do, shall be made on Patents Form No. 36.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the fee prescribed by these Rules.

**INFORMATION.**

**105. Requests for information.**—A request made under Section 44A for information upon a matter affecting a patent or an application for a patent shall be made on Patents Form No. 36A, and may be in respect of any one of the following matters:—

- (a) when a complete specification following a provisional specification has been left or when an application for a patent has become abandoned;
- (b) when a complete specification has been accepted or when an application for a patent has become void;
- (c) when a patent has been sealed or when the time for payment of the sealing fee has expired;
- (d) when a renewal fee has been paid;
- (e) when a patent has expired;
- (f) when an entry has been made on the register or application has been made for the making of such entry; or
- (g) when any application is made or action taken involving an entry on the register or advertisement in the Journal.

[Regarding Rules 104 and 105 above, compare Rule 63 of the Indian Patents and Designs Rules, 1933.]

**SECRET PATENTS.**

**106. Secret patents.**—When it has been decided by the Admiralty, Secretary of State for War or the Secretary of State for Air that it is advisable to take out a secret patent for any invention assigned under Section 30 of the Acts, and an application for such patent has been made on Patents Form No. 1D, accompanied by a certificate of the Admiralty or Secretary of State under Section 30(3) of the Acts, the Comptroller shall not communicate the application

or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Acts to be made in the case of other applications for patents.

Unless and until such invention is re-assigned to the inventor by the Admiralty or Secretary of State—

- (1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.
- (2) The application for the patent, and the acceptance of any specification relating to the invention shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under Section 11 of the Acts; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.
- (3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Acts for ordinary patents. Nor shall any entry be made in the ordinary register of patents in respect of any such patent or any assignment thereof.
- (4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of sixteen years from its date.

**107. Certificate of secrecy after application.**—When an application has been made otherwise than as provided by the last preceding Rule for a patent for an invention, and such application is still pending, and a certificate under Section 30(3) of the Acts is furnished to the Comptroller by the Admiralty or Secretary of State, the provisions of such Rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

**108. Re-assignment.**—In the event of any secret patent being re-assigned to the inventor by the Admiralty or Secretary of State, it shall be removed from the confidential register of secret patents; all fees that would have been there-after payable if the same had not been a secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payments of fees and otherwise as if it had not been a secret patent.

### LOST PATENT.

**109. Lost patent.**—An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 37, and shall be accompanied by a statutory declaration setting out in full and verifying the circumstances in which the patent was lost or destroyed.

### INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

**110. Industrial or International Exhibitions.**—Any person desirous of exhibiting at an industrial or international exhibition an invention in respect of which an application for a patent has not been left at the Patent Office, or of publishing any description of such invention during the period of the holding of the exhibition, or of using such invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 38 of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

**PUBLICATION OF INVENTIONS BEFORE LEARNED SOCIETIES.**

**111. Publication of inventions before learned societies.**—Any person desirous of publishing an invention in respect of which an application for a patent has not been left at the Patent Office, by reading a paper before a learned Society or of permitting publication of the paper in such Society's transactions may give the Comptroller notice on Patents Form No. 38 of his intention to publish such invention as provided in Rule 110.

**EXERCISE OF DISCRETIONARY POWERS BY THE COMPTROLLER.**

**112. Exercise of discretionary powers by Comptroller.**—**Notice of hearing.**—Before exercising any discretionary power given to the Comptroller by the Acts or these Rules adversely to any person concerned, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to such person of the time when he may be heard personally or by his agent before the Comptroller.

**113. Notice by applicant.**—Within five days from the date on which such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the person concerned shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

[Regarding Rules 112 and 113 above, compare Rule 64 of the Indian Patents and Designs Rules, 1933.]

**114. Comptroller may require statement, etc.**—Whether such person desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

[Compare Rule 65 of the Indian Patents and Designs Rules, 1933.]

**115. Decision to be notified to parties.**—The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to all persons who appear to him to be affected thereby.

**STATUTORY DECLARATIONS AND AFFIDAVITS.**

**116. Form, etc., of statutory declaration and affidavit.**—The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written, typed, lithographed or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

**117. Manner in which, and persons before whom, declaration or affidavit is to be taken.**—The statutory declarations and affidavits required by the Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

- (a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;
- (b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and
- (c) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a judge or magistrate.

**GENERAL.**

**118. Power of amendment, etc.**—If the Comptroller think fit any document for the amending of which no special provision is made by the Acts may be



amended, and any irregularity in procedure may be rectified, on such terms as the Comptroller may direct if in the opinion of the Comptroller such amendment or rectification can be made without detriment to the interests of any person.

[Compare Rule 66 of the Indian Patents and Designs Rules, 1933.]

**119. General power to enlarge time.**—The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times prescribed by Rules 15, 52 and 58, may be enlarged by the Comptroller if he thinks fit, upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

[Compare Rule 67 of the Indian Patents and Designs Rules, 1933.]

**120. Days and hours of business.**—The Office shall be open to the public every weekday except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

**121. Excluded days.**—Whenever the last day fixed by the Acts, or by these Rules, for doing anything shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Acts and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

**122. Power to dispense with evidence, signature, etc.**—Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, signature, declaration, document, or evidence.

#### APPLICATIONS TO AND ORDERS OF COURT.

**123. Applications to Court.**—Four clear days' notice of every application to the Court under Section 72 of the Acts for rectification of the register of patents shall be given to the Comptroller.

**Orders of Court.**—Where any Order has been made by the Court under the Acts revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent or any rights thereunder, the person in whose favour such Order has been made shall forthwith serve on the Comptroller an office copy of such Order together with Patents Form No. 39. The specification shall thereupon be amended or the register rectified or altered as the case may be.

#### REPEAL.

**124. Repeal.**—The Patents Rules, 1920, are hereby repealed, without prejudice to anything done under such Rules, or to any application or other matter pending thereunder at the date of the coming into force of these Rules.

[Compare Rule 68 of the Indian Patents and Designs Rules, 1933.]

Dated this 25th day of October, 1932.

WALTER RUNCIMAN,  
President of the Board of Trade.

**THE FIRST SCHEDULE.**

**List of Fees payable in respect of the grant of Patents and of other matters with relation thereto.**

			Corresponding Form
£ s. d.			
1	On application accompanied by provisional specification .. .. .	1 0 0	Patents Forms Nos. 1 or 1A, etc.
2	On filing complete specification thereafter	4 0 0	Patents Form No. 3.
3	On application accompanied by complete specification .. .. .	5 0 0	Patents Forms Nos. 1 or 1A, etc., and 3.
4	On request for the post-dating of an application under sub-section (4) of Section 3:— Not exceeding one month ..	2 0 0	Patents Form No. 4.
	„ two months ..	4 0 0	„ „
	„ three months ..	6 0 0	„ „
	„ four months ..	8 0 0	„ „
	„ five months ..	10 0 0	„ „
	„ six months ..	12 0 0	„ „
5	For extension of time under Rule 15:— Not exceeding one month ..	2 0 0	Patents Form No. 5.
	„ two months ..	4 0 0	„ „
	„ three months ..	6 0 0	„ „
6	For extension of time for leaving complete specification not exceeding one month ..	2 0 0	Patents Form No. 6.
7	For extension of time for leaving amended specification under Rule 29 or 33 or notifying acceptance of alternative under Rule 30 or 34:— Not exceeding one month ..	0 10 0	Patents Form No. 7.
	Each succeeding month .. ..	0 10 0	„ „
8	For extension of time for acceptance of complete specification:— Not exceeding one month ..	2 0 0	Patents Form No. 8.
	„ two months ..	4 0 0	„ „
	„ three months ..	6 0 0	„ „

	£ s. d.	Corresponding Form
9 On application for result of a search under Sections 7 and 8 .. .. .	1 0 0	Patents Form No. 9.
10 On notice of opposition to grant of patent. By opponent .. .. .	1 0 0	Patents Form No. 10.
10A On application for extension of time for filing notice of opposition to grant of patent .. .. .	1 0 0	Patents Form No. 10A.
11 On hearing by Comptroller. By applicant and by opponent, respectively ..	2 0 0	Patents Form No. 11.
12 On notice of desire to have patent sealed ..	1 0 0	Patents Form No. 12.
12A Application under Section 12(1) (b) for grant of patent to an assignee ..	1 0 0	Patents Form No. 12E.
13 On application for extension of time for sealing of patent other than extension under sub-section 4(d) of Section 12:—		
Not exceeding one month .. ..	2 0 0	Patents Form No. 13.
" " two months .. ..	4 0 0	" "
" " three months .. ..	6 0 0	" "
13A On application for extension of time for sealing of patent under sub-section 4(d) of Section 12:—		
Not exceeding one month .. ..	2 0 0	Patents Form No. 13A.
Each succeeding month .. ..	2 0 0	" "
13B On application for grant of Patent of Addition in lieu of an independent patent ..	5 0 0	Patents Form No. 13B.
On application for certificate of renewal:—		
14* Before the expiration of the 4th year from the date of the patent and in respect of the 5th year .. .. .	5 0 0	Patents Form No. 14.
15* Before the expiration of the 5th year from the date of the patent and in respect of the 6th year .. .. .	6 0 0	" "

	£ s. d.	Corresponding Form
16* Before the expiration of the 6th year from the date of the patent and in respect of the 7th year .. .. .	7 0 0	Patents Form No. 14.
17* Before the expiration of the 7th year from the date of the patent and in respect of the 8th year .. .. .	8 0 0	" "
18* Before the expiration of the 8th year from the date of the patent and in respect of the 9th year .. .. .	9 0 0	" "
16* Before the expiration of the 9th year from the date of the patent and in respect of the 10th year .. .. .	10 0 0	" "
20* Before the expiration of the 10th year from the date of the patent and in respect of the 11th year .. .. .	11 0 0	" "
21* Before the expiration of the 11th year from the date of the patent and in respect of the 12th year .. .. .	12 0 0	" "
22* Before the expiration of the 12th year from the date of the patent and in respect of the 13th year .. .. .	13 0 0	" "
23* Before the expiration of the 13th year from the date of the patent and in respect of the 14th year .. .. .	14 0 0	" "
24* Before the expiration of the 14th year from the date of the patent and in respect of the 15th year .. .. .	15 0 0	" "
25* Before the expiration of the 15th year from the date of the patent and in respect of the 16th year .. .. .	16 0 0	" "
26 On enlargement of time for payment of renewal fees:--		
Not exceeding one month .. .. .	2 0 0	Patents Form No. 15.
" " two months .. .. .	4 0 0	" "
" " three months .. .. .	6 0 0	" "
27 On application for restoration of a lapsed patent .. .. .	20 0 0	Patents Form No. 16.
28 On notice of opposition to application for restoration of lapsed patent .. .. .	1 0 0	Patents Form No. 17.

\* One moiety only of these fees payable on Patents indorsed "Licences of Right."

		£ s. d.	Corresponding Form
29	On hearing by Comptroller. By applicant and by opponent, respectively ..	2 0 0	Patents Form No. 11.
30	On application to amend specification after acceptance:—		
	Up to sealing. By applicant ..	1 10 0	Patents Form No. 18.
	After sealing. By patentee ..	3 0 0	„ „
30A	On application to amend specification not yet accepted .. ..	1 10 0	Patents Form No. 18A.
30B	On application to amend an application for a patent .. ..	1 10 0	Patents Form No. 18B.
31	On notice of opposition to amendment. By opponent .. ..	1 0 0	Patents Form No. 19.
32	On hearing by Comptroller. By applicant and by opponent, respectively ..	2 0 0	Patents Form No. 11.
33	On request for indorsement of patent "Licences of Right" .. ..	1 0 0	Patents Form No. 20.
34	On application for refusal of request for indorsement of patent "Licences of Right" or cancellation of indorsement ..	2 0 0	Patents Form No. 21.
35	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
36	On application for settlement of terms of "Licences of Right" .. ..	5 0 0	Patents Form No. 22.
37	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
38	On application by patentee for cancellation of indorsement of a patent "Licences of Right" .. ..	2 0 0	Patents Form No. 23.
39	On notice of opposition to cancellation of indorsement of a patent "Licences of Right" .. ..	2 0 0	Patents Form No. 24.
40	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
41	On application for revocation of a patent under Section 26 .. ..	2 0 0	Patents Form No. 25.
42	On hearing by Comptroller. By applicant and by patentee, respectively ..	2 0 0	Patents Form No. 11.
43	On offer to surrender a patent under Section 26 .. ..	1 0 0	Patents Form No. 26.
43A	On notice of opposition to surrender a patent	1 0 0	Patents Form No. 26A.

		£ s. d.	Corresponding Form
44	On hearing by Comptroller. By applicant and by opponent, respectively.. ..	2 0 0	Patents Form No. 11.
45	On application for grant of compulsory licence or revocation of a patent under Section 27 .. ..	5 0 0	Patents Form No. 27.
46	On request for hearing under Section 27(10)	2 0 0	Patents Form No. 28.
47	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
48	On application for licence under Section 38A(3) .. ..	5 0 0	Patents Form No. 29.
49	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
50	For altering name or address or address for service in register, for each patent ..	0 5 0	Patents Form No. 30.
51	For entry of two addresses for service in register, for each patent .. ..	0 5 0	Patents Form No. 31.
52	On application for entry of name of subsequent proprietor in the register of patents, if made within six months from date of acquisition of proprietorship:—		
	In respect of one patent .. ..	1 0 0	Patents Form No. 32.
	For each additional patent, the devolution of title being the same as in the first patent .. ..	0 2 6	„ „
53	On application for entry of name of subsequent proprietor in the register of patents, if made after expiration of six months from date of acquisition of proprietorship:—		
	In respect of one patent .. ..	10 0 0	„ „
	For each additional patent, the devolution of title being the same as in the first patent .. ..	0 2 6	„ „
54	On application for entry of notice of a mortgage of licence in the register of patents, if made within six months from date of acquisition of interest or the sealing of the patent :—		
	In respect of one patent .. ..	1 0 0	Patents Form No. 33.
	For each additional patent, the devolution of title being the same as in the first patent .. ..	0 2 6	„ „

		£ s. d.	Corresponding Form
55	On application for entry of notice of a mortgage or licence in the register of patents, if made after expiration of six months from date of acquisition of interest or the sealing of the patent:—		
	In respect of one patent .. ..	10 0 0	Patents Form No. 33.
	For each additional patent, the devolution of title being the same as in the first patent .. ..	0 2 6	„ „
56	On application for entry of notification of a document in the register of patents, if made within six months from date of document or the sealing of the patent:—		
	In respect of one patent .. ..	1 0 0	Patents Form No. 34.
	For each additional patent referred to in the same document as the first patent .. ..	0 2 6	„ „
57	On application for entry of notification of a document in the register of patents, if made after expiration of six months from date of document or the sealing of the patent:—		
	In respect of one patent .. ..	10 0 0	Patents Form No. 34.
	For each additional patent referred to in the same document as the first patent .. ..	0 2 6	„ „
58	On request to Comptroller to correct a clerical error:—		
	Up to sealing .. ..	0 10 0	Patents Form No. 35.
	After sealing .. ..	1 0 0	„ „
58A	On notice of opposition to the correction of a clerical error .. ..	1 0 0	Patents Form No. 35A.
58B	On hearing by Comptroller. By each party	2 0 0	Patents Form No. 11.
59	For Certificate of Comptroller under Section 78 .. ..	0 10 0	Patents Form No. 36.
59A	On request for information as to a matter affecting a patent or an application therefor .. ..	0 10 0	Patents Form No. 36A.

			Corresponding Form
			£ s. d.
60	For duplicate of patent .. ..	2 0 0	Patents Form No. 37.
61	On notice to Comptroller of intended exhibition or publication of an invention under Section 45 .. ..	1 0 0	Patents Form No. 38.
62	On notice of order of Court for amendment of specification or rectification of register .. ..	0 10 0	Patents Form No. 39.
62A	On application under Section 37 (2) for directions as to sale or lease of a patent or grant of licence .. ..	5 0 0	Patents Form No. 40.
62B	On hearing by Comptroller. By each party .. ..	2 0 0	Patents Form No. 11.
63	On inspection of register, original documents, convention documents and samples or specimens .. ..	0 1 0	
64	For typewritten office copies—every 100 words (but never less than one shilling)	0 0 6	
65	For photographic office copies and office copies of drawings, cost according to agreement .. ..	....	
66	For office copy of patent .. ..	0 4 6	
67	For certifying office copies, MSS, printed or photographic .. .. each	0 2 6	

Dated this 25th day of October, 1932.

WALTER RUNCIMAN,

President of the Board of Trade.

We sanction the above fees.

AUSTIN HUDSON,

WALTER J. WOMERSLEY,

Lords Commissioners of

His Majesty's Treasury.



**THE SECOND SCHEDULE.**

Forms		Corresponding Fee
Patents Form No. 1 ..	Application for Patent ..	£1
„ No. 1A ..	Application for Patent communi- cated from abroad ..	£1
„ No. 1B ..	Application for Patent under Inter- national and Colonial Arrange- ments .. .. .	£1
„ No. 1B* ..	Application for Patent by Legal Representatives or Assignees under International and Colonial Arrangements .. .. .	£1
„ No. 1C ..	Application for Patent of Addition	£1
„ No. 1C* ..	Application for Patent of Addition under International and Colonial Arrangements .. .. .	£1
„ No. 1C**	Application for Patent of Addition for Invention communicated from abroad .. .. .	£1
„ No. 1C*†	Application for Patent of Addition by Legal Representatives of Assignees under International and Colonial Arrangements ..	£1
„ No. 1C***	Application for Patent of Addition to a Patent of Addition ..	£1
„ No. 1D ..	Application for Secret Patent ..	
„ No. 1E ..	Application for Grant of Patent to an Assignee .. .. .	£1
„ No. 2 ..	Provisional Specification ..	
„ No. 3 ..	Complete Specification ..	£4
„ No. 4 ..	Request for post-dating of applica- tion .. .. .	Fee item 4
„ No. 5 ..	Application for extension of Time under Rule 15 .. .. .	£2, £4, or £6
„ No. 6 ..	Application for extension of Time for leaving Complete Specifica- tion .. .. .	£2
„ No. 7 ..	Application for extension of Time for leaving as amended Specifica- tion under Rule 29 or 33 or notifying acceptance of alterna- tive offered under Rule 30 or 34	Fee item 7.

Forms		Corresponding Fee
Patents Form No. 8 ..	Application for extension of Time for acceptance of Complete Specification .. ..	£2, £4, or £6
,, No. 9 ..	Application for the result of a search made under Sections 7 and 8 .. ..	£1
,, No. 10 ..	Notice of Opposition to Grant of Patent .. ..	£1
,, No. 10A ..	Application for extension of Time for filing Notice of Opposition to Grant of Patent .. ..	£1
,, No. 11 ..	Notice that hearing before the Comptroller will be attended ..	£2
,, No. 12 ..	Notice of Desire to have Patent sealed .. ..	£1
,, No. 13 ..	Application for extension of Time for the sealing of a Patent other than extension under sub-section (4) (d) of Section 12 ..	£2, £4, or £6
,, No. 13A ..	Application for extension of Time for the sealing of a Patent under sub-section (4) (d) of Section 12	£2 per month
,, No. 13B ..	Application for the grant of a Patent of Addition in lieu of an independent Patent .. ..	£5
,, No. 14 ..	Application for Certificate of Payment of Renewal Fee ..	Fee items 14 to 25
,, No. 15 ..	Application for enlargement of Time for Payment of Renewal Fee ..	£2, £4, or £6
,, No. 16 ..	Application for the restoration of a lapsed Patent .. ..	£20
,, No. 17 ..	Opposition to application for restoration of a lapsed Patent ..	£1
,, No. 18 ..	Application for Amendment of Specification after acceptance ..	£1 10s., or £5
,, No. 18A ..	Application for Amendment of Specification not yet accepted ..	£1 10s.
,, No. 18B ..	Application for Amendment of an application for a Patent ..	£1 10s.
,, No. 19 ..	Opposition to Amendment of Specification .. ..	£1

Forms		Corresponding Fee
Patents Form No. 20 ..	Request for indorsement of Patent "Licences of Right" ..	£1
,, No. 21 ..	Application for refusal of request for indorsement of Patent "Licences of Right" or cancellation of in- dorsement ..	£2
,, No. 22 ..	Application for settlement of terms of Licence under Patent indorsed "Licences of Right" ..	£5
,, No. 23 ..	Application by patentee for cancell- ation of indorsement of a Patent "Licences of Right" ..	£2
,, No. 24 ..	Opposition to cancellation of in- dorsement of a Patent "Licences of Right" ..	£2
,, No. 25 ..	Application for Revocation of a Patent under Section 26 ..	£2
,, No. 26 ..	Offer to surrender a Patent ..	£1
,, No. 26A ..	Opposition to surrender a Patent ..	£1
,, No. 27 ..	Application for Grant of Compulsory Licence or Revocation of a Patent under Section 27 ..	£5
,, No. 28 ..	Request for hearing under Section 27 (10) ..	£2
,, No. 29 ..	Application for Licence under Sec- tion 38A (3) ..	£5
,, No. 30 ..	Request for Alteration of Name or Address or Address for Service in Register ..	5s.
,, No. 31 ..	Request to enter two Addresses for Service in Register ..	5s.
,, No. 32 ..	Application for entry of name of proprietor in Register ..	Fee items 52 & 53
,, No. 33 ..	Application for entry of Notice of Mortgage or Licence in Register ..	Fee items 54 & 55
,, No. 34 ..	Application for entry of Notifica- tion of Document in Register ..	Fee items 56 & 57
,, No. 35 ..	Request for Correction of Clerical Error ..	10s., or £1
,, No. 35A ..	Notice of Opposition to Correction of Clerical Error ..	£1

Forms		Corresponding Fee
Patents Form No. 36 ..	Request for Certificate of Comptroller	10s.
,, No. 36A ..	Request for information as to a matter affecting a Patent or an application thereof ..	10s.
,, No. 37 ..	Application for Duplicate of Patent	£2
,, No. 38 ..	Notice of Intended Exhibition or Publication of Unpatented Inven- tion .. ..	£1
,, No. 39 ..	Application for Entry of Order of Court .. ..	10s.
,, No. 40 ..	Application under Section 37 (2) for directions as to sale or lease of a Patent or Grant of Licence ..	£5

[N.B.—The model English Patents Forms referred to above, which are used only in the United Kingdom for business at the English Patent Office, have been omitted from this Appendix.]

#### THE THIRD SCHEDULE.

[N.B.—This Schedule consists of Form A, being the English Form of Patent in use in the United Kingdom for the grant of a Patent in an ordinary case, and of Form B, being the English Form of Patent in use in the United Kingdom for the grant of a Patent of Addition. See Rules 55 to 57 above. The first-mentioned Form is worded in the same manner as that set out in full at page 23 above and fully discussed in Chapter II above.]

WALTER RUNCIMAN,  
President of the Board of Trade.

Dated this 25th day of October, 1932.

**PATENTS APPEAL TRIBUNAL FEES ORDER, 1932.**

Dated October 26, 1932.

(S. R. &amp; O. 1932, No. 874.)

The Lord Chancellor, the Judges of the Supreme Court, and the Treasury, in pursuance of the powers and authorities vested in them respectively, by Section 92A of the Patents and Designs Act, 1907, Section 213 of the Supreme Court of Judicature (Consolidation) Act, 1925, and Sections 2 and 3 of the Public Offices Fees Act, 1879, do hereby, according as the provisions of the above-mentioned enactments respectively authorize and require them, make, advise, consent to, and concur in, the following Order:—

1. A fee of £3 shall be taken upon the filing of every notice of appeal to the Appeal Tribunal constituted under Section 92A of the Patents and Designs Act, 1907.

2. Where it appears to the Lord Chancellor that the payment of the fee prescribed by this Order would, owing to the exceptional circumstances of the particular case, involve hardship, the Lord Chancellor may, with the concurrence of the Treasury, reduce or remit the fee in that particular case.

3. The fee prescribed by this Order shall be taken by a judicature fee stamp impressed on the notice of appeal.

4. The Interpretation Act, 1889, shall apply for the purposes of this Order as if it were an Act of Parliament.

5. This Order may be cited as the Patents Appeal Tribunal Fees Order, 1932, and shall come into operation on the 1st day of November, 1932.

SANKEY, C.  
HEWART, C. J.,  
HANWORTH, M. R.  
FAIRFAX LUXMOORE.  
AUSTIN HUDSON.  
WALTER J. WOMERSLEY.

Lords Commissioners of )  
His Majesty's Treasury. )

Dated the 26th day of October, 1932.

**PATENTS APPEAL TRIBUNAL RULES, 1932.**

Dated October 31, 1932.

(S. R. & O. 1932, No. 887.)

I, the Honourable Arthur Fairfax Charles Corydon Luxmoore, Knight, the Judge of the High Court nominated by the Lord Chancellor to be the Appeal Tribunal constituted under Section 92A of the Patents and Designs Act, 1907, do, by virtue of Section 92A(3)(b) of the Act and all other powers enabling me in this behalf, hereby make the following Rules:—

1. When any person intends to appeal to the Appeal Tribunal from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within fourteen days from the date of the decision appealed against file in the Registry, Patents Appeal Tribunal, Royal Courts of Justice, a notice in the appropriate form set out in the Schedule hereto.

2. The notice shall state the nature of the decision appealed against and whether the appeal is from the whole, or part only, and if so, what part, of the decision.

3. A copy of the notice of appeal shall be sent by the appellant to the Comptroller; and, when there has been an opposition, or a dispute under Section 12 or an application under Section 49 or under Section 58 of the Act, to the opposite party or parties also.

4. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Registry, Patents Appeal Tribunal, all the papers relating to the matter in respect of which the appeal is made.

5. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow (upon request received before the expiration of the said fourteen days), except by special leave upon application to the Appeal Tribunal.

6. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal shall be given by the Registrar, Patents Appeal Tribunal, unless special leave be given by the Appeal Tribunal that any shorter notice may be given.

7. Such notice shall in all cases be given to the Comptroller and the appellant and all other necessary parties.

8. The evidence used on appeal by the Appeal Tribunal shall be the same as that used before the Comptroller; and no further evidence shall be given, except with the leave of the Appeal Tribunal upon application for that purpose.

9. The Appeal Tribunal may, at the request of any party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates.

10. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

11. The Appeal Tribunal may, upon awarding costs, either fix the amount thereof or direct by whom and in what manner the amount of such costs shall be ascertained.

12. If any costs awarded be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the Appeal Tribunal, the party to whom such costs are to be paid may apply to the Appeal Tribunal for an order for payment under the provisions of Section 92A(3)(c) of the Act.

13. All documentary evidence required, or allowed by the Appeal Tribunal to be filed, shall be subject to the same regulations in all respects, as apply to the procedure before the Comptroller, and shall be filed in the records of the Appeal Tribunal.

14. Any notice or other document required to be given to the Registrar, Patents Appeal Tribunal, under these Rules, may be sent by a prepaid letter through the post.

15. Where, prior to the 1st day of November, 1922, either a notice of intention to appeal to the law officer has been filed and served in accordance

with the law officer's Rules dated 11th December, 1907, or a petition has been presented and served in accordance with Order LIIIA Rule 5 (a) of the Rules of the Supreme Court by way of appeal to the Court under Section 49 or 58 of the Act, the requirements of Rules 1, 2, 3 and 5 hereof shall be deemed to have been satisfied.

16. The Interpretation Act, 1889, shall apply for the purposes of these Rules as if they were an Act of Parliament.

17. These Rules shall come into force on the 1st day of November, 1932, and may be cited as the Patents Appeal Tribunal Rules, 1932.

FAIRFAX LUXMOORE.

Dated the 31st day of October, 1932.

### **SCHEDULE.**

(Forms of Notice of Appeal to Appeal Tribunal.)

[There is in India no provision for the existence of any Patents Appeal Tribunal, such as is indicated above. There being no such Patents Appeal Tribunal, there are accordingly no corresponding Rules.]

**ORDER LIIIA.****Procedure in Actions for Infringements of Patents and under the Patents and Designs Acts, 1907 to 1932.****1. In this Order:—**

"The principal Act" means the Patents and Designs Act, 1907 as amended.

"The Comptroller" means the Comptroller-General of Patents, Designs and Trade Marks.

"The Court" includes the Judge of the High Court for the time being selected by the Lord Chancellor as the Court for the purpose of hearing appeals and petitions under the principal Act.

2. The Rules of the Supreme Court for the time being in force shall apply, so far as may be practicable (unless by the principal Act or by these Rules otherwise expressly provided), to all proceedings before the Court under the principal Act. In particular, if the Court is for the time being a Judge of the Chancery Division, the provisions of Order V, Rule 9, shall apply to all such proceedings, as being business assigned to the Court within the meaning of that Rule.

3. In the case of petitions for extension of the term of a patent under Section 18 of the principal Act, the following provisions shall apply:—

(a) A party intending to apply by petition shall give public notice by advertising three times in the "London Gazette," and once at least in a London daily newspaper.

(b) If the applicant's principal place of business is situated in the United Kingdom at a distance of 15 miles or more from Charing Cross he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no such place of business, then if he carries on the manufacture of anything made under his specification in the United Kingdom at a distance of 15 miles or more from Charing Cross he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no such place of business and carries on no such manufacture in the United Kingdom, then if he resides in the United Kingdom at a distance of 50 miles or more from Charing Cross he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

(c) The applicant shall in his advertisements state the object of his petition and shall give notice of the day (which if the Court is for the time being a Judge of the Chancery Division shall be an ordinary petition day) on which he intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing (hereinafter called "the appointed day"), which first mentioned day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the "London Gazette." Every such advertisement shall state an address within the United Kingdom for service on the applicant of any document requiring service under this Rule. He shall also give notices of objection which must be lodged as hereinafter provided before such day so named in the said advertisements. A copy of such advertisement shall be forwarded by the applicant to the Solicitor to the Board of Trade at the same time as the first advertisement is sent to the "London Gazette" and the Solicitor to the Board of Trade shall thereupon cause such advertisement to be inserted in the three following issues of the Official Journal (Patents).

(d) The petition shall name the Comptroller as a respondent and must be presented within one week from the publication of the last of the advertisements required to be published in the "London Gazette" and a copy of the petition must within the same time be served on the Solicitor to the Board of Trade. Such petition shall be made returnable for the day named in the advertisements.



- (e) The petition must be accompanied by an affidavit or affidavits of advertisements having been published by the petitioner according to the requirements of paragraphs (a), (b) and (c), hereof. The statements contained in such affidavit or affidavits may be disputed upon the hearing.
- (f) Upon the day named in the advertisements the petition shall appear in the Court List, and the petitioner shall apply to the Court to fix the appointed day.
- (g) The petitioners shall forthwith after the appointed day has been fixed give public notice of the same by advertising once at least in the "London Gazette."
- (h) A party presenting a petition must lodge as hereinafter provided a copy thereof with two printed copies of the specification of his patent.
- (i) The petitioner shall also lodge as hereinafter provided not less than three weeks before the appointed day two copies of the balance sheet of expenditure and receipts relating to the patent in question which accounts are to be proved on oath before the Court at the hearing. He shall also at the same time furnish two printed copies of the specification and of the said balance sheet to the Solicitor to the Board of Trade, and shall upon receiving two days' notice give the Solicitor to the Board of Trade or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet or from which the materials for making up the said balance sheet have been derived.
- (j) Any person desirous of opposing the prayer of the petition shall lodge as hereinafter provided a notice that he intends so to oppose and giving an address in the United Kingdom for service of any document requiring service under this Rule. Such person shall at the same time serve upon the petitioner and upon the Solicitor to the Board of Trade a copy of such notice. Such notices shall be respectively lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply to the Court for the appointed day to be fixed.
- (k) The petitioner shall forthwith upon receipt of such notice serve a copy of his petition upon each person giving such notice.
- (l) Every person giving such notice as aforesaid shall within three weeks after service of the petition upon him lodge as hereinafter provided two copies and serve upon the petitioner one copy and lodge with the Solicitor to the Board of Trade three copies in writing of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.
- (m) Any person who shall not within the said three weeks lodge and serve such particulars of objections as aforesaid shall be deemed to have abandoned his opposition.
- (n) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.
- (o) Any person who has lodged notice that he intends to oppose the granting of the prayer of the petition shall be entitled to be heard on the application to fix the appointed day, and every person who has lodged and served particulars of objection shall be served by the petitioner with notice of the appointed day.
- (p) The petition shall not be entered in the list for trial until the expiration of the time limited for the lodging and service of the particulars of objections, and shall only be entered for trial on the lodging of an affidavit on behalf of the petitioner that all persons who have served him with notice of intention to oppose the prayer of his petition have been served with

copies of the petition. The petition shall, if and so long as the Court is a Judge of the Chancery Division and subject to any direction of the Court to the contrary be set down in the same manner as if it had been a witness action assigned to that Judge and shall be marked in the witness list not before the

of 19 being the appointed day.

- (q) Any persons who have delivered particulars of objections shall be entitled, at their own expense, to obtain from the petitioner copies of the accounts which have been lodged by him.
  - (r) All petitions, documents, and copies by this Rule required to be lodged shall if and so long as the Court is a Judge of the Chancery Division be lodged at the Chambers of the Judge, and subject as aforesaid shall be lodged with such person and at such place as the Court may from time to time direct.
  - (s) The Court may excuse petitioners and opponents from compliance with any of the requirements of this Rule and may give such directions in matters of procedure and practice as it shall consider to be just and expedient.
  - (t) The Comptroller if he elects or is directed to appear on the question of granting the prayer of any petition shall not be required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Court.
  - (u) The Court may in cases where opposition has been entered to the prayer of a petition give costs to or against such opponents.
  - (v) In the event of the Court refusing the prayer of the petition the Court shall not except under special circumstances give more than one set of costs amongst all the opponents.
  - (w) Revoked by R. S. C. (No. 2) 1933.
  - (x) Service of any document requiring service under this Rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.
4. (a) The originating summons for the extension of any Letters Patent under Section 18(6) of the principal Act shall be intitled in the Matter of the Patents and Designs Acts, 1907 to 1932, and in the Matter of the Letters Patent in question and shall name the Comptroller as a respondent and shall be served on the Solicitor to the Board of Trade and shall so long as the Court is a Judge of the Chancery Division be marked with the name of that Judge.
- (b) At least seven days before the day on which the originating summons is returnable the applicant shall file and serve on the Solicitor to the Board of Trade an affidavit stating all material facts on which the applicant relies. Such affidavit shall in particular state facts sufficient to show the district or districts wherein advertisements of the intended hearing of the summons should appear.
  - (c) On the return of the summons or on any adjournment thereof caused by the insufficiency of the applicant's evidence to comply with the requirements aforesaid or otherwise directions shall be given for public advertisement of the application which shall include unless the Judge in Chambers shall otherwise specially direct at least one advertisement in the "London Gazette" and one advertisement either in some London daily newspaper if the applicant's principal place of business in the United Kingdom is situated within 15 miles of Charing Cross or if such principal place of business in the United Kingdom is outside that distance then in some local newspaper published or circulating in the town or district in which such place of business is situated. And thereupon the summons shall be adjourned to a day (hereinafter called the appointed day) not

being less than four weeks from the estimated date of the forthcoming appearance of the advertisement in the "London Gazette."

- (d) The form of advertisement shall be approved by the Judge in Chambers and shall state the object of the application and name the day fixed as the appointed day. Every such advertisement shall also state an address for service on the applicant of any document requiring service under this Rule and shall also give notice that notices of objection must be lodged as hereinafter provided at least seven days before the appointed day. A copy of such advertisement shall be served by the applicant on the Solicitor to the Board of Trade at the same time that the advertisement is sent to the "London Gazette" and the Solicitor to the Board of Trade shall thereupon cause such advertisement to be inserted in the two following issues of the Official Journal (Patents).
- (e) Except with the leave of the Judge in Chambers no affidavit shall be filed by the applicant between the appearance of his advertisement in the "London Gazette" as aforesaid and the appointed day other than an affidavit or affidavits to prove compliance with the directions given as to advertisement.
- (f) Any person desirous of opposing the relief sought by the originating summons shall at least seven days before the appointed day lodge at the Chambers of the Judge a notice stating that he intends so to oppose and giving an address within the United Kingdom for service of any document requiring service under this Rule. Such person shall at the same time serve upon the applicant and upon the Solicitor to the Board of Trade a copy of such notice. After lodgment of such notice the opponent shall be entitled to be supplied on the usual terms with copies of the originating summons and of any affidavit filed by the applicant in support.
- (g) Upon the appointed day and on any adjournment directions shall be given for the delivery by any opponent of particulars of objection and for the filing of any affidavits and the matter shall in general proceed and be heard and dealt with in the like manner as an originating summons in the Chancery Division in which the applicant is plaintiff and the Comptroller and any opponents are defendants.
- (h) The Court may excuse applicants and opponents from compliance with any of the requirements of these Rules and may give such directions in matters of procedure and practice as it shall consider to be just and expedient.
- (i) The Comptroller if he elects or is directed to appear upon the question of the relief sought by the originating summons shall not be required to give notice of the grounds of any objection he may think fit to take or of any evidence he may think fit to place before the Court.
- (j) The Court may in cases where opposition has been entered to the relief sought by the originating summons give costs to or against the opponents.
- (k) In the event of the Court refusing the relief sought by the originating summons the Court shall not except under special circumstances give more than one set of costs amongst all the opponents.
- (l) Revoked by R. S. C. (No. 2), 1933.
- (m) Service of any document requiring service under this Rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.
- (n) In the event of any person desiring to obtain relief under Section 18(6) of the principal Act together with relief under sub-section (1) of that Section it shall not be necessary for him

to take out a separate originating summons but he shall be at liberty to make a combined application by a petition. And in that event his application shall conform to and be regulated by Rule 3 of this Order and not by the foregoing paragraphs of this Rule.

5. (a) All appeals to the Court from any decision of the Comptroller under Sections 20, 21, 24, 26, 27, 37 and 38A of the principal Act or from the decision of the arbitrator under Section 27(12) of the principal Act shall be brought by petition presented to the Court within one calendar month of the decision of the Comptroller or the arbitrator as the case may be or within such further time as the Court may under special circumstances allow. A copy of the petition shall be served by the appellant upon the Comptroller and upon any other person interested. Each such petition shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision. It shall also state concisely the grounds of the appeal, and no grounds, other than those so stated, shall, except with the leave of the Court, be given on such terms and conditions as may seem just, be allowed to be taken by the appellant at the hearing.

(b) Every such appeal shall, if and so long as the Court is a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such Judge and be heard and disposed of in due course.

(c) In all proceedings before the Court under the said Sections of the principal Act, the evidence used shall be the same as that used at the hearing before the Comptroller or the arbitrator as the case may be, and no further evidence shall be given except by the leave of the Court on application to be made to the Court at or before the hearing.

6. In all proceedings before the Court under the principal Act the Court shall have all the powers by the principal Act vested in the Comptroller and may make any order which might, or ought to, have been made by the Comptroller.

7. In all proceedings before the Court under the principal Act the costs of and incident thereto, and also the costs of hearings before the Comptroller, shall be in the discretion of the Court.

8. If a defendant in an action for infringement of a patent intends to rely as a defence to such action on the insertion by the patentee in any contract or contracts of any condition which by virtue of Section 38 of the principal Act, is null and void, he shall deliver with his defence full particulars of the dates and parties to all contracts on which he intends to rely as containing any such condition, and of the particular conditions in any such contracts on which he intends to rely as being by virtue of that Section null and void, and save as appears from such particulars, no defence shall be available to him in such action under sub-section (4) of that Section. Provided that particulars delivered under this Rule may be from time to time amended by leave of the Court.

9. Any person presenting a petition for the revocation of a patent under Section 25 of the principal Act must deliver with his petition particulars of the objections to the validity of the patent on which he means to rely and no evidence shall, except by leave of the Court, be admitted in proof of any objection of which particulars are not so delivered.

10. The respondent to a petition for the revocation of a patent under Section 25 of the principal Act shall be entitled to begin and give evidence in support of the patent and if the petitioner gives evidence impeaching the validity of the patent the respondent shall be entitled to reply.

11. In an action for infringement of a patent the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.

12. In an action for infringement of a patent the defendant if he disputes the validity of the patent must deliver with his defence, particulars of the objections on which he relies in support of such invalidity.

13. A defendant in an action for infringement of a patent who under Section 32 of the principal Act counterclaims in the action for the revocation of the patent shall with his counterclaim deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim.

14. Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed and shall give at least one instance of each type of infringement of which complaint is made.

15. Particulars of objections (whether delivered with the defence in an action for infringement of patent or with a petition for revocation under Section 25 of the principal Act or with a counterclaim for revocation under Section 32 of the principal Act) must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise.

16. If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the persons or person who are alleged to have made such prior user and whether such prior user is alleged to have continued down to the date of the patent, and if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected.

No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.

17. Particulars of breaches and particulars of objection may from time to time be amended by leave of the Court upon such terms as may be just.

18. Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court.

19. At the hearing of any action, petition or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.

20. On taxation of costs in any action or counterclaim for infringement of patent or in any petition for revocation of a patent under Section 25 of the principal Act or in any counterclaim for revocation of a patent under Section 32 of the principal Act, the following provision shall apply, that is to say:—

If the action, petition or counterclaim proceeds to trial on any patent, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objections and relating to that patent to the parties delivering the same, respectively, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper without regard to the general costs of the case, but subject as aforesaid the cost of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the Taxing Master.

21. Where an application is made by a patentee for leave to amend his specification by way of disclaimer under Section 22 of the principal Act, the following provisions shall apply:—

(a) The application shall be made by motion in the proceedings pending before the Court, and notice of such motion together with a copy of the specification certified by the Comptroller showing in red ink the amendment proposed to be made shall be served on the parties to such proceedings, and in the first instance upon such parties only.

- (b) On the hearing of such motion the Court shall decide whether and on what terms as to costs or otherwise the application shall be allowed to proceed, and if the application be allowed to proceed, shall give directions as to whether such application shall be heard on oral or affidavit evidence and if on affidavit evidence shall fix the times within which affidavits shall be filed by the parties, respectively, and by any other person entitled to be heard under the principal Act or these Rules.
- (c) If the application be allowed to proceed the applicant shall forthwith serve the Comptroller with a copy of the notice of motion together with such copy specification as aforesaid and also an office copy of the order allowing the application to proceed, and also with the name and address of the applicant's solicitor, and the proposed amendment shall be advertised in the Official Journal (Patents), such advertisement stating that any person desiring to oppose the amendment must within fourteen days of the issue of the advertisement give notice in writing of such desire to the applicant's solicitor, whose name and address for that purpose shall be also stated in the advertisement. Any person giving such notice shall be entitled to be heard upon the hearing of the motion.
- (d) Within seven days after the receipt of any such notice the applicant shall, if the person giving such notice shall have stated therein an address for service within the United Kingdom, serve on such person a copy of the notice of motion together with such copy of the specification as aforesaid, and also a copy of the order allowing the application to proceed. Such service may be made by prepaid registered letter sent to such person through the post at his address for service.
- (e) In the case of an application directed to be heard on oral evidence the applicant shall as soon as he shall have complied with the requirements of the preceding Rules set the same down for hearing in the witness list and in the case of an application directed to be heard on affidavit evidence the applicant shall after such compliance as aforesaid and after the times fixed for filing evidence have expired set the same down for hearing in the non-witness list and the application so set down shall be heard and disposed of in due course.
- (f) Where the Court allows a specification to be amended the applicant shall forthwith lodge with the Comptroller an office copy of the order allowing such amendment, and the Comptroller shall advertise the same once at least in the Official Journal (Patents). The applicant shall also if required so to do by the Court or by the Comptroller leave at the Patent Office a new specification and drawings as amended, the same being prepared as far may be in accordance with the Rules of the Patent Office for the time being in force.

21A. (1) The plaintiff in an action for infringement of a patent so soon as he becomes entitled to give notice of trial shall and the defendant in such an action if the plaintiff makes default under this Rule for fourteen days may apply under Rule 1(c) or Rule 5 of Order XXX for directions as to the mode of trial. Such application may be dealt with in Chambers or in Court as the Judge shall think fit. Upon any such application such directions for the delivery of further pleadings or particulars or statements in the nature of further pleadings or particulars and for the making of experiments, tests or inspections for the purposes of the trial, and for obtaining reports and for the hearing of any preliminary question that may arise and otherwise may be given as the Court or the Judge shall think necessary or expedient for the purposes of (a) determining any question of construction which may arise on the specification, (b) defining, limiting or directing the issues of fact to be tried, (c) restricting the number of witnesses to be called at the trial on any particular issue, and (d) otherwise securing that the trial shall be conducted

consistently with adequate hearing in the most expeditious manner. No action for infringement of a patent shall be set down for trial unless and until an application under this Rule has been made and disposed of.

(2) The like provisions shall apply *mutatis mutandis* to petitions for the revocation of a patent, and no such petition shall be heard unless and until an application under this Rule has been made and disposed of.

22. All references of disputes to the Court under Section 29 of the principal Act are hereby assigned to the Chancery Division and shall be commenced by originating notice of motion to which the provisions of Order V, Rule 9(c), shall apply. Where the application is by a patentee or by a proprietor of a registered design the notice of motion shall be addressed to the Government Department or Departments concerned and shall be served on the Treasury Solicitor. Where the application is by a Government Department it shall be served on the patentee or on the proprietor of the registered design as the case may be and may be made through the Treasury Solicitor or through the Solicitor of the Department and in the latter case shall be forthwith notified to the Treasury Solicitor, unless the Judge shall give special leave to the contrary. There shall be at least ten clear days between the service of a notice of motion under this Rule and the day named in the notice for hearing the motion.

[There are in India no special provisions in the nature of Rules of Court corresponding to the above, regarding patent suits in India; neither in the Civil Procedure Code itself nor in the respective Rules of any of the three Chartered High Courts.]

**APPENDIX IV.**  
**REPEALED INDIAN ACTS AND RULES.**



## CONTENTS.

**Note.**--*The Acts which follow have been repealed. They are set out here for purposes of historical reference.*

### **Repealed Acts:--**

1. Act No. VI of 1856. (An Act for granting exclusive privileges to Inventors.)
2. Act No. IX of 1857.
3. Act No. XV of 1859. (An Act for granting exclusive privileges to Inventors.)
4. Act No. XIII of 1872. (An Act to amend Act XV of 1859.)
5. Act No. XVI of 1883. (An Act for the protection of Inventions exhibited in the Exhibitions of India.)
6. Act No. V of 1888. (The Inventions and Designs Act, 1888. An Act to consolidate and amend the law relating to the Protection of Inventions and Designs.)

### **Repealed Rules:—**

7. Indian Patents and Designs Rules, 1912. (This set of Rules was published in Part II of the "Gazette of India," dated 23rd September, 1911, at page 1441. They came into effect on 1st January, 1912. They were repealed by Rule 68 of the current Indian Patents and Designs Rules of 1933: for which see Appendix No. V.)

**ACT NO. VI OF 1856.**

(Received the assent of the Governor-General on the 28th February, 1856.)

**Note.**—*The following is a summary of the provisions contained in Act VI of 1856, see Theobald's Legislative Acts of the Governor-General of India in Council (1863 Edn.) Vol. II, at page 397.*

Recites expediency of privileges to inventors of new manufactures.

1. Inventor to petition Governor-General-in-Council for leave to file specification: form of petition.

2. Governor-General-in-Council may give leave.

3. And may, before doing so, refer to any person for enquiry, such person to be entitled to fee.

4. Inventor, his executors, etc., and those authorized by him, upon his filing specification within six months after leave given, entitled exclusively to make, sell and use invention in India for fourteen years; and for such further term as (on petition presented in manner directed) Governor-General-in-Council may grant.

5. Orders of Governor-General-in-Council upon petitions may contain conditions and restrictions.

6. Requisites of specification.

7. Petition and specification how to be filed, to be accompanied by declaration in form specified.

8. Wilful and corrupt false declaration, perjury.

9. Fees to be paid before filing specification.

10. Five copies to be given at time of filing, one of which open for public inspection on payment of one rupee.

11. Petitions and specifications to be recorded in book.

12. Which book to public on payment of one rupee, and certified copies of entries to be furnished if paid for.

13. Such certified copies *prima facie* proof.

14. Exclusive privilege void, if invention not new, or if petitioner not inventor, or if specification not precise as to the invention and manner of execution.

15. Power to Governor-General-in-Council to put an end to privileges granted, if considered mischievous to State or prejudicial to public. If proved to H. M.'s Court that condition under which specification filed, or further term granted, broken, Governor-General-in-Council may declare privileges at an end.

16. Importer to be deemed an inventor, but privilege to cease unless the invention put in practice within two years from date of petition and continue to be in use or available.

17. Foreigner may petition.

18. Invention a new one, if not publicly used in India or made public in print. Knowledge fraudulently obtained, or published, not to prevent invention being new under this Act, if not acquiesced in by inventor, and leave to file specification be applied for within six months of being so used or known. Use by inventor or by his authority, not to public use.

19. Patentee in United Kingdom may petition within six months of date of British patent, if invention not known in India at date of letters patent although known or used afterwards; and on grant of privilege by Governor-General-in-Council all exclusive privilege, previously obtained by importer, to cease, provided petition recite particulars of British patent.

20. No person who has used an invention prior to 7th July, 1855, can be excluded.

21. Action for infringement, and where to be brought.

22. How such action may and may not be defended.

23. Rule *nisi* may be obtained in H. M.'s Court to declare privilege not in conformity with this Act, upon six objections specified.

24. Like applications as to part of an invention, for the objections specified.

25. Advocate-General entitled to Rule *nisi* to try any fact on which revocation of exclusive privilege may depend by an issue. Subsequent proceedings.

26. Notice of proceeding under three last sections to be served on all persons apparently interested and on no other.

27. Issue upon any question of fact arising under Sections 23, 24, 25, may be directed by the Court to any Court of H. M. or any principal Civil Court of East India Co.; such issue to be tried in a summary manner.

28. Court at hearing of application under Sections 23 and 24 may give judgment against the privilege, which shall cease.

29. Certain defects in specification not to be fatal to the privilege; and may be amended by the Court if so doing, no injury to the public.

30. Misdescription not to vitiate, unless fraudulent.

31. Upon judgment against privilege, Secretary to make entry accordingly in book of registry.

32. Upon proof before H. M.'s Court any principal Civil Court of East India Co. within two years from date of petition by an inventor that the latter has fraudulently obtained his privilege, the Court may compel him to assign his privilege and to account for profits.

33. Particulars of infringement of defence, also of objections, in action or application under this Act, must be delivered.

34. Book in Home Secretary's Office (open to inspection without fee) to contain name of person to receive service of Rule or Proceedings, also of names of proprietors and partners in the privilege, service in conformity therewith sufficient.

35. Act not to interfere with Prerogative.

36. Stamp.

37. Interpretation clause.

#### **An Act for granting exclusive privileges to Inventors.**

[*N.B. Repealed by Act IX of 1857, and New Patent Law substituted for it by Act XI of 1859.*]

**ACT IX OF 1857.**

(Received the assent of the Governor-General on the 20th May, 1857.)

[**Note.**—See Theobald's *Legislative Acts of the Governor-General of India in Council* (1868 Edn.) Vol. II, at page 642.]

Recites that the Court of Directors have disallowed Act VI of 1856 and repeals it.

An Act to repeal Act VI of 1856.

**Preamble.**—Whereas the Court of Directors of the East India Company have, in pursuance of the power vested in them by law disallowed Act VI of 1856 and have signified to the Governor-General of India in Council their disallowance thereof, it is enacted as follows:—

1. **Act repealed.**—Act VI of 1856 is hereby repealed.

**ACT XV OF 1859.****Passed by the Legislative Council of India.**

(Received the assent of the Governor-General on the 17th May, 1859.)

**An Act for granting exclusive privileges to Inventors.**

Whereas Act VI of 1856 entitled "An Act for granting exclusive privileges to Inventors," was passed by the Legislative Council of India without the sanction of Her Majesty to the passing thereof having been previously obtained and signified in pursuance of the Statute passed in the seventeenth year of the reign of Her Majesty, entitled "An Act to provide for the Government of India" and whereas Her Majesty's Law Officers having given it as their opinion that the Legislative Council of India was not competent to pass Act VI of 1856 without previously obtaining the sanction of the Crown, and the Court of Directors of the East India Company having in pursuance of the power vested in them by law disallowed Act VI of 1856 and having signified to the Governor-General of India in Council their disallowance thereof, the said Act was repealed by Act IX of 1857; and whereas it is expedient for the encouragement of Inventors of new manufactures, that certain exclusive privileges in their inventions should be granted to them in India, and that exclusive privileges obtained under the said Act should be protected. It is enacted as follows (the sanction of Her Majesty to the passing of this Act having been previously obtained and signified in pursuance of the said Statute):—

**I. Inventor may petition for leave to file specification. Form, etc., of petition.**—The inventor of any new manufacture may petition the Governor-General of India in Council for leave to file a specification thereof. Every such petition shall be in writing in the form or to the effect mentioned in the Schedule hereunto annexed, and shall be signed by the petitioner, or in case the petitioner shall be absent from India, by an authorized agent, and shall state the name, addition, and place of residence of the petitioner, and the nature of the invention.

**II. Order to file specification.**—Upon such petition, the Governor-General of India in Council may make an order authorizing the petitioner to file a specification of the invention.

**III. Power to refer petition for enquiry and report.**—Before making such order, the Governor-General of India in Council may refer the petition to any person or persons for enquiry and report, and such person or persons shall be entitled to a reasonable fee for such enquiry and report to be paid by the petitioner; the amount of such fee, in case of dispute to be settled by a Judge of one of Her Majesty's Courts of Judicature in a summary manner.

**IV. Extension of term of exclusive privilege for fourteen years from the time of filing specification.**—If, within the space of six calendar months from the date of such order, the petitioner cause a specification of his invention to be filed in manner hereinafter mentioned, the petitioner, his executors, administrators, or assigns, shall be entitled to the sole and exclusive privilege of making, selling and using the said invention in India, and of authorizing others so to do, for the term of fourteen years from the time of filing such specification, and for such further term (if any) not exceeding fourteen years from the expiration of the first fourteen years as the Governor-General of India in Council may think fit to direct, upon petition to be presented by such inventor, at any period not more than one year, and not less than six calendar months, before the expiration of the exclusive privilege hereby granted.

**V. Order to file specification may be made subject to conditions.**—An order authorizing the filing of a specification, or for extending the term of such exclusive privilege as aforesaid may be made subject to any such conditions and restrictions as the Governor-General of India in Council may think expedient.

**VI. Specification to be in writing and to describe the invention.**—Every specification of an invention filed under this Act shall be in writing, and shall be signed by the petitioner, and shall particularly describe and ascertain the nature of the said invention in what manner the same is to be performed.

**VII. Petition and specification to be left with Secretary to Government. Petition, etc., to be accompanied by declaration. Date of Delivery to be endorsed on petition.**—Every petition for leave to file a specification and every specification filed under this Act shall be left with the Secretary to the Government of India in the Home Department, and every petition and specification shall be accompanied by a declaration in writing signed by the petitioner in the forms or to the effect mentioned in the Schedule hereto annexed, and if the inventor be absent from India, the petition and specification shall also be accompanied by a declaration signed by the agent who shall present or file the same, to the effect that he verily believes that the declaration purporting to be the declaration of the inventor was signed by him, and that the contents thereof are true, which declaration shall be in the form or to the effect mentioned in the said Schedule. The date of the delivery of every such petition and specification shall be endorsed on the same respectively, and shall also be recorded at the Office of the said Secretary.

**VIII. False statement in declaration punishable as perjury.**—If any person, who shall make a declaration under this Act, shall wilfully and corruptly make any false statement therein, he shall be deemed guilty of perjury, and shall be proceeded against, and upon conviction punished accordingly.

**IX. Specification not to be filed before payment of fees.**—No specification shall be filed until the petitioner shall have paid all fees payable under this Act, including the fees (if any) of the person or persons to whom the petition shall have been referred for enquiry and report.

**X. Copies of specification to be delivered and distributed. To be open to inspection.**—At the time of delivering the specification for the purpose of being filed, the petitioner shall cause to be delivered to the said Secretary five copies thereof, of which—

One shall be sent to and filed by one of the Secretaries to the Government of Bengal;

One shall be sent to and filed by one of the Secretaries to the Government of Fort St. George;

One shall be sent to and filed by one of the Secretaries to the Government of Bombay; and

One shall be sent to and filed by one of the Secretaries to the Government of the North Western Provinces.

A copy of such specification shall be open at all reasonable times at the Office of each of the said Secretaries to public inspection upon payment of a fee of one Rupee.

**XI. Book for the registry of petitions, specifications, etc.**—A book shall be kept in the Office of the said Secretary to the Government of India wherein shall be entered and recorded every such petition and specification and every order made upon such petition or relating to the invention therein mentioned. Every specification shall be numbered according to the order in which it is entered in such book; and a reference shall be made in such book, in the margin of the entry of each specification to every order relating to the invention, and to every petition, memorandum, or amended specification which shall be filed under the provisions of Section XIV.

**XII. Inspection of registry book. Certified copy of entry to be given.**—Such book or a copy thereof shall be open at all convenient times for the inspection of any person upon payment of a fee of one Rupee; and the said Secretary shall cause a copy of any entry therein, certified under his hand, to be given to any person requiring the same, on payment of the expenses of copying.

**XIII. Certified copy to be prima facie evidence.**—Every such certified copy shall be prima facie evidence of the document of which it purports to be a copy.

**XIV. In what cases petitioner may apply for leave to file amended specification. Effect of amended specification.**—If, after the filing of the specification, the petitioner shall have reason to believe that through mistake or inadvertence he has erroneously made any mis-statement in his petition or specification, or included therein something which at the date of his petition was not new or whereof he was not the inventor, or that such specification is in any particular

defective or insufficient, he may petition the Governor-General-in-Council for leave to file a memorandum pointing out such error, defect, or insufficiency, and disclaiming any part of the alleged invention, or, in case of any defect or insufficiency of the specification, for leave to file an amended specification. The petition shall state how the error, defect, or insufficiency occurred and that it was not fraudulently intended, and shall be accompanied by a declaration in writing signed by the petitioner, and if he be absent from India by his agent, stating that the contents of such petition are true to the best of his knowledge and belief. Upon such petition the Governor-General-in-Council may make an order allowing such memorandum or amended specification to be filed. All the provisions of Sections X, XI, XII and XIII, applicable to specifications, shall be applicable to the petitions, orders, and memoranda or amended specifications referred to in this Section. An amended specification filed under the provisions of this Act shall, except as to suits or proceedings relating to the exclusive privilege which shall be pending at the time of the filing of such amended specification, have the same effect as if it had been the specification first filed, provided that nothing contained in an amended specification shall extend or enlarge any exclusive privilege before acquired.

**XV. No person entitled to exclusive privilege in any of the following cases.**—No person shall be entitled to any exclusive privilege under the provisions of this Act.

If the invention is of no utility; or

If the invention, at the time of presenting the petition for leave to file the specification, was not a new invention within the meaning of this Act; or

If the petitioner is not the inventor thereof; or

If the specification filed or the amended specification (if any) does not particularly describe and ascertain the nature of the invention and in what manner the same is to be performed; or

If the original or any subsequent petition relating to the invention or the original or any amended specification contain a wilful or fraudulent mis-statement.

**XVI. Exclusive privilege to cease if Government declare it mischievous, etc., to public.** Or if Government, upon breach of condition proved, declare that it shall cease.—Every exclusive privilege under this Act shall cease if the Governor-General-in-Council shall declare that the same, or the mode in which it is exercised, is mischievous to the State, or generally prejudicial to the public; or if a breach of any special condition on which the petitioner shall be authorized to file a specification, or upon which the term of the exclusive privilege shall be extended, shall be proved to the satisfaction of any of Her Majesty's Courts of Judicature, and if the Governor-General of India in Council shall thereupon declare that such exclusive privilege shall cease.

**XVII. Importer of invention, if not the actual inventor, not to be deemed inventor.**—The importer into India of a new invention shall not be deemed an inventor within the meaning of this Act, unless he be the actual inventor.

**XVIII. Foreign inventor.**—A foreigner, whether resident abroad or not may petition for leave to file a specification under this Act.

**XIX. An invention not publicly used or known in the United Kingdom or in India before the application for leave to file a specification, to be deemed a new invention within this Act.**—An invention shall be deemed a new invention within the meaning of this Act, if it shall not, before the time of applying for leave to file the specification, have been publicly used in India or in any part of the United Kingdom of Great Britain and Ireland, or been made publicly known in any part of India or of the United Kingdom by means of a publication, either printed or written or partly printed and partly written.

**Knowledge of invention fraudulently acquired.**—The public use or knowledge of an invention, prior to the application for leave to file a specification, shall not be deemed a public use or knowledge within the meaning of this Section, if the knowledge shall have been obtained surreptitiously or in fraud of the inventor, or shall have been communicated to the public in fraud of the inventor, or in breach of confidence.

**Proviso.**—Provided the inventor shall, within six calendar months after the commencement of such public use, apply for leave to file his specification,

and shall not previously have acquiesced in such public use; provided also that the use of an invention in public by the inventor thereof, or by his servants or agents or by any other person by his licence in writing for a period not exceeding one year prior to the date of his petition, shall not be deemed a public use thereof within the meaning of this Act.

**XX. Inventor having obtained English Letters Patent, to petition within twelve months from the passing of this Act or from the date of the Letters Patent. Invention, if not publicly known or used in India at the time of applying for such Letters Patent, to be deemed new. What to be stated in such petition. Duration of exclusive privilege.**—If an inventor who, prior to the time of applying for leave to file a specification of an invention under this Act, shall have obtained Her Majesty's Letters Patent for the exclusive use of such invention in the United Kingdom or any part thereof shall, within twelve calendar months from the passing of this Act, or within twelve calendar months from the date of such Letters Patent, petition the Governor-General of India in Council for leave to file a specification of such invention (which petition shall be in writing in the form or to the effect mentioned in the Schedule), the invention shall be deemed a new invention within the meaning of this Act, if it was not publicly known or used in India at or before the date of the petition for such Letters Patent notwithstanding it may have been publicly known or used in some part of the United Kingdom or in India before the time of his petitioning, under this Act, for leave to file the specification. Provided the petition for leave to file the specification shall state that such Letters Patent have been granted, and shall also state the date thereof and the term during which the same are to continue in force. Provided also that an exclusive privilege obtained under the provisions of this Act, by an inventor who has obtained Her Majesty's Letters Patent for the exclusive use of such invention, shall cease to have effect, if such Letters Patent be revoked or cancelled; and that no such exclusive privileges shall extend beyond the term granted by such Letters Patent unless the same shall be renewed, in which case the exclusive privileges may be renewed under this Act for the extended term or any part thereof.

**XXI. Saving of rights of persons who used invention before 7th of July 1855.**—No exclusive privilege obtained under this Act shall entitle the owner of such privilege to exclude any person from using the invention, who, prior to the 7th day of July 1855, used the same in India.

**XXII. Action for infringement.**—An action may be maintained by an inventor against any person who, during the continuance of any exclusive privilege granted by this Act, shall without the licence of the said inventor, make, use, sell, or put in practice the said invention, or who shall counterfeit or imitate the same. Provided that no such action shall be maintained in any Court other than the principal Court of original jurisdiction in Civil cases within the local limits of whose jurisdiction the cause of action shall accrue or the defendant shall reside as a fixed inhabitant.

**XXIII. Defect in specification or petition, or want of novelty in invention, etc., no defence to action for infringement. The actual use of an invention in India or the United Kingdom before date of petition a defence to such action.**—No such action shall be defended upon the ground of any defect or insufficiency of the specification of the invention, nor upon the ground that the original or any subsequent petition relating to the invention or the original or any amended specification contains a wilful or fraudulent mis-statement, nor upon the ground that the invention is not useful nor shall such action be defended upon the ground that the plaintiff was not the inventor unless the defendant shall show that he is the actual inventor or has obtained a right from him to use the invention either wholly or in part. Any such action may be defended upon the ground that the invention was not new, if the person making the defence, or some person through whom he claims, shall, before the date of the petition for leave to file the specification, have publicly or actually used in India or in some part of the United Kingdom, the invention, or that part of it of which the infringement shall be proved; but not otherwise.

**XXIV. Invention of no utility. Invention not new. Petitioner not the inventor. Invention not described in specification. Fraud in Petition or specification, Fraudulent mis-statement in petition or specification. Insufficient**



**description of part of invention in specification.**—It shall be lawful for any person to apply by motion to any of Her Majesty's Courts of Judicature for a rule to show cause why the Court should not declare that an exclusive privilege in respect of an invention has not been acquired under the provisions of this Act by reason of all or any of the objections following (to be specified in the rule) that is to say—

That the said invention is of no utility; or

That the said invention was not, at the time of presenting petition for leave to file the specification, a new invention within the meaning of this Act; or

That the petitioner was not the inventor thereof; or

That the specification filed or the amended specification (if any) does not particularly describe and ascertain the nature of the invention or in what manner the same is to be performed; or

That the petitioner has knowingly or fraudulently included in the petition or specification or amended specification, as part of his invention, something which was not new or whereof he was not the inventor; or

That the original or any subsequent petition relating to the invention, or the original or any amended specification contains a wilful or fraudulent mis-statement; or

That some part of the invention, or the manner in which that part is to be performed as described in the specification filed or the amended specification, is not thereby sufficiently described and ascertained, and that such defect or insufficiency was fraudulent and is injurious to the public.

**XXV. Like application as to part of an invention.**—Any person may, in like manner, apply to any of Her Majesty's Courts of Judicature for a rule to show cause why the Court should not declare that an exclusive privilege has not been acquired under the provisions of this Act in respect of any part of the invention to be specified in the rule by reason of all or any of the objections following (to be specified in the rule) that is to say—

That such part of the invention is wholly distinct from the other part thereof and is of no utility; or

That such part of the invention was not, at the date of the petition for leave to file the specification, a new invention within the meaning of this Act; or

That the petitioner was not the inventor of that part of the invention; or

That that part of the invention, and the manner in which it is to be performed, is not sufficiently described and ascertained in the specification filed or the amended specification, and that such defect or insufficiency is injurious to the public.

**XXVI. Application by Advocate-General on breach of special condition.**—It shall be lawful for the Advocate-General at any of the Presidencies of Fort William in Bengal, Fort St. George, and Bombay, or any other person, by order of the Governor-General-in-Council, to apply to any of the said Courts of Judicature for a rule calling upon the petitioner, his executors, administrators, or assigns, to show cause why the question of the breach of any special condition upon which the leave to file a specification has been granted, or any other question of fact on which the revocation of the exclusive privilege by the Governor-General-in-Council under the power hereinbefore reserved may, in the judgment of the said Governor-General-in-Council, depend, should not be tried in the form of an issue directed by the said Court; and if the rule be made absolute, the Court, unless the breach or other matter of fact be admitted, may thereupon direct such issue to be tried, and certify the result of such trial to the Governor-General-in-Council. The costs of such trial, and also the costs of any proceedings in any of the said Courts of Judicature under the provisions of this Act, shall be in the discretion of the Court.

**XXVII. Service of proceedings on all persons interested.**—Notice of any rule obtained or proceeding taken under either of the last three preceding Sections shall be served on all persons appearing to be proprietors or to have shares or interests in the exclusive privilege under the provisions of Section XXXV of this Act, and it shall not be necessary to serve such notice on any other persons,

**XXVIII. Supreme Court may direct issue for trial to other Courts. New trial.**—Any of the said Courts of Judicature, if it think fit, may direct an issue for the trial, before the same Court or any other Court of Judicature or any principal Court of original jurisdiction in Civil cases, of any question of fact arising upon an application under Section XXIV, XXV, or XXVI of this Act, and such issue shall be tried accordingly in a summary manner, and, if the issue be directed to another Court, the finding shall be certified by the Court before which the same was tried, to the Court directing the issue.

If the issue be directed to any Court of Judicature, the Court by which the issue is tried may, before the finding is certified, direct a new trial of such issue according to the usual course and practice of such Court. If the issue be directed to any Court other than a Court of Judicature, the finding shall not be subject to appeal, but the evidence taken upon the trial shall be recorded and a copy thereof, certified by the Judge, shall be transmitted, together with any remarks he may think fit to make thereon, to the Court by which the issue was directed; and such Court may either act upon the decision of the Court which tried the issue, or direct a new trial if it shall appear necessary.

**XXIX. Costs.**—If it shall appear to any of the said Courts of Judicature at the hearing of any application under the provisions of Section XXIV or XXV of this Act that, by reason of any of the objections therein mentioned, the said exclusive privilege in the invention or in any part thereof has not been acquired, the Court shall give judgment accordingly, and shall make such order as to the costs of and consequent upon the application as it may think just; and thereupon the petitioner, his executors, administrators, and assigns shall so long as the judgment continues in force, cease to be entitled to such exclusive privilege.

**XXX. Amendment of specification by Court.**—If the Court, at the hearing of any such application as last aforesaid, shall think that the petitioner has, in the description of his invention in the petition or specification (if any) included something which at the date of the petition was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect, or insufficiency was not fraudulently intended, the Court may adjudge the said exclusive privilege to have been acquired and to be valid, save as to the part thereof affected by such error, defect, or insufficiency, or if the Court shall think that the error, defect, or insufficiency can be amended without injury to the public, they may adjudge the exclusive privilege in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be amended in any of the said particulars; and thereupon the petitioner, his executors, administrators, or assigns shall, within the time limited by the said Court for the purpose, file a specification amended according to such order.

Provided that no such amended specification shall have the effect of extending or enlarging the exclusive privilege before acquired.

**XXXI. Mis-statement in the petition, if not fraudulent, not to defeat the privilege.**—An exclusive privilege shall not be defeated upon the ground that the petition contains a mis-statement, unless such mis-statement was wilful or fraudulent.

**XXXII. Entry in registry book of judgment, etc., declaring privilege not to have been acquired.**—Whenever it shall be adjudged by any of the said Courts of Judicature that an exclusive privilege as to the whole or any part of an invention has not been acquired, the said Secretary to the Government of India shall, upon the production of the judgment or order, cause an entry thereof to be made in the said book hereinbefore directed to be kept and shall cause a reference to such entry to be made in the margin of the entry of the specification contained in such book.

**XXXIII. In what case actual inventor entitled to assignment of an exclusive privilege fraudulently obtained.**—If, upon proceedings instituted within two years from the date of a petition to file a specification, the actual inventor shall prove to the satisfaction of the principal Court having jurisdiction in Civil cases within the local limits of whose jurisdiction the defendant shall reside as a fixed inhabitant, that the petitioner was not the actual inventor, and that at the time of the petition he knew or had good reason to believe that the knowledge of the invention was obtained by himself or by some other person

surreptitiously or in fraud of the actual inventor, or by means of a communication made in confidence by the actual inventor to him or to any person through whom he derived such knowledge, the Court may compel the petitioner to assign to the actual inventor any exclusive privilege obtained under this Act and to account for and pay over the profits thereof.

**XXXIV. Particulars to be delivered.**—In any action for the infringement of such exclusive privilege, the plaintiff shall deliver with his plaint particulars of the breaches complained of in the said action; and the defendant shall deliver a written statement of the particulars of the grounds (if any) upon which he means to contend that the plaintiff is not entitled to an exclusive privilege, in the invention. In like manner, upon any application to any of the said Courts of Judicature under Section XXIV, XXV, or XXVI of this Act, the applicant shall deliver particulars of the objections on which he means to rely. At the trial of any such action or issue, no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such exclusive privilege which shall not be contained in the particulars delivered as aforesaid. If it be alleged that the invention was publicly known or used prior to the date of the petition for leave to file such specification, the places where and the manner in which the invention was so publicly known or used shall be stated in such particulars. Provided always that it shall be lawful for any Court in which the action or proceeding is pending, or in which the issue is tried, to allow the plaintiff or defendant respectively to amend the particulars delivered as aforesaid upon such terms as shall seem fit.

**XXXV. Service of proceedings.**—A book shall be kept in the Office of the Secretary to the Government of India in the Home Department (such book to be open to inspection without fee) wherein every person filing a specification under this Act, or any person to whom the exclusive privilege may be assigned, shall cause to be stated some place in India where service of any rule or proceedings for the purpose of cancelling or revoking his exclusive privilege may be made, and shall cause a reference to such entry to be made in the margin of the entry of the specification, and may from time to time cause any other place in India, to be substituted by a similar entry and reference. All such rules and proceedings as aforesaid shall be deemed sufficiently served if a copy thereof be left at the place entered in such book or (if any other place be substituted for the same by entry in the said book) at the place last substituted, by delivering the same to any person resident at or in charge of such place; or if there be no person resident at or in charge of such place, or if such place be not within the local limits of the jurisdiction of the Court, by causing such rule or proceeding to be sent by post by a registered letter directed to such person at such place; and if any such person shall neglect to make or cause to be made such entry, then service of such rule or proceeding may be effected by affixing a copy thereof to some conspicuous part of the Court-house or in such manner as the Court may direct.

**XXXVI. Act VI of 1856 to have effect in respect of certain specifications filed and acts done.**—Act VI of 1856 shall be of the same force and effect in respect to every petition and specification filed under the provisions thereof before the Act was repealed, and in regard to all proceedings consequent thereon or in relation thereto and for the purpose of everything done under that Act while it continued in force, as if previously to the passing of the said Act the sanction of Her Majesty to the passing thereof had been obtained and signified in pursuance of the Statute passed in the seventeenth year of the reign and as if the said Act had not been repealed; and the term of every exclusive privilege obtained under the said Act is hereby extended and shall continue until the expiration of fourteen years from the time of the passing of this Act. No exclusive privilege obtained under the said Act by an importer not being the actual inventor shall cease to have effect by virtue of the provisions of Section XVI of the said Act, if the invention be put in practice in India within the period of two years from the time of the passing of this Act.

**XXXVII. Stamp on petition.**—Every petition for leave to file a specification under the provisions of this Act, or for the extension of the term of an exclusive privilege shall be written on printed or stamped paper of the value of one hundred rupees,

**XXXVIII. Interpretation.**—In the construction of this Act, the following words and expressions shall have the meanings hereby assigned to them, unless there be something in the subject or context repugnant to such construction.

**Number.**—Words importing the singular number shall include the plural number, and words importing the plural number shall include the singular number.

**Gender.**—Words importing the masculine gender shall include females.

**"Invention."**—The word "invention" shall include an improvement.

**"Manufacture."**—The word "manufacture" shall be deemed to include any art, process, or manner of producing, preparing, or making an article, and also any article prepared or produced by manufacture.

**"Printed."**—The word "printed" shall include "lithographed."

**"Inventor" and "actual inventor."**—The words "inventor" and "actual inventor" shall include the executors, administrators, or assigns of an inventor or actual inventor as the case may be.

**"Assigns."**—The word "assigns" shall include grantees of the sole use or benefit in India of an invention or of the sole use of an exclusive privilege for a limited time.

**"India."**—The word "India" shall mean the territories which are or may become vested in Her Majesty by the Statutes 21 and 22 Vic. c. 106, entitled "An Act for the better Government of India."

**"Governor-General-in-Council."**—The words "Governor-General-in-Council" shall include the "President in Council."

**"Secretary to the Government of India."**—The words "Secretary to the Government of India" shall include any Under Secretary to the said Government.

**"Her Majesty's Courts of Judicature." "Courts of Judicature."**—The expressions "Her Majesty's Courts of Judicature" and "Courts of Judicature" shall mean the Courts established by Royal Charter.

#### SCHEDULE OF FORMS.

##### Form of Petition (See Section 1).

To The Governor-General of India in Council.

The Petition of (here insert name, addition, and place of residence) for leave to file a specification under Act No. XV of 1859).

Sheweth,

That your Petitioner is in possession of an invention for (state the title of the invention) which invention he believes will be of public utility; that he is the inventor thereof (or, as the case may be, the assignee or the executor or administrator of the inventor) and that the same is not publicly known or used in India, or in any part of the United Kingdom of Great Britain and Ireland to the best of his knowledge and belief.

The following is a description of the invention (here describe it).

Your Petitioner therefore prays for leave to file a specification of the said invention pursuant to the provisions of Act No. XV of 1859.

And your Petitioner, etc.,

(Signed)

The day of

**Form of Declaration to Accompany Petition (See Section VII.)**

I (here insert name, addition, and place of residence) do solemnly and sincerely declare that I am in possession of an invention for (state the title of the invention as in the petition); that I believe the said invention will be of public utility; that I am the inventor thereof (or, as the case may be, the assignee or executor or administrator of the inventor) and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland to the best of my knowledge and belief; and that, to the best of my knowledge and belief, my said invention is truly described in my petition for leave to file a specification thereof.

(Signed)

The                      day of

**Form of Declaration to Accompany Specification (See Section VII).**

I (here insert name, addition, and place of residence) do solemnly and sincerely declare that I am in possession of an invention for (state the nature of the invention) which invention I believe will be of public utility; that I am the inventor thereof (or, as the case may be, the assignee or executor or administrator of the inventor) and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland to the best of my knowledge and belief; and that, to the best of my belief, the instrument in writing under my hand hereunto annexed particularly describes and ascertains the nature of the said invention and in what manner the same is to be performed.

(Signed)

The                      day of

**Form of Declaration by an Agent where an Inventor is absent from India (See Section VII).**

I                      of                      do solemnly and sincerely declare that I have been appointed by the said                      his agent for the purpose of                      ; and I verily believe that the declaration purporting to be the declaration of the said                      marked (                      ) was signed by him, and that the contents thereof are true.

(Signed)

The                      day of

**Form of Petition (See Section XX).**

That your Petitioner (or, as the case may be, that A.B. of whom your Petitioner is the assignee or executor) has obtained Her Majesty's Letters Patent dated the                      day of                      for (state the title of the invention). and that such Letters Patent are to continue in force for                      years. That your Petitioner believes that the said invention is not now and has not hitherto been publicly known or used in India.

The following is a description of the invention (here describe it).

Your Petitioner therefore prays for leave to file a specification of the said invention pursuant to the provisions of Act No. XV of 1859.

And your Petitioner, etc.,

(Signed)

The                      day of

**ACT NO. XIII OF 1872.**

**Passed by the Governor-General of India in Council.**

(Received the assent of His Excellency the Governor-General on the 26th April, 1872).

**AN ACT TO AMEND ACT XV OF 1859.**

**Preamble.**—Whereas, by the Act XV of 1859, provision was made for the grant of certain privileges to the inventors of new manufactures; and whereas it is desirable that provision should be made for the grant of similar privileges to the inventors of new patterns and designs in British India; it is hereby enacted as follows:—

1. **Extent. Commencement.**—This Act may be called "The Patterns and Designs Protection Act, 1872": It extends to the whole of British India, and shall come into force on the passing thereof.

2. **Addition to Sec. 1 of Act XV of 1859. "New manufacture" defined.**—At the end of Section I of the said Act XV of 1859, the following shall be read:—"For the purposes of this Act, 'New manufacture' shall be deemed to include any new and original pattern or design, or the application of such pattern or design to any substance or article of manufacture."

3. **Addition to Sec. IV of said Act.**—At the end of Section IV of the said Act, the following shall be read:—"Provided that, in the case of a pattern or design or the application thereof to any substance or article of manufacture, such privilege shall be granted for the term of three years and no more."

4. **Persons invested by English law with rights as to patterns and designs to have same rights in British India.**—After Section XXXVII of the said Act, the following shall be read:—"Whenever, by any law for the time being in force in the United Kingdom, any person entitled in the United Kingdom to an exclusive right in any pattern or design or in the application of such pattern or design to any substance or article of manufacture, such person shall be entitled in British India to the sole and exclusive right in such pattern or design, or in such application thereof, and shall be entitled in British India to the same civil remedies in respect of any infringement thereof in British India, as those to which he would be entitled in the United Kingdom in respect of an infringement thereof in the United Kingdom."

5. **Act to be read as part of Act XV 1859.**—This Act shall be read with and as part of the said Act XV of 1859.

**ACT NO. XVI OF 1883.**

**Passed by the Governor-General of India in Council.**

(Received the assent of the Governor-General on the 4th October, 1883.)

**AN ACT FOR THE PROTECTION OF INVENTIONS EXHIBITED  
IN THE EXHIBITIONS OF INDIA.**

Whereas it is expedient that such protection as is hereinafter mentioned should be afforded to the inventors of new manufactures who are desirous of exhibiting them at Exhibitions to be held in India; it is hereby enacted as follows:—

**1. Short Title.**—(1) This Act may be called the Protection of Inventions Act, 1883.

(2) **Commencement.**—And it shall come into force at once.

**2. Act to be read with Act XV of 1859.**—It shall be read with, and taken as part of, Act XV of 1859 (for granting exclusive privileges to inventors).

**3. Inventions exhibited when to be deemed new though publicly used or made publicly known.**—If, within six months from the time of the opening of an Exhibition, a person, being the inventor and exhibitor of any manufacture exhibited at that Exhibition petitions the Governor-General-in-Council under Act XV of 1859, for leave to file a specification of his invention, the circumstance that the invention has at any time after the opening of the Exhibition been publicly used or made publicly known shall not prevent the invention being deemed to have been at the time of presenting the petition a new invention for the purposes of the said Act.

**4. Meaning of term "Exhibition."**—In this Act, "Exhibition" means the International Exhibition to be held in the years one thousand eight hundred and eighty-three and one thousand eight hundred and eighty-four at Calcutta and any Exhibition to be held in India which the Governor-General-in-Council may on the application of any persons desirous of holding the Exhibition by notification in the "Gazette of India," declare to be, in the judgment of the Governor-General-in-Council, calculated to promote Indian art or industry, and to prove beneficial to the mercantile, agricultural or industrial classes of Her Majesty's subjects in India.

**ACT NO. V OF 1888.**

**Passed by the Governor-General of India in Council.**

(Received the assent of the Governor-General on the 16th March, 1888.)

**AN ACT TO CONSOLIDATE AND AMEND THE LAW RELATING TO THE PROTECTION OF INVENTIONS AND DESIGNS.**

Whereas it is expedient to consolidate and amend the law relating to the protection of inventions and designs; It is hereby enacted as follows:—

1. **Title, extent and commencement.**—(1) This Act may be called the Inventions and Designs Act, 1888.

(2) It shall extend to the whole of British India.

(3) It shall come into force on the first day of July 1888.

2. **Repeal.**—(1) The enactments described in the first schedule are hereby repealed to the extent specified in the third column thereof.

(2) But this repeal of enactments shall not affect any exclusive privilege acquired, or any conditions or restrictions imposed with respect to any such privilege, or any right or liability accrued or incurred, under any of those enactments before the commencement of this Act, or any relief in respect of any such privilege, right or liability.

(3) Any enactment or document referring to any enactment hereby repealed shall be construed to refer to this Act or to the corresponding portion thereof.

3. **Division of Act into Parts.**—The remainder of this Act is divided into Parts, as follows:—

**Part I—INVENTIONS.**

**Part II—DESIGNS.**

**PART I.**

**INVENTIONS.**

4. **Definitions.**—In this Part, unless there is something repugnant in the subject or context:—

(1) "Invention" includes an improvement:

(2) "inventor" does not include the importer into British India of a new invention unless he is the actual inventor:

(3) "applicant" means a person who has applied under this Part for leave to file a specification of an invention, whether he has filed the specification or not:

(4) "assign" includes a grantee of the exclusive privilege of making, selling or using an invention, or of authorizing others so to do, during the term for which the privilege is to continue or may be extended, or for any shorter term:

(5) "inventor," "actual inventor" and "Applicant" include the executors, administrators or assigns of an inventor, actual inventor and applicant, as the case may be:

(6) "manufacture" includes any art, process or manner of producing, preparing or making an article and also any article prepared or produced by manufacture:

(7) "write" includes print, lithograph, photograph, engrave, and every other mode in which words or figures can be expressed on paper or on any substance:

(8) "Secretary" means a Secretary to the Government of India appointed by the Governor-General-in-Council to discharge the functions of the Secretary under this Act, and includes any under-secretary, assistant-secretary or other officer subordinate to the Government of India to the extent to which such



officer may be authorized by general or special order of the Governor-General-in-Council to discharge any of those functions:

(9) **XIV of 1882.**—"District Court" has the meaning assigned to that expression by the Code of Civil Procedure: and

(10) **X of 1882.**—"High Court" has the meaning assigned to that expression by the Code of Criminal Procedure, 1882, in reference to proceedings against European British subjects.

**5. Application for leave to file specification.**—(1) The inventor of a new manufacture, whether he is a British subject or not, may apply to the Governor-General-in-Council for leave to file a specification thereof.

(2) The application must be in writing signed by the applicant and in the form or to the effect of the second schedule if the inventor has not obtained a patent in the United Kingdom, and in the form or to the effect of the third schedule if he has obtained a patent in the United Kingdom.

(3) It must state the name, occupation address of the applicant, and, where a patent has been obtained in the United Kingdom, the date of the patent and the date of the actual sealing thereof, and must describe with reasonable precision and detail the nature of the invention, and of the particular novelty whereof it consists, and be supplemented by such further particulars relating to the invention, and by such drawings or photographs illustrative thereof, as the Governor-General-in-Council may see fit to require from the applicant.

(4) If in any case it appears to the Governor-General-in-Council that an application ought to be further supplemented by a model of anything alleged to constitute an invention, he may require the applicant to furnish such a model neatly and substantially made of durable material and of dimensions not exceeding those, if any, specified in the requisition therefor.

**6. Order to file specification.**—(1) Upon an application under the last foregoing Section the Governor-General-in-Council may, after such inquiry as he thinks fit, make an order authorizing the applicant to file a specification of the invention.

(2) Before making an order under sub-section (1), the Governor-General-in-Council may direct that the application be referred for inquiry and report to any person whom he thinks fit.

(3) When such enquiry and report are made by a person who is not in the service of the Government, there shall be payable to that person by the applicant such fee as the Governor-General-in-Council, after considering the report, may determine.

(4) When an application is to be referred to such a person, the applicant shall deposit, in such place and within such time as the Governor-General-in-Council may by rule or otherwise prescribe, such sum as will, in the opinion of the Secretary, be sufficient to defray any fee which is likely to be determined under sub-section (3).

(5) If the sum is not deposited in the place and within the time prescribed, the application may be rejected.

(6) If the fee as determined by the Governor-General-in-Council exceeds the sum so deposited, an order shall not be made under sub-section (1) until the applicant has paid the balance of the fee.

(7) If the sum deposited exceeds the fee so determined, the excess shall be refunded to the applicant.

**7. Applications in respect of contemporaneous inventions.**—(1) If two or more inventors apply on the same day for leave to file specifications of inventions which appear to the Governor-General-in-Council to be identical or so similar as to be practically identical, the Governor-General-in-Council may, in his discretion, authorize both or all the applicants, subject to the other provisions of this Part, to file specifications of their respective inventions.

(2) If they apply on different days for leave to file specifications of such inventions as aforesaid, the applicant who applied on the first of the different days shall be deemed to have preferential claim to an order authorizing the filing of his specification.

**8. Acquisition and continuance of exclusive privilege.**—(1) If within six months from the date of an order under Section 6, sub-section (1), or within such further time, not exceeding three months, as the Governor-General-in-Council, in his discretion, may, on cause shown to his satisfaction and on payment of the fee prescribed in that behalf in the fourth schedule, see fit to allow, the applicant causes a specification of his invention to be filed in manner by this Part required, and the fee prescribed in the fourth schedule in respect of the filing of the specification to be paid, the applicant shall, subject to the other provisions of this Part, be entitled to the exclusive privilege of making, selling and using the invention in British India and of authorizing others so to do, for a term of fourteen years from the date of the filing of the specification.

(2) But an exclusive privilege in respect of an invention of a new manufacture shall, notwithstanding anything in sub-section (1), cease if the inventor fails to pay, within the time limited in that behalf by the fourth schedule, any fee prescribed in that schedule in respect of the continuance of the privilege.

(3) If, nevertheless, in any case, by accident, mistake or inadvertence, an inventor fails to pay any such fee within the time so limited, he may apply to the Governor-General-in-Council for an enlargement of the time for making the payment.

(4) Thereupon the Governor-General-in-Council may enlarge the time accordingly, on payment of the fee prescribed in that behalf in the fourth schedule and subject to the following conditions, namely:—

(a) The time for making a payment shall not in any case be enlarged for more than three months; and

(b) if any suit is instituted in respect of an infringement of exclusive privilege committed after a failure to make a payment within the time limited for the making thereof and before the enlargement of that time, the Court disposing of the suit may, if it thinks fit, refuse to award or give any damages in respect of the infringement.

**9. Form and contents of specification.**—(1) A specification filed under this Part must be in writing signed by the applicant, and must set forth the precise invention in respect of which the applicant claims to become entitled to an exclusive privilege.

(2) If the specification is of an invention which is an improvement only, it must by explicit language distinguish between what is old and what is claimed to be new.

(3) Every specification must explain the principle of the invention set forth therein and the best mode in which the applicant has contemplated applying that principle, and must describe the manner of making and using the invention in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which the invention appertains, or with which it is most closely connected, to make or use the same.

**10. Mode of filing application and specification.**—Every application for leave to file a specification and every specification filed under this Part, must be left with, or sent by post to, the Secretary, and the date of the delivery or receipt thereof shall be endorsed thereon and recorded in his office.

**11. Delivery and distribution of copies of specification.**—(1) At the time of delivering or sending the specification for the purpose of its being filed, the applicant shall cause to be delivered or sent therewith to the Secretary as many copies thereof, not being fewer than four, as may be required by the Rules for the time being in force under this Part.

(2) One of these copies shall be retained by the Secretary, and one shall be sent to the Governor of Fort St. George in Council, one to the Governor of Bombay in Council, one to the Chief Commissioner of Burma, and the others, if any, to such authorities as the Governor-General-in-Council may appoint in this behalf.

(3) The copies of the specification which are sent under sub-section (2) to the authorities mentioned or referred to in that sub-section shall be open to the inspection of any person at all reasonable times at places to be appointed by those authorities.

**12. Register of inventions.**—(1) A book, to be called the register of inventions shall be kept in the office of the Secretary wherein shall be entered and recorded every application for leave to file a specification, every order made on any such application, every specification filed in pursuance thereof, and every subsequent proceeding relating to the invention described therein.

(2) Applications for leave to file a specification shall be numbered consecutively in the order in which they are delivered or received, and be dated as of the day of their delivery or receipt, and shall be entered in the register of inventions in the order of their respective numbers.

(3) A reference shall be made in that register, in the margin of the entry of each application, to every order on or in respect of the application, to the specification, if any, filed in pursuance thereof, and to every subsequent proceeding relating to the invention which forms the subject of the application.

**13. Address-book.**—(1) Another book, to be called the address-book, shall be kept in the office of the Secretary wherein any person filing a specification under this Part, or any person in whom an exclusive privilege acquired under this Part, or any share or interest therein, may become vested, may from time to time cause to be stated some place in British India where notice of any rule or proceeding relating to the exclusive privilege may be served on him.

(2) A reference to each entry in the address-book shall be made in the register of inventions in the margin of the entry in that register of the application for leave to file the specification.

**14. Provisions with respect to the register and book.**—(1) Every entry in the register of inventions or address-book and every document entered and recorded in the register, shall, for the purposes of the law of evidence for the time being in force, be deemed to be a public document and shall be open to the inspection of any person at all reasonable times at the office of the Secretary.

(2) The books kept under Section 11 and Section 35 of Act No. XV of 1859 (an Act for granting exclusive Privileges to Inventors) shall be deemed to be parts of the register of inventions and address-book, respectively.

**15. Extension of exclusive privilege.**—(1) The inventor of a new manufacture may, at any time not more than one year and not less than six months before the time limited for the expiration of an exclusive privilege acquired under Section 8, apply to the Governor-General-in-Council for an extension of the privilege for a further term.

(2) When an application is made under sub-section (1) the Governor-General-in-Council may, if he thinks fit, refer it to a High Court for report.

(3) The Court to which the application is referred shall, in making its report, have regard to the nature and merits of the invention in relation to the public, to the profits made by the inventor as such, and to all the circumstances of the case.

(4) The procedure on the reference shall be such as the Court thinks fit, and may include the issue of citations calling upon persons claiming to have any interest in the reference to appear before the Court on the day on which the reference is to be considered, or on any day to which the consideration thereof may be adjourned, and make with respect thereto any representation which they may see fit in relation to any of the matters to which the Court is required by the last foregoing sub-section to have regard in making its report.

(5) If the Governor-General-in-Council is of opinion or where a reference has been made under sub-section (2), if the Court reports that the inventor has been inadequately remunerated by his exclusive privilege, the Governor-General-in-Council may, on payment of the fee prescribed in that behalf in the fourth schedule, make an order extending the term of the privilege for a further term not exceeding seven or, in exceptional cases, fourteen years from the expiration of the first term of fourteen years.

(6) But an exclusive privilege of which the term has been extended under the last foregoing sub-section shall, notwithstanding anything in that sub-section, cease if the inventor fails to pay before the expiration of each year of such extended term the fee prescribed in the schedule aforesaid in respect of the continuance of the privilege.

**16. Imposition of conditions with respect to exclusive privilege.**—An order under Section 6, sub-section (1), authorizing the filing of a specification, or under Section 15, sub-section (5) extending the term of an exclusive privilege, may be made subject to such conditions as the Governor-General-in-Council thinks expedient.

**17. Exclusive privilege to bind the Government.**—(1) Subject to any conditions imposed under the last foregoing section—

(a) with respect to the filing by a person employed in the service of Her Majesty in India, of the specification of a manufacture invented by him in the course of his employment, or

(b) with respect to the extension, in favour of any person, of the term of an exclusive privilege,

an exclusive privilege acquired under this Part shall have to all intents the like effect as against Her Majesty as it has against a subject.

(2) But the officers or authorities administering any department of the service of Her Majesty may, be themselves their agents, contractors or others, at any time after the delivery or receipt of the application for leave to file the specification of an invention, use the invention for the services of the Government on terms to be before or after the use thereof agreed on, with the approval of the Governor-General in Council between those officers or authorities and the inventor, or, in default of such agreement, on such terms as may be settled by the Governor-General-in-Council.

**18. Application for leave to file memorandum or amended specification.**—

(1) If, after the filing of the specification, the applicant has reason to believe that through mistake or inadvertence he has erroneously made any mis-statement in his application or specification or included therein something which at the date of the delivery or receipt of his application was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, he may apply to the Governor-General-in-Council for leave to file a memorandum pointing out the mis-statement or disclaiming any part of the alleged invention, or for leave to file an amended specification, as the case may be.

(2) The application must be in writing signed by the applicant, and must state how the error, defect or insufficiency occurred and that it was not fraudulently intended.

(3) Upon the application the Governor-General-in-Council may make an order allowing the memorandum or amended specification to be filed.

(4) The provisions of Section 6, with respect to applications, and of Sections 9 and 11 with respect to specifications shall apply, so far as they can be made applicable, and copies thereof, to applications and to amended specifications, respectively, made and filed under this section.

**19. Effect of amended specification.**—An amended specification filed under the last foregoing section shall, except as to any suit or proceeding relating to the exclusive privilege which may be pending at the time of the filing of the amended specification, have the same effect as if it had been the specification first filed:

Provided that nothing in an amended specification shall be construed to extend or enlarge an exclusive privilege before acquired.

**20. Bar to exclusive privilege in certain cases.**—A person shall not be entitled to an exclusive privilege under this Part—

(a) if the invention is of no utility, or

(b) if the invention, at the date, of the delivery or receipt of the application for leave to file the specification thereof, was not a new invention within the meaning of this part, or

(c) if the applicant is not the inventor thereof, or

(d) if the original or any amended specification does not fulfil the requirements of this Part, or

(e) if the original or any subsequent application relating to the invention or the original or any amended specification contains a wilful or fraudulent mis-statement, or

- (f) if the application for leave to file the specification of the invention was made under this Part after the expiration of one year from the date of the acquisition of an exclusive privilege in respect of the invention in any place beyond the limits of British India and the United Kingdom.

**21. Novelty of invention dependent on public use or knowledge thereof before application to file specification.**—An invention shall be deemed a new invention within the meaning of this Part if it has not before the date of the delivery or receipt of the application for leave to file the specification thereof been publicly used in any part of British India or of the United Kingdom, or been made publicly known in any part of British India or of the United Kingdom by means of a written publication.

**22. Effect of public use or knowledge of invention in fraud of invention.**—The public use or knowledge of an invention before the date of the delivery or receipt of the application for leave to file a specification thereof, shall not be deemed a public use or knowledge within the meaning of this Part if the knowledge has been obtained surreptitiously or in fraud of the inventor or has been communicated to the public in fraud of the inventor or in breach of confidence.

Provided that the inventor has not acquiesced in the public use of his invention, and that, within six months after the commencement of that use, he applies for leave to file a specification.

**23. Effect of temporary use of invention in public by inventor or by his leave.**—Use of an invention in public by the inventor thereof or by his servant or agent, or by any other person by his licence in writing for a period not exceeding one year immediately preceding the date of the delivery or receipt of his application for leave to file a specification thereof or knowledge of the invention resulting from such use thereof in public, shall not be deemed a public use or knowledge within the meaning of this Part.

**24. Effect of public use or knowledge of patented invention between application for patent and application to file specification.**—If an inventor who has obtained a patent for his invention in the United Kingdom causes an application for leave to file a specification of the invention under this Part to be delivered or received by the Secretary within twelve months from the date of the actual sealing of the patent, the invention shall be deemed a new invention within the meaning of this Part if it was not publicly used or known in any part of British India at or before the date of the application for the patent notwithstanding that it may have been publicly used or known in some part of British India or of the United Kingdom before the date of the delivery or receipt of the application under this Part for leave to file the specification.

**25. Effect of like public use or knowledge of unpatented invention.**—If an inventor applies for leave to file a specification under this Part while his application for a patent is pending in the United Kingdom, and the interval between the date of his application for the patent and the date of the delivery or receipt of his application under this Part does not exceed twelve months, the invention shall not be deemed to have been publicly used, or made publicly known, within the meaning of this Part, by reason only of the invention having been used, or a description thereof having been published, in any part of British India or of the United Kingdom during the interval.

**26. Effect of public use or knowledge of invention after admission to an exhibition.**—If an inventor, being the exhibitor of his invention at an industrial or international exhibition, certified as such by the Governor-General-in-Council, causes an application for leave to file a specification of the invention to be delivered to or received by the Secretary within six months from the date of the admission of the invention into that exhibition, the invention shall not be deemed to have been publicly used, or made publicly known, within the meaning of this Part, by reason only of the invention having at any time after admission into exhibition been publicly used or made publicly known.

**27. Cessation of exclusive privilege by order of the Government.**—(1) An exclusive privilege acquired under this Part shall cease if the Governor-General-in-Council declares the privilege, or the mode in which it is exercised to be mischievous to the State, or generally prejudicial to the public.

(2) It shall also cease if a breach of any condition on which the applicant was authorized to file a specification, or on which the term of the exclusive privilege was extended, is on an application under this Part to a High Court proved to the satisfaction of that Court, and if the Governor-General-in-Council thereupon declares the privilege to have ceased.

**28. Cessation of exclusive privilege on revocation or expiration of Patent.**—

(1) An exclusive privilege acquired under this Part in respect of an invention for which a patent has been obtained in the United Kingdom shall cease on the revocation or expiration of the patent.

(2) Such a privilege in respect of an invention for which a patent has not been obtained in the United Kingdom shall cease on the revocation or expiration of any patent or exclusive privilege which has been obtained or acquired for or in respect of the invention in any other country.

**29. Suit for infringement of exclusive privilege.**—(1) An inventor may institute a suit in the District Court against any person who, during the continuance of an exclusive privilege acquired by him under this Part in respect of an invention, makes, sells or uses the invention without his licence, or counterfeits or imitates it.

(2) The suit shall not be defended upon the ground of any defect or insufficiency of the specification of the invention or upon the ground that the original or any subsequent application relating to the invention, or the original or any amended specification, contains a wilful or fraudulent mis-statement, or upon the ground that the invention is of no utility:

(3) Nor shall it be defended upon the ground that the plaintiff was not the inventor, unless the defendant shows that he himself is the actual inventor or has obtained from the actual inventor a right to make, sell or use the invention, or imitate it as the case may be:

(4) Nor shall it be defended upon the ground that the invention was not new, unless the defendant, or some person through whom he claims, has, before the date of the delivery or receipt of the application for leave to file the specification, publicly or actually used in some parts of British India or of the United Kingdom the invention or that part of it with respect to which the exclusive privilege is alleged to have been infringed.

**30. Application to declare exclusive privilege in respect of an invention not to have been acquired.**—Any person may apply to a High Court for a rule to show cause why the Court should not declare that an exclusive privilege in respect of an invention to be specified in the rule has not been acquired under this Part by reason of all or any of the objections following (to be specified in the rule), that is to say:—

- (a) that the invention is of no utility, or
- (b) that the invention was not, at the date of the delivery or receipt of the application for leave to file the specification, a new invention within the meaning of this Part, or
- (c) that the applicant was not the inventor thereof, or
- (d) that the original or any amended specification does not fulfil the requirements of this Part, or
- (e) that the applicant has knowingly or fraudulently included in the application for leave to file the specification, or in the original or any amended specification as part of his invention, something which was not new or whereof he was not the inventor, or
- (f) that the original or any subsequent application relating to the invention, or the original or any amended specification contains a wilful or fraudulent mis-statement, or
- (g) that some part of the invention, or the manner in which that part is to be made and used as described in the original or any amended specification, is not thereby sufficiently described, and that this insufficiency was fraudulent and is injurious to the public.

**31. Like application as to part of an invention.**—Any person may apply to a High Court for a rule to show cause why the Court should not declare that an exclusive privilege in respect of any part of an invention to be specified in the rule has not been acquired under this Part, by reason of all or any of the objections following (to be specified in the rule), that is to say:—

- (a) that that part of the invention is wholly distinct from the other parts thereof and is of no utility, or
- (b) that that part of the invention was not, at the date of the delivery of receipt of the application for leave to file the specification, a new invention within the meaning of this Part, or
- (c) that the applicant was not the inventor of that part of the invention, or
- (d) that that part of the invention, or the manner in which it is to be made and used, is not sufficiently described in the original or any amended specification, and that this insufficiency is injurious to the public.

**32. XIV of 1882. Security for costs of application under either of the two last foregoing Sections.**—The High Court may, irrespective of any provisions of the Code of Civil Procedure in this behalf, require a person applying for a rule under either of the two last foregoing Sections to give security for the payment of all costs incurred or likely to be incurred by any person appearing to show cause against the rule.

**33. Application on breach of condition.**—(1) Any person authorized by the Governor-General-in-Council in this behalf may apply to a High Court for a rule to show cause why the question of the breach of any condition on which leave to file a specification has been granted, or any other question of fact on which the cessation of an exclusive privilege under Section 27 may, in the judgment of the Governor-General-in-Council, depend, should not be tried in the form of an issue directed by the Court.

(2) If the rule is made absolute, the Court unless the breach or other matter of fact is admitted, may direct the issue to be tried and certify the result of the trial to the Governor-General-in-Council.

**34. Notice of proceedings to persons interested.**—(1) Notice of any rule obtained or proceeding taken under Section 30, Section 31 or Section 33 shall be served on all persons appearing from the address-book to be proprietors of the exclusive privilege, or to have shares or interests therein, and it shall not be necessary to serve the notice on any other person.

(2) The notice shall be deemed to be sufficiently served if a copy thereof is left at the place for the time being stated in the address-book, by delivering the copy to any person resident at or in charge of the place or, if there is no person resident at or in charge of the place, or if the place is not within the local limits of the jurisdiction of the Court, by causing the notice to be sent to the place by post by a registered letter directed to the person to whom the notice is addressed.

**35. Framing issue for trial before other Court.**—(1) The High Court may, if it thinks fit, direct an issue for the trial, before itself or any other High Court, or any District Court, of any question of fact arising upon an application under Section 30, Section 31 or Section 33, and the issue shall be tried accordingly.

(2) If the issue is directed to another Court, the finding shall be certified by that Court to the Court directing the issue.

(3) If the issue is directed to a District Court, the finding of that Court shall not be subject to appeal, but the evidence taken upon the trial shall be recorded, and a copy thereof, certified by the Judge of the Court, shall be transmitted, together with any remarks which he may think fit, to make thereon, to the High Court, and the High Court may thereupon act upon the finding of the District Court, or dispose of the application upon the evidence recorded, or direct a new trial, as the justice of the case may require.

**36. Order on application.**—(1) If it appears to the High Court at the hearing of an application under Section 30 or Section 31 that by reason of any of the objections specified in the rule, the exclusive privilege in the

invention or in any part thereof has not been acquired, the Court shall make an order accordingly, and thereupon the applicant shall, so long as the Order continues in force, cease to be entitled to the exclusive privilege.

(2) If it appears to the High Court, at the hearing of any such application as last aforesaid, that the applicant has, in the description of his invention in the application for leave to file a specification thereof or in the original or any amended specification, erroneously included something which at the date of the delivery or receipt of the application for leave to file the specification was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect or insufficiency was not fraudulently intended, the Court may adjudge the exclusive privilege to have been acquired and to be valid save as to the part thereof affected by the error, defect or insufficiency: or

(3) If it appears to the High Court that the error, defect or insufficiency can be amended without injury to the public, the Court may adjudge the exclusive privilege in respect of the whole of the invention to be valid, and may, upon such terms as it thinks reasonable, order the specification to be amended in any particular in which it is erroneous, defective or insufficient; and thereupon the applicant shall, within a time to be limited by the Court for the purpose, file in the office of the Secretary a specification amended according to the order.

(4) The provisions of Section 18 with respect to the distribution and disposal of copies of amended specifications and of Section 19 with respect to the effect of such specifications, shall apply, so far as they can be made applicable, to an amended specification filed under this Section.

(5) An exclusive privilege in respect of an invention shall not be defeated upon the ground that the application for leave to file the specification of the invention contains a mis-statement, unless the mis-statement was wilful or fraudulent.

**37. Delivery of particulars.**—(1) In a suit for the infringement of an exclusive privilege acquired under this Part the plaintiff shall deliver with his plaint particulars of the breaches complained of in the suit, and the defendant shall deliver a written statement of the particulars of the grounds, if any, upon which he means to contend that the plaintiff is not entitled to an exclusive privilege in respect of the invention.

(2) In like manner upon an application to a High Court under Section 30, Section 31 or Section 33, the person making the application shall deliver particulars of the objections or grounds on which he means to rely.

(3) At the hearing of any such suit or application, or at the trial of any issue arising out of any such application, evidence shall not be allowed to be given in proof of any breach of the exclusive privilege, or of any ground impeaching the validity of that privilege, or of any objection or ground affecting such a privilege, unless such breach or other matter as aforesaid has been stated in the particulars delivered under this Section.

(4) If it is alleged that the invention was publicly used or known before the date of the delivery or receipt of the application for leave to file the specification thereof, the places where and the manner in which the invention was so publicly used or known shall be stated in the particulars.

(5) Notwithstanding anything in the foregoing portion of this Section, the Court in which the suit or application is pending, or an issue arising out of the application is being tried, may allow the plaintiff or defendant respectively to amend the particulars delivered under this section upon such terms as it thinks fit.

**38. Title of actual inventor to exclusive privilege in case of fraud.**—If, in a suit instituted in the District Court at any time within fourteen years from the date of the filing of a specification of an invention under this Part, the actual inventor proves to the satisfaction of the Court that the applicant was not the actual inventor, and that at the time of the application for leave to file the specification the applicant knew or had reason to believe that the knowledge of the invention was obtained by himself or by some other person surreptitiously or in fraud of the actual inventor, or by means of a communication made in confidence by the actual inventor to him or to any person through



whom he derived the knowledge, the Court may make a decree declaring an exclusive privilege in respect of the invention to be vested, subject to the other provisions of this Part, in the actual inventor for a term of fourteen years from the date on which the specification was filed, and requiring the applicant to account for and pay over to the actual inventor the profits derived by him from the invention or so much of those profits as the Court, having regard to the degree of diligence exerted by the actual inventor in proceeding under this Section and to all the other circumstances of the case, may see fit to require the applicant to pay.

**39. Transmission of copies of decrees and orders to Secretary.**—A Court making a decree in a suit under Section 29 or Section 38, or an Order on an application under Section 30, Section 31 or Section 33, shall send a copy of the decree or Order, as the case may be, to the Secretary, who shall cause an entry thereof and reference thereto to be made in the register of inventions and against any entry in the address-book affected thereby.

**40. Registration of cessation of exclusive privilege.**—In the following cases, namely:—

- (a) when an exclusive privilege acquired under this Part has ceased under Section 8 or Section 15 by reason of a fee in respect of the continuance of the privilege not having been paid within the time limited by the fourth schedule for the payment thereof, and the period, if any, within which an Order might have been made for enlarging the time for the making of the payment has expired;
  - (b) when an exclusive privilege acquired under this Part has been declared by the Governor-General-in-Council under Section 27 to have ceased;
  - (c) when an exclusive privilege acquired under this Part has ceased under Section 28 by reason of the revocation or expiration of a patent or exclusive privilege;
  - (d) when the whole or any part of an exclusive privilege acquired under this Part has ceased under Section 36 in consequence of an order under that section;
  - (e) when an exclusive privilege has been declared by a decree to have vested in an actual inventor under Section 38;
  - (f) when an exclusive privilege acquired under this Part has ceased by reason of the expiration of the term for which it was acquired;
- the Secretary shall cause an entry with respect to the cessation or vesting of the exclusive privilege to be made in the register of inventions, and a reference to that entry to be made in the margin of the entry in that register of the application for leave to file the specification of the invention.

**41. Rectification of register of inventions or address-book.**—(1) If any person is aggrieved by an entry in the register of inventions or address-book, or by the omission of an entry therefrom, and a proceeding is not provided in the foregoing portion of this Part whereby the register or book may be rectified, he may apply to a High Court for an order for the rectification of the register or book, and that Court may make such Order on the application as it thinks fit.

(2) A copy of the Order shall be forwarded by the Court to the Secretary, who shall cause an entry thereof and reference thereto to be made in the register of inventions and against any entry in the address-book affected thereby.

(3) When the Secretary is a party to an application under this Section, the costs of another party thereto shall not be adjudged to be payable by the Secretary.

**42. Power to High Court to stay proceedings on or dismiss certain applications.**—A High Court to which an application has been made under Section 30, Section 31 and Section 33 or Section 41 may stay proceedings on, or dismiss, the application if in its opinion the application would be disposed of more justly or conveniently by another High Court.

**43. Power for Governor-General-in-Council to require grant of licences.**—If on the petition of any person interested it is proved to the Governor-General-in-Council that, by reason of an inventor who has acquired an exclusive privilege under this Part failing to grant licences on reasonable terms:—

(a) the exclusive privilege is not being worked in British India; or  
(b) the reasonable requirements of the public with respect to the invention cannot be supplied; or

(c) any person is prevented from working or using to the best advantages an invention of which he is possessed;  
the Governor-General-in-Council may order the inventor to grant or may himself on behalf of the inventor grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Governor-General-in-Council, having regard to the nature of the invention and the circumstances of the case, may deem just.

**44. Assignment for particular places.**—Any person for the time being entitled to an exclusive privilege under this Part, or to any share or interest in such a privilege, in any local area may, subject to the conditions of his title thereto, assign the privilege or such share or interest, as the case may be, for any place in or part of that local area.

**45. Subscription of specifications and applications.**—If an applicant is absent from British India, an application for leave to file a specification, or a specification, or an application for leave to file a memorandum or amended specification, may, instead of being signed by the applicant under Section 5, Section 9 or Section 18, as the case may be, be signed on behalf of the applicant by an agent in British India authorized by him in writing in that behalf.

**46. Verification of application.**—(1) An application under this Part for leave to file a specification, memorandum or amended specification must be verified by the person making the application.

(2) If that person is absent from British India, the application may be verified by the agent who signs the application on his behalf.

(3) The verification must be signed by the person making it, and must be to the effect that the facts stated in the application are true to his knowledge, except as to matters stated on information and believes them to be true.

**47. Agents.**—Subject to the provisions of the two last foregoing Sections and of any other enactment for the time being in force any act which is required or authorized by this Part to be done by any person may be done on his behalf by an agent in British India having authority in writing from that person so to do the act.

**48. Fees.**—(1) There shall be paid in respect of the several proceedings specified in the fourth schedule the fees in that schedule prescribed.

(2) The Governor-General-in-Council may, if he thinks fit, reduce any of those fees and revoke or vary the reduction.

(3) The fees payable under this Section shall be collected by means of stamps or otherwise as the Governor-General-in-Council directs.

(4) A proceeding in respect of which a fee is payable under the fourth schedule shall be of no effect unless the fee has been paid.

**49. Rules and forms.**—(1) The Governor-General-in-Council may make such rules and prescribe such forms as he thinks necessary for carrying out the purposes of this Part, and may alter or amend either of the forms in the second and third schedules.

(2) Rules under this Section may provide, among other matters, for the printing of specifications, memoranda and amended specifications, and for the distribution or sale of printed copies thereof.

## PART II.

### DESIGNS.

(N.B.—Sections 50-63 which comprised Part II of this Act, since they related only to Designs are not printed in the present work.)

**THE FIRST SCHEDULE.****Enactments Repealed.**

(See Section 2.)

Number and Year.	Subject or Title.	Extent of Repeal.
XV of 1859 ..	For granting exclusive privilege to Inventors.	So much as has not been repealed.
XIII of 1872 ..	Patterns and Designs Protection Act, 1872	So much as has not been repealed.
XVI of 1883 ..	Protection of Inventions Act, 1883 ..	The whole.
I of 1879 ..	Indian Stamp Act, 1879 ..	Article 48, Schedule I.

**THE SECOND SCHEDULE.****Application where Patent has not been obtained.**

(See Sections 5 and 49.)

To The Governor-General-in-Council.

The application of (here insert name, occupation and address), for leave to file a specification under Part I of the Inventions and Designs Act, 1888.

1. The applicant is in possession of an invention for (state the title of the invention); he is the inventor thereof (or, as the case may be, the executor, administrator or assign of the inventor), and, to the best of his information and belief, the invention is new within the meaning of Part I of the Inventions and Designs Act, 1888, and no circumstance exists which, if the applicant is authorized to file a specification and files it in accordance with that Part, will disentitle him to an exclusive privilege thereunder in respect of the invention.

2. The following is a description of the invention (here describe it and the particular novelty whereof it consists).

3. The applicant, therefore, applies for leave to file a specification of the invention pursuant to Part I of the Inventions and Designs Act, 1888.

(Signature and verification.)

**THE THIRD SCHEDULE.****Application where Patent has been obtained.**

(See Sections 5 and 49.)

To The Governor-General-in-Council.

The application of (here insert name, occupation and address), for leave to file a specification under Part I of the Inventions and Designs Act, 1888.

1. The applicant (or, as the case may be, A. B. of whom the applicant is the executor, administrator or assign) has obtained a patent in the United Kingdom dated and sealed as of the       day of       , and actually sealed on the       day of       , for (state the title of the invention).

2. To the best of the information and belief of the applicant the invention is new within the meaning of Part I of the Inventions and Designs Act, 1888, and no circumstances exist which, if the applicant is authorized to file a specification and files it in accordance with that Part, will disentitle him to an exclusive privilege thereunder in respect of the inventions.

3. The following is a description of the invention (here describe it and the particular novelty whereof it consists).

4. The applicant therefore applies for leave to file a specification of the invention pursuant to Part I of the Invention and Designs Act, 1888.

(Signature and verification.)

**THE FOURTH SCHEDULE.****Fees (Inventions).**

(See Sections 8, 15 and 48.)

	Rs.	A.	P.
(1) In respect of an application for leave to file a specification (Section 5) .. .. .	10	0	0
(2) In respect of the filing of a specification (Section 8) ..	30	0	0
(3) In respect of an extension of the time for filing a specification (Section 8) .. .. .	20	0	0
(4) In respect of the continuance of an exclusive privilege (Section 8)—			
(a) After the filing of the specification and before the expiration of the fourth year from the date of the filing thereof .. .. .	50	0	0
(b) After the expiration of the fourth year and before the expiration of the fifth year from that date .. .. .	50	0	0
(c) After the expiration of the fifth year and before the expiration of the sixth year from that date .. .. .	50	0	0
(d) After the expiration of the sixth year and before the expiration of the seventh year from that date .. .. .	50	0	0
(e) After the expiration of the seventh year and before the expiration of the eighth year from that date .. .. .	50	0	0
(f) After the expiration of the eighth year and before the expiration of the ninth year from that date .. .. .	100	0	0
(g) After the expiration of the ninth year and before the expiration of the tenth year from that date .. .. .	100	0	0
(h) After the expiration of the tenth year and before the expiration of the eleventh year from that date .. .. .	100	0	0
(i) After the expiration of the eleventh year and before the expiration of the twelfth year from that date .. .. .	100	0	0
(j) After the expiration of the twelfth year and before the expiration of the thirteenth year from that date .. .. .	100	0	0

		Rs.	A.	P.
Provided that the inventor may pay the sum total of the said fees in respect of the continuance of the exclusive privilege, or any part thereof short of the sum total, at any time before the same falls due.				
(5)	In respect of an enlargement of the time for payment of a fee under article (4) of this schedule (Section 8)—			
(i)	If the enlargement does not exceed one month ..	10	0	0
(ii)	If the enlargement exceeds one month but does not exceed two months ..	25	0	0
(iii)	If the enlargement exceeds two months ..	50	0	0
(6)	In respect of an application for an extension of an exclusive privilege for a further term (Section 15) ..	50	0	0
(7)	In respect of the continuance of an exclusive privilege of which the term has been extended (Section 15) ..	100	0	0
		To be paid before the expiration of each year of the extended term:		
Provided that the inventor may pay the sum total of the said fees in respect of the continuance of the exclusive privilege, or any part thereof short of the sum total at any time before the same falls due.				
(9)	In respect of an application for leave to file a memorandum or amended specification (Section 18) ..	20	0	0
(10)	In respect of a petition to the Governor-General-in-Council for a compulsory licence (Section 43) ..	50	0	0
(11)	For the inspection of any book or other document which is open to inspection under Part I ..	1	0	0
(12)	For copies—			
(a)	When the number of words copied does not exceed four hundred ..	1	0	0
(b)	For every hundred words in excess of four hundred ..	0	4	0
(c)	Of drawings or photographs ..	Cost according to agreement.		
(13)	For certifying copies—			
	For every hundred words ..	0	2	0

### THE FIFTH SCHEDULE.

Application for Orders for Registration of Design.

(See Sections 51 and 63.)

[N.B.—This Schedule and the Sixth Schedule which related only to Designs are not printed in the present work.]

### THE SIXTH SCHEDULE.

Fees (Designs).

(See Section 62.)

[N.B.—Not printed.]

## INDIAN PATENTS AND DESIGNS RULES, 1912.

*N.B.—These Rules as here printed embody the amendments contained in the "Gazette of India" dated 16th October 1915 in Part I at page 1914, also those contained in the "Gazette of India" dated 24th January 1921 in Part I at page 170, and those contained in the "Gazette of India" dated 21st June 1923 in Part I at page 573, and those of a Notification No. a-197 dated 17th July 1930, and those of a Notification of the Department of Industries and Labour published in the "Gazette of India" dated 5th November 1932, Part I, at page 1208. These Indian Patents and Designs Rules of 1912 were originally published in the "Gazette of India" dated 23rd September 1911 in Part II at page 1441. They have been superseded in toto under Section 68 of the Indian Patents and Designs Rules, 1933 (for which see Appendix V below).*

In exercise of the powers conferred by sections 57 and 77 (1) of the Indian Patents and Designs Act, 1911 (II of 1911), the Governor-General-in-Council is pleased to make the following rules:—

### CHAPTER I. PRELIMINARY.

1. **Short title and commencement.**—These rules may be called the Indian Patents and Designs Rules, 1912.

They shall come into force on the first day of January, 1912.

2. **Definitions.**—In the rules, unless there is anything repugnant in the subject or context—

(a) The Act means the Indian Patents and Designs Act, 1911.

(b) Office means the Patent Office provided under section 55 of the Act.

(c) Controller means the Controller of Patents and Designs appointed under section 56 of the Act, and includes any officer appointed to act for him.

(d) "British application" means an application by any person for protection of his invention in any part of His Majesty's dominions for the protection of which invention in British India the provisions of section 78A of the Act are for the time being applicable.

(e) "Reciprocity application" means an application in British India under section 78A of the Act.

3. **Communications to the Office.**—Any application, notice or other document, and any fee, authorized or required to be left, made, given or paid at the Office, or to the Controller, may be sent by hand or through the post addressed to the Controller of Patents and Designs, 1, Council House Street, Calcutta, and, if so sent, shall be deemed to have been left, made, given or paid on the day of receipt.

4. **Fees.**—(1) The fees to be paid under the Act shall be those specified in the first Schedule to these rules, hereinafter described as the prescribed fees.

(2) Fees may be paid in cash at the office, or may be sent by money order or postal order or cheque payable to the Controller at Calcutta. Cheques not carrying the correct addition for commission, and other cheques on which the full value cannot be collected in cash within the time allowed for payment of the fee, will only be accepted at the discretion of the Controller. Stamps will not be received in payment of fees.

5. **Application, etc., to be accompanied by the prescribed fee.**—All applications, notices, requests, appeals or documents on which a fee is leviable under these rules shall be accompanied by the prescribed fee.

6. The forms set forth in the second Schedule to these rules, with such variations as the circumstances of each case require, shall be used for the respective purposes therein mentioned, and if used shall be sufficient.

7. **Size, etc., of documents.**—(1) All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Controller shall be written, typewritten, lithographed, or printed in the English

language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong white paper, and on one side only, of a size approximately of 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof. Signatures thereto must be written in a large and legible hand, and a vernacular signature must be accompanied by a transliteration in English.

(2) Duplicate documents shall be filed at the Office, if at any time required by the Controller.

(3) Names and addresses of applicants and other persons shall be given in full, together with such other particulars of nationality, caste or calling as are necessary for identification.

**8. Signature and verification of documents specified in section 75 of the Act.**—The documents specified in section 75 of the Act shall be dated and signed at the foot, and shall contain a statement that the facts and matters stated therein are true to the best of the knowledge, information and belief of the person signing them.

**9. Agency.**—(1) For all matters falling under the provisions of section 76 of the Act, any person may, unless otherwise directed by the Controller, authorize, under his personal signature, any other person to act as his agent and to receive all notices, requisitions and communications. The authority may be given on Form 26.

(2) If he does not desire to authorize any other person to act as his agent, but wishes notices, requisitions and communications to be sent to a particular address, he may notify the same to the Controller on Form 27.

## CHAPTER II.—PATENTS.

### APPLICATIONS FOR GRANT OF PATENT.

**10. Application.**—(1) An application, under section 3 of the Act, for a patent shall be made on Form 1 or Form 2, and shall be accompanied by a specification, prepared in duplicate in accordance with Form 3.

(2) Applications shall, as far as may be practicable, be numbered and dated in the order of their receipt.

(3) If the true and first inventor, or any other applicant is in the service of the Crown, he shall disclose that fact in the application and shall state the office he holds.

(4) If the true and first inventor does not wish to be a party to the application, the applicant shall produce the original deed of assignment or other document under which he is enabled to apply for a patent, unless the application itself is endorsed by the true and first inventor in the presence of two witnesses with a statement that the said inventor agrees that the application shall be made without his name as an applicant for a patent.

(5) If the application is made by the legal representative of a deceased inventor, the legal representative shall produce for inspection the probate of the will or the letters of administration of the estate of the inventor, or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require.

**10A.** Every reciprocity application shall be made on Form 2A or on Form 2B and shall contain a declaration that a British application has been made for protection of the invention to which such reciprocity application relates and shall specify every part of His Majesty's dominions in which any such British application has been made and the official date or dates thereof. The reciprocity application shall be accompanied by a specification prepared in duplicate in accordance with Form 3.

### SPECIFICATION.

**11. Specification.**—(1) The specification shall commence with the title of the invention and the name of the applicant as in the application. It shall terminate with a clear and succinct statement of the invention claimed, distinct from the body of the specification, and shall be signed by the applicant or his agent.

(2) Where the invention is capable of representation by drawings, such drawings shall be prepared in accordance with rule 13 and shall be supplied with, and referred to in detail in, the specification.

(3) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.

11A. (1) In addition to the specification left with every reciprocity application, a copy or copies of the specification or specifications, and drawings or documents filed or deposited by the applicant in respect of the first British application, duly certified by the official chief or head of the Patent Office in which they were filed or deposited, or otherwise verified to the satisfaction of the Controller, shall be left at the office at the same time as the reciprocity application or within such further time, not exceeding three months, as the Controller may allow.

(2) If any specification or other document relating to the application is in a foreign language a translation thereof shall be annexed thereto and shall be verified to the satisfaction of the Controller.

(3) An application for an extension of time for leaving the copy or copies of the specification or specifications, drawings or documents, filed or deposited in respect of the first application, shall be made on Form 4A.

12. **Amendments how to be made.**—(1) When the specification, or any drawing accompanying it is defective and requires amendment, one copy shall be returned to the applicant or his agent and all alterations shall be made thereon as far as possible. Additional matter may be interpolated if necessary by re-writing such pages as are required to form a continuous document. Amendments shall not be made by slips pasted on, or as footnotes, or by writing in the margin. The amended documents shall be returned to the Controller together with the cancelled pages or drawings, if any, and with a duplicate of any pages or drawings that have been amended or added.

(2) Amendments, alterations or additions shall be initialled by the applicant or his agent.

(3) No amendments, alterations or additions shall be made in a document returned for amendment beyond those necessary to comply with the requirements of the Controller.

(4) When a specification comprises more than one invention, and it is considered by the Controller or the applicant that the application should be restricted to one invention, the additional inventions may be made the subject-matter of additional applications. Any such applications, if made before the acceptance of the original application, shall, on the request of the applicant, bear date of the original application, and shall be proceeded with as substantive applications of that date.

## **DRAWINGS WITH APPLICATIONS FOR PATENTS.**

13. **Size of drawings, etc.**—(1) Drawings shall be supplied in duplicate on sheets 13 inches in height and either 8 or 16 inches in width. A clear margin of half an inch shall be left round each sheet. The figures of the drawing shall be numbered consecutively Figure 1, Figure 2, etc., and shall be placed upright on the sheets. Reference figures and letters shall be clear and bold, not less than  $\frac{1}{16}$ th of an inch in height, and the same letters shall be used for the same parts in different views or drawings. The sheets of drawings, when more than one, shall be numbered consecutively, the number of each sheet being shown in the right-hand top corner. Each sheet shall be signed by the applicant or his agent in the bottom right-hand corner.

(2) No written description of the invention shall appear on the sheets of drawings.

(3) At least one copy of the drawings shall be suitable for reproduction and, for that purpose, shall be prepared on tracing cloth or on smooth white paper which is not opaque. All lines and lettering shall be executed with Indian ink of good quality. Coloured lines and washes shall not be used. The lines and lettering shall be firm and even, and section lines shall not be closely drawn. The scale adopted shall be large enough to show the invention clearly.

(4) Drawings shall be delivered flat or rolled so as to be free from creases,



**OPPOSITION TO GRANT OR AMENDMENT, ETC.**

14. **Notice of opposition.**—Notice of opposition to the grant, or to the amendment, etc., of a patent shall be given in duplicate on Form 5. The duplicate notice shall be sent by the Controller to the applicant or his agent.

15. **Filing of statements.**—(1) Within 14 days of giving notice of opposition the opponent may, and shall, if at any time so required by the Controller, leave at the Office a full written statement in duplicate of the reasons for, and extent of, his opposition, and of the grounds upon which he relies in support of his opposition.

(2) If the written statement referred to in clause (1) is supplied the Controller shall furnish the applicant or his agent with the duplicate copy thereof, and the applicant or his agent may leave at the Office a reply in writing within a time to be specified by the Controller. Such reply shall deal in full with the statement of the opponent and shall be in duplicate.

(3) If the reply referred to in clause (2) is supplied by the applicant, the Controller shall furnish the opponent or his agent with the duplicate copy thereof, and the opponent or his agent may again leave at the Office a rejoinder in writing within a time to be specified by the Controller. Such rejoinder shall be confined strictly to matters in reply, and shall be in duplicate. The duplicate copy shall be sent by the Controller to the applicant or his agent.

(4) The Controller may require at any time that any written statement, reply or rejoinder shall be in the form of an affidavit.

(5) The time ordinarily allowed for filing a reply or rejoinder shall be one month.

16. **Hearing.**—(1) On completion of these proceedings, if any, or at such other time as he may see fit, the Controller shall appoint a time for the hearing of the case, and shall give the parties not less than ten days' notice of such appointment. If either party does not desire to be heard he shall as soon as possible notify the Controller to that effect. If either party desires to be heard, he must leave a notice of his intention to attend the hearing on Form 6, together with a fee of Rs. 10, at the Office. The Controller may refuse to hear any party who has not left such notice and fee at least two clear days before the date fixed for the hearing.

(2) After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Controller shall decide the case and notify his decision to the parties.

**SEALING OF PATENTS.**

17. **Sealing.**—(1) If an applicant desires to have a patent sealed on his application, he shall, within the period allowed by section 10, sub-section 2 of the Act, leave at the Office an application on Form 7.

(2) Where the applicant neglects or fails to pay the fee prescribed within the time allowed, the time may be extended for a period not exceeding three months. An application for such extension of time shall be made on Form 4, and shall be accompanied by a fee of Rs. 10, Rs. 20, or Rs. 30 for an extension of one, two, or three months respectively.

18. **Form of patent.**—The patent shall be in the form given in the third Schedule to these rules, with such modifications as the circumstances of each case require.

**RESTORATION OF A LAPSED PATENT.**

19. **Restoration of lapsed patent.**—(1) Application under section 16 of the Act for the restoration of a lapsed patent shall be made on Form 9.

(2) If the Controller entertains the application, he shall advertise it in the "Gazette of India."

20. **Opposition.**—Notice of opposition to the restoration may be given on Form 5 within six weeks of the advertisement and the procedure for the disposal of such opposition shall be regulated by the provisions of Rules 14, 15 and 16.

**AMENDMENT.**

21. **Amendment.**—A request under section 17 of the Act for the amendment of an application, specification or drawings (not being a request under section 62 of the Act for correction of a clerical error) shall be made on Form 10

and shall be accompanied by a copy of the application, specification, or drawings showing in red ink the proposed amendment in such a manner as to indicate clearly the alteration desired.

**22. Procedure when patent has been accepted.**—If the request relates to an application for a patent which has been accepted, the request and the nature of the proposed amendment shall be advertised by notification in the "Gazette of India" and in such other manner, if any, as the Controller may in each case direct under Rule 45. The Controller shall also notify all persons whose names are entered at the time of the request on the Register as claiming an interest in the patent.

**23. Opposition.**—Notice of opposition to the amendment may be given on Form 5 within three months of the date of the notification, and the procedure for the disposal of such opposition shall be regulated by the provisions of Rules 14, 15 and 16.

### **SURRENDER OF PATENTS.**

**24. Surrender of patent.**—Notice of an offer under section 24 of the Act to surrender a patent shall be made on Form 11. The Controller shall advertise the offer in the "Gazette of India," and shall notify all persons whose names are entered at the time of the offer on the Register as claiming an interest in the patent.

**25. Opposition.**—Within six weeks of the advertisement any person may give notice of opposition to such surrender. After the expiration of such six weeks the Controller may, if a notice of opposition has been given, appoint a hearing if he sees fit, and shall decide whether the patent shall be revoked.

## **CHAPTER III.—DESIGNS.**

*(N.B.—The following Rules 26-38 comprising Chapter III, which related exclusively to Designs, have been here omitted.)*

## **CHAPTER IV.—GENERAL.**

### **REGISTERS OF PATENTS AND DESIGNS.**

**38A.** The patent granted on any reciprocity application shall be entered in the register of patents as dated of the official date of the first British application, but the date of the reciprocity application shall also be entered in the register.

**39. Requests under section 63 of the Act.**—Requests under section 63 of the Act to enter a claim to any interest in a patent or registered design shall be made on Form 21, accompanied by the document under which the claim is made, and an attested copy thereof. If, however, the document is a matter of record, an official or certified copy thereof may be produced unless the Controller otherwise directs.

**40. Rectification of the Register.**—Ten clear days' notice of every application to the Court under section 64 of the Act for rectification of the register shall be given to the Controller.

### **APPEALS.**

**41. Appeals.**—(1) An appeal to the Governor-General-in-Council from the decision of the Controller shall be made on Form 24 and shall be left at the Office in duplicate and shall show fully the reasons for appealing and the grounds on which objection is taken to the decision.

(2) The Controller shall forward one copy to the Governor-General-in-Council through the Secretary in the Department of Commerce and Industry, who shall notify the appellant of its receipt.

### **CONVERSION OF EXCLUSIVE PRIVILEGE INTO A PATENT.**

**42. Conversion of exclusive privilege into a patent.**—

*(N.B.—This Rule ceased to be effective after 31st December 1913).*

**MISCELLANEOUS POWERS OF THE CONTROLLER.**

**43. Exercise of discretionary power of Controller.**—Before exercising any discretionary power given to the Controller by the Act or these rules adversely to the applicant for a patent, or for amendment of an application or specification, the Controller shall (under section 67 of the Act) give notice to the applicant or his agent and shall, if so required within 1 month of the date of such notice, appoint a date for a hearing in the matter and shall give ten days' notice thereof.

**44. Controller may require statement.**—Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a time to be notified by the Controller, or to attend before him and make explanation with respect to such matters as the Controller may require.

**45. Controller may direct advertisement in newspapers.**—Applications for extension of the term of a patent under section 15, or for amendment under section 17, shall, if so directed by the Controller, be advertised by the applicant in not less than two newspapers published in British India. Copies of the newspapers containing those advertisements shall be supplied to the Controller.

Advertisement of such applications shall be made by the Controller by notification in the "Gazette of India."

**46. General powers of amendment.**—Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure which, in the opinion of the Controller, may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit, and upon such terms as he may direct.

**47. General power to enlarge time.**—The time prescribed by these rules for doing any act or taking any proceeding thereunder may be enlarged by the Controller, if he thinks fit, and upon such terms as he may direct.

**SCHEDULES.**

I. Fees, section 57 and Rule 4.

II. Forms, Rule 6.

III. Model form of patent, section 12 (2) and Rule 18.

IV. Classification of goods for designs, sections 43 (3) and 77 (1) (b) and Rule 26.

**THE FIRST SCHEDULE.**

(Vide section 57 and rule 4.)

**FEES.**

Number of entry.	On what payable.	Number of Form.	Proper Fee.
			Rs. A. P.
1	On application for a patent under section 3	1 or 2	10 0 0
1-A	On application for a patent under section 78-A.	2-A or 2-B	10 0 0
2	For extension of time to accept application under section 5 (4). .. ..	4	20 0 0
3	On notice of opposition under section 9 (r)	5	5 0 0
4	On hearing by Controller under section 9 (2). By applicant and opponent respectively .. ..	6	10 0 0

Number of entry.	On what payable.	Number of Form.	Proper Fee.
5	Before sealing under section 10 (1) ..	7	Rs. A. P. 30 0 0
6	On extension of time for sealing under section 10 (2) (d). .. ..	4	..
	One month .. ..	..	10 0 0
	Two months .. ..	..	20 0 0
	Three months .. ..	..	30 0 0
6-A	On extension of time for filing documents under rule 11-A. .. ..	4A	..
	One month .. ..	..	10 0 0
	Two months .. ..	..	20 0 0
	Three months .. ..	..	30 0 0
7	On certificate of renewal under section 14	8	..
	Before expiration of 4th year in respect of the 5th year .. ..	..	50 0 0
	Before expiration of 5th year in respect of the 6th year .. ..	..	50 0 0
	Before expiration of 6th year in respect of the 7th year .. ..	..	50 0 0
	Before expiration of 7th year in respect of the 8th year .. ..	..	50 0 0
	Before expiration of 8th year in respect of the 9th year .. ..	..	50 0 0
	Before expiration of 9th year in respect of the 10th year .. ..	..	100 0 0
	Before expiration of 10th year in respect of the 11th year .. ..	..	100 0 0
	Before expiration of 11th year in respect of the 12th year .. ..	..	100 0 0
	Before expiration of 12th year in respect of the 13th year .. ..	..	100 0 0
	Before expiration of 13th year in respect of the 14th year .. ..	..	100 0 0
	Before expiration of 14th year in respect of the 15th year .. ..	..	150 0 0
	Before expiration of 15th year in respect of the 16th year .. ..	..	150 0 0

Number of entry.	On what payable.	Number of Form.	Proper Fee.
			Rs. A. P.
	<b>Note.</b>		
	<i>The fee for two or more years may be paid in advance.</i>		
8	On enlargement of time for payment of renewal fees under section 14 (2) ..	4	..
	One month .. ..	..	10 0 0
	Two months .. ..	..	20 0 0
	Three months .. ..	..	30 0 0
9	On petition for extension of term of patent under section 15 .. ..	..	50 0 0
10	On certificate of renewal in respect of each year under section 15 .. ..	..	150 0 0
11	On application for restoration of lapsed patent under section 16 .. ..	9	100 0 0
12	On opposition to restoration under section 16 .. ..	5	5 0 0
13	On hearing by Controller under section 16. By applicant and opponent, respectively .. ..	6	10 0 0
14	On application to amend under section 17	10	..
	Before acceptance .. ..	..	10 0 0
	After „ .. ..	..	20 0 0
15	On opposition to amendment under section 17 (3) .. ..	5	5 0 0
16	On hearing by Controller under section 17 (4). By applicant and opponent, respectively .. ..	6	10 0 0
17	On petition for compulsory licence or revocation under sections 22 and 23 ..	..	10 0 0
18	On offer to surrender a patent under section 24 .. ..	11	10 0 0
19	For duplicate of a patent under section 39	12	10 0 0
20	On notice to Controller of intended exhibition of an invention or design under section 40 or 52 .. ..	13	5 0 0

Number of entry.	On what payable.	Number of Form.	Proper Fee.
			Rs. A. P.
21	On request to register design under section 43 .. ..	14	..
	In classes 1 to 6 and class 16 ..	..	3 0 0
	In classes 7 to 15 .. ..	..	0 8 0
22	On request for written decision under Rule 32 .. ..	15	5 0 0
23	On request to extend copyright under section 47 .. ..	16	10 0 0
24	On request to inspect under section 50 ..	17	1 0 0
25	On request for information under section 51 .. ..	18	..
	When number is given .. ..	..	2 0 0
	When number is not given ..	..	4 0 0
26	On inspection of the register under section 59 .. ..	..	1 0 0
27	On request for certificate under section 59	19	2 0 0
	An additional fee of 4 annas for every 100 words in excess of 400 words will be charged. Drawings will be charged according to agreement		
28	On request to correct or cancel entry in register under section 62 ..	20	3 0 0
29	On request to enter claim in register under section 63 .. ..	21	5 0 0
30	On request to alter address in register ..	22	1 0 0
31	On entry of order of court under section 64 (4) .. ..	23	3 0 0
32	On appeal from the Controller to the Governor-General-in-Council under section 70 .. ..	24	30 0 0
33	On application for a patent in place of an exclusive privilege under section 81 ..	25	3 0 0
34	On opposition to grant thereof under section 81 .. ..	5	5 0 0
35	On hearing by Controller under section 81 (3). By applicant and opponent respectively .. ..	6	10 0 0

**THE SECOND SCHEDULE.****FORMS.****List of Forms.**

Form No.	Act, section.	Title.	Fee.		
			Rs.	A.	P.
1	3	Application for patent .. ..	10	0	0
2	3	„ „ „ .. ..	10	0	0
2-A	78-A	„ „ „ .. ..	10	0	0
2-B	78-A	„ „ „ .. ..	10	0	0
3	4	Specification .. ..	..		
4	5 (4), 10 (2), 14 (2)	Application for extension of time ..	Rs. 10, 20, 30		
4-A	78-A	„ „ „ .. ..	Rs. 10, 20, 30		
5	9 (1), 16, 17, 18	Notice of opposition .. ..	5	0	0
6	9 (2), 16, 17, 18	Notice of intention to attend hearing ..	10	0	0
7	10	Request for sealing .. ..	30	0	0
8	14	Request for certificate of renewal ..	Rs. 50 or 100		
9	16	Application for restoration of patent ..	100	0	0
10	17	Application to amend .. ..	Rs. 10 or 20		
11	24	Offer to surrender patent .. ..	10	0	0
12	39	Application for duplicate patent ..	10	0	0
13	40 and 52	Notice of intended exhibition ..	5	0	0
<b>Designs.</b>					
14	43	Application for registration .. ..	0	8	0
15	..	Request for grounds of decision ..	5	0	0
16	47	Application for extension of copyright ..	10	0	0
17	50	Request to inspect design .. ..	1	0	0
18	51	„ for information .. ..	Rs. 2 or 4		

Form No.	Act, section.	Title.	Fee.
		<b>General.</b>	<b>Rs. A. P.</b>
19	59	Request for certificate .. ..	2 0 0
20	62	„ to cancel or correct .. ..	3 0 0
21	63	„ for entry in register .. ..	5 0 0
22	63	„ for entry of address .. ..	1 0 0
23	64	Entry of order of court .. ..	3 0 0
24	5 (2), 9 (3), 16 (5), 17 (6), 43 (4), 70	Appeal .. ..	30 0 0
26	76	Power of authority to agent .. ..	..
27	76	Statement of address .. ..	..

[N.B. Here followed certain specimen forms, which are here omitted.]

### THE THIRD SCHEDULE.

#### Model Form of Patent.

[N.B. Since the Indian Model Form of Patent in the current Indian Patent and Designs Rules, 1933 is set out in full below in Appendix V, the contents of this third schedule to the old Rules of 1912 is here omitted.]

### THE FOURTH SCHEDULE.

#### Classification of Goods.

[N.B. Since the contents of this schedule refers to matters which related exclusively to Designs, they are here omitted.]





**APPENDIX NO. V.**  
**CURRENT INDIAN ACTS AND RULES.**

## CONTENTS.

*N.B.—The Acts which follow are in full force and effect in British India at the present day. In addition to the complete text of the Acts as passed, copies of the respective Objects and Reasons and, when desirable, of the Report of the Select Committee in regard to the Bills which culminated in these Acts, are set out below for convenience of reference. The principal Act of 1911 is also set out in full in its current form after giving effect to the various amendments which have been effected by the amending Acts. References are given in respect of the Sections of the current principal Act as amended and to the current Rules showing the pages in the present work, where any specific Section or Rule is considered.*

### CURRENT ACTS.

(With the relative Statement of Objects and Reasons and, where the Bill has been sent to a Select Committee before being passed into Law, with the Report of the Select Committee):—

1. Objects and Reasons of the Bill which culminated in Act II of 1911.
2. Act II of 1911 as originally passed.
3. Objects and Reasons of the Bill which culminated in Act XXIX of 1920.
4. Act XXIX of 1920.
5. Objects and Reasons of the Bill which culminated in Act VII of 1930.
6. Report of the Select Committee on the Bill which culminated in Act VII of 1930.
7. Act VII of 1930.
8. Extracts from the Indian and Bengal Stamp Acts.
9. Calcutta High Court (Jurisdiction Limits) Act (Indian Act XV of 1919).
10. Madras High Court (Jurisdictional Limits) Act (Madras Act IV of 1927).
11. Text of the current Indian Patents and Designs Act embodying the amendments and provisions made by the above-mentioned Acts: with references to the pages in this work where particular Sections of the Act are referred to, considered, and commented on.

### CURRENT RULES.

12. Indian Patents and Designs Rules, 1933. These Rules were published in Part II of the "Gazette of India" of 11th February, 1933. They came into effect on 1st April, 1933. (References are given to the pages in this work which refer to particular Rules and where particular Rules are considered and commented on).

## OBJECTS AND REASONS OF THE BILL CULMINATING IN ACT II OF 1911.

Extract from "Gazette of India" of 26th March, 1910, Part V, at page 92, Statement of Objects and Reasons of the Indian Patents and Designs Bill (No. 9 of 1910).

The Inventions and Designs Act, V of 1888, now in force is based in all material respects as regards inventions on the previous Act, XV of 1859, which, in turn, was practically a repetition of Act VI of 1856. This, the earliest Act in India, was founded on the English Patent Law of 1852 contained in the Statutes 16 and 17 Vict., c. 115.

2. Under the Statute of 1852 a patent was granted subject to the subsequent filing of a specification but under the Indian Act of 1859 an advance in procedure was made in that the exclusive privilege which is the Indian equivalent to a patent, only accrued when a specification was filed. By the later Statute of 1883 (46 and 47 Vict., c. 57) the patent was not granted until after the acceptance of a correct specification and the absence or failure of opposition by interested parties; and this procedure is still followed in the English Law which is contained in the Patents and Designs Act, 1907 (7 Edw. 7, c. 29).

3. Although the Indian Act of 1888 was passed five years after the United Kingdom Statute of 1883, it was felt that the time was not yet ripe in this country for introducing the English practice in its entirety as the volume of patent work was then small. Now, however, that it is growing and is likely to do so at a much greater rate in the future, it is thought advisable to bring the practice in this country more into conformity with that of the United Kingdom, thereby following the example of most of the other British possessions. By postponing action until now it has been possible to take advantage of the consolidation of the English Statutes which the Patents and Designs Act, 1907, has effected. The present appears therefore to be a very opportune time for undertaking legislation in India.

4. The existing procedure in India under the Inventions and Designs Act, 1883, for obtaining an exclusive privilege is somewhat as follows. The inventor submits to the Governor-General-in-Council an application accompanied by the prescribed fee and containing a description of the invention. The title of the invention is notified in the "Gazette of India," and after examination by the Secretary under the Act for formal matters, the application is exposed to public inspection in the Secretary's office for ten days, so that any number of the public may have an opportunity of objecting to the grant of leave to file the specification. The application is then further examined by the Secretary more closely to see whether it complies in all respects with the Act, and also, where possible, to see whether the invention is novel. Any objections are also considered by him at this stage. If he finds the application is in order, leave to file a specification is granted, subject generally to conditions in the case of inventors who are Government servants. Within a period of six months (which may on permission be extended to nine months) the applicant, if he desires to obtain an exclusive privilege, must file six copies of a specification together with a second fee. The specification is then examined by the Secretary to see whether it is substantially identical with the description drawings and claims in the application. As soon as this identity is secured, the specification is notified as filed as from the date on which it was first received and the exclusive privilege accrues from that for fourteen years, or even with permission for a longer period, but it ceases if any corresponding English or foreign patent lapses.

5. Under the above procedure the public have no proper opportunity of objecting to the grant as merely a single manuscript copy of the application, which often contains an imperfect description, is available for inspection in Calcutta only during a very limited period. Subsequently, though the exclusive privilege may on application to the High Court be revoked on various grounds, including invalidity and non-novelty, these grounds—which are the natural grounds of defence—cannot, except in certain special cases, be pleaded by privilege. For the sake both of the inventor and the public it is desirable that the procedure should be simplified and made more direct and effective,

not only in regard to the grant of patents but also in respect of their subsequent existence and operation. Further it seems expedient that the dependence of Indian rights on foreign patents should cease.

6. By the Bill as proposed the method of obtaining a patent for an invention will consist of the following stages:—

- (a) submission of application and specification at the same time, together with the prescribed fee;
- (b) acceptance of the application after complete examination within nine or twelve months;
- (c) publication of documents after such acceptance;
- (d) interval of three months for submission of objections to grant;
- (e) grant of patent after objections (if any) have been disposed of, on payment of the prescribed fee.

The public will thus be protected by increasing the facilities for opposition at an effective period, while the applicant will be enabled to restrict his claim to what appears to be more properly his invention, thus obviating to some degree his risks in subsequent infringement or revocation proceedings. The applicant will further be protected as his application will be kept secret, which it is not at present, until acceptance.

7. The following further improvements in the law proposed by the Bill may here be enumerated:—

- (a) Patents will not lapse on cessation of foreign patents.
- (b) Patents will be granted as being more suitable for commercial purposes than the present certificates that specifications have been filed and fees paid.
- (c) Proprietorship of patents and designs will be more fully recorded.
- (d) Amendment of application and specifications will be facilitated and opposition thereto by the public will be permissible as in the case of the original applications.
- (e) Defendants in infringement suits will be allowed in all cases to use the natural ground of defence by pleading non-validity and non-novelty of the patent.
- (f) Validity of patents will be certified in certain cases to give protection against wilful infringers.
- (g) Threats of legal proceedings will be actionable unless the patentee proceeds diligently with an infringement suit.
- (h) Anomalies in respect of British inventors will be removed and arrangements will be made for the mutual protection of inventions and designs between India and other British possessions and between Indian and Foreign States.
- (i) Compulsory licences for the working of inventions will be obtainable on more clearly defined and broadened grounds than formerly.
- (j) Surrender of patents and restoration of ceased patents will be permissible.
- (k) The law as to designs, which now follows the Statute of 1883, will be brought into line with the Statute of 1907.
- (l) Finally a Controller of Patents and Designs will be established, with power to dispose of many matters which are at present referred to the Governor-General-in-Council.

8. Generally speaking, the provisions of the Bill follow with the necessary modifications those of the Inventions and Designs Act, 1907, only such provisions of the Act of 1888 being retained as appear necessary to meet the special conditions in India. It is hoped that the proposals contained in the Bill will enable the attainment of the double object of encouraging the inventor and of giving more effective protection both to him and to the public.

9. The more important alterations in the existing law proposed by the Bill are explained in the Notes on Clauses below, and two Tables, showing the extent to which the provisions of the Act of 1888 and the Statute of 1907 have been adopted in the Bill, are appended.

**ACT II OF 1911 AS ORIGINALLY PASSED.**

*N.B.—In order to avoid unnecessary matter, since it would appear that the original text of this Act will but seldom, if ever, be required to be referred to in practice, and in view of the fact that the text of the whole Act of 1911 as amended up to date is printed in Appendix No. V, the original text of this Act II of 1911 in the form in which it was first passed is here omitted.*

## OBJECTS AND REASONS OF THE BILL CULMINATING IN ACT XXIX OF 1920.

Extract from the "Gazette of India" of 28th August, 1920, Part V, at page 166.

### GOVERNMENT OF INDIA.

#### Legislative Department.

The following Bill was introduced in the Indian Legislative Council on the 27th August, 1920:—

No. 31 of 1920.

A Bill further to amend the Indian Patents and Designs Act, 1911.

(Here follows the text of the Bill: providing for a new section 78A to be inserted in Act II of 1911.)

#### Statement of Objects and Reasons.

The main object of this Bill is to bring India into the inter-imperial arrangement for the provisional protection of inventions and designs within the Empire.

A subsidiary object is to enable valid protection to be obtained for inventions which owing to war exigencies have been protected only in some parts of the Empire but would otherwise be invalidated by publication in other parts.

India has hitherto been disqualified for admission to the inter-imperial arrangement provided for section 91 of the United Kingdom Patents and Designs Act, 1907, but by virtue of the amendment made in sub-section (5) of that section by the United Kingdom amending Act of 1919, it is now possible for India to enter into this mutual arrangement, by which Indian inventors will gain the advantages of provisional protection for their inventions for a period of twelve months in almost all parts of the Empire.

Inasmuch as Article 308 of the Treaty of Versailles does not apply to India, it is at present impossible to adopt the procedure adopted in the United Kingdom and elsewhere of extending the period of provisional protection under emergency legislation so as to antedate patents for which application has been delayed by war conditions.

Several cases have occurred in which valuable British inventions cannot be protected in India on this account in spite of the fact that under Article 308 valid patents will be obtainable in such cases in Germany.

By making it possible for British and other patentees to obtain valid Indian patents in these and similar instances, the proposed legislation may be expected to give an additional impetus to the progress of Indian industries, by the introduction and establishment of fresh industries which but for the inducement of the patent grant coupled with the restriction on importation embodied in section 23 of the present Indian Act, might otherwise be permanently excluded from India.

In order to remove these and similar difficulties, it is necessary that the inter-imperial arrangement should be initiated during the life of the Indian Patents and Designs (Temporary Rules) Act, 1915, and it is important therefore that this Bill should proceed at once.

Simla, the 17th August, 1920.

T. H. HOLLAND,

A. P. MUDDIMAN,  
Secretary to the Government of India.

**ACT NO. XXIX OF 1920.****(Passed by the Indian Legislative Council.)****(Received the assent of the Governor-General on the 2nd September, 1920).****AN ACT FURTHER TO AMEND THE INDIAN PATENTS AND DESIGNS ACT, 1911.**

Whereas it is expedient further to amend the Indian Patents and Designs Act, 1911; it is hereby enacted as follows:—

1. **Short Title.**—This Act may be called the Indian Patents and Designs (Amendment) Act, 1920.

2. **Insertion of new section 78-A in Act II of 1911.**—After section 78 of the Indian Patents and Designs Act, 1911, the following heading and section shall be inserted, namely:—

Reciprocal arrangements with the United Kingdom and other parts of His Majesty's dominions.

**“78A. Reciprocal arrangements with the United Kingdom and other parts of His Majesty's dominions.**—(1) If His Majesty is pleased by Order in Council to apply such of the provisions of section 91 of the Patents and Designs Act, 1907, as relate to inventions or designs, to British India, then any person who has applied for protection for any invention or design in the United Kingdom shall be entitled to a patent for his invention or to registration of his design under this Act, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the United Kingdom:

Provided that—

- (a) the application is made in the case of a patent within twelve months and, in the case of a design within four months from the application for protection in the United Kingdom, and
  - (b) nothing in this section shall entitle the patentee or the proprietor of the design to recover damages for infringements happening prior to the actual date on which in the case of a patent, his application is accepted or, in the case of a design, the design is registered, in British India.
- (2) The patent granted for an invention or the registration of design shall not be invalidated—
- (a) in the case of a patent by reason only of the publication of a description of, or use of, the invention, or
  - (b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design, in British India during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent or the registration of a design under this section must be made in the same manner as an ordinary application under this Act: Provided that, in the case of a patent, if the application is not accepted within twelve months from the date of the application for protection in the United Kingdom, the specification and the drawings (if any) supplied therewith shall be open to public inspection at the expiration of that period.

(4) Where it is made to appear to the Governor-General-in-Council that the legislature of any other part of His Majesty's dominions has made satisfactory provision for the protection of inventions or designs patented or registered in British India the Governor-General-in-Council may, by notification in the “Gazette of India,” direct that the provisions, if any, as may be set out in such notification, shall apply for the protection of inventions or designs patented or registered in that part of His Majesty's dominions.”



## OBJECTS AND REASONS OF THE BILL CULMINATING IN ACT VII OF 1930.

Extract from the "Gazette of India" dated 22nd September, 1928.

Bills introduced in the Council of State and Legislative Assembly, Reports of  
Select Committee presented to the Council and Assembly and Bills  
published under Rule 18 of the Indian Legislative Rules.

### GOVERNMENT OF INDIA.

#### Legislative Department.

The following Bill was introduced in the Legislative Assembly on the  
17th September, 1928:—

L. A. Bill No. 33 of 1928.

A Bill to amend the Indian Patents and Designs Act, 1911, for certain purposes.  
(Here follows the text of the Bill).

### STATEMENT OF OBJECTS AND REASONS.

The existing Indian Patents and Designs Act, 1911 (II of 1911) was passed in 1911 and came into effect in 1912. Experience has indicated a number of directions in which amendments are required; and it is now proposed to revise it. The amendments which it is desired to make are drawn from several sources. A few of them are taken from the British Act of 1907 (on which the present Indian Act is based) and were omitted from the Indian Act as they were not considered necessary in the conditions then existing in India. A considerable number are based on the provisions of the British Patents and Designs Act of 1919 which represented a fairly general revision of the 1907 Act in the light of the experience gained from its working. Others are designed to remove defects which experience in India has revealed and a few drafting amendments have been added. The amendments are explained in the detailed notes on clauses below:—

### NOTES ON CLAUSES.

Clause 2 (a).—The existing definition admits of some ambiguity; the proposed definition is based on that adopted in the British Act of 1919.

(b).—The revised definition of "patentee" substitutes the registered owner for the beneficial owner, and follows the definition adopted in the United Kingdom in 1919.

(c).—The amendment is designed to bring the definition into line with section 43(1) of the Act.

Clause 3.—In the case of applications comprising more than one invention it is sometimes necessary to submit amended applications for each invention and the Controller has discretion under section 5(1) to grant to such separate applications the date on which they are amended. If the sub-section is revised in the manner proposed, the Controller will have the power to grant the date of the original application to the separate subsequent applications.

Clause 4.—Under section 8 of the Act the Governor-General-in-Council can direct the Controller to refer the specification for enquiry after the acceptance of an application and before sealing a patent but in the absence of opposition a patent cannot be refused as a result of such enquiry. The section has therefore proved to be valueless.

Clause 5.—Section 9(1) of the Act allows a period of three months within which a notice of opposition can be entered. This period has proved inadequate in some cases, and it is proposed to add to this period the time required to supply a copy of the specification. The amendment proposed follows a general legal principle.

Clause 6(1).—The amendment will enable the Controller to proceed with an application for a patent when the applicant has assigned it to another party and refuses to proceed with the application or when disputes arise between joint applicants. It follows in substance the provision made in the United Kingdom Act of 1919.

Clause 6(2) (i).—This is consequential to the amendment in clause 4.

(ii).—The first amendment makes clause (d) of section 10(2) applicable to any case where a patent cannot be sealed within the time ordinarily allowed. The second amendment is based on an existing provision in the Patents and Designs Rules which has proved satisfactory.

Clause 7.—The object is to make the time when proceedings can be taken in respect of an infringement more definite.

Clause 8.—The object is to enlarge the provision contained in section 13(2) so as to enable a patent to be given to the true inventor not merely in case where the Court has revoked the patent, but also in cases where the Controller has refused a patent on account of the opposition of the true inventor.

Clause 9(a).—This amendment will extend the period of future patents from 14 years to 16 years, following the recommendations of the Empire Patents Conference and the alteration made in the British Law in 1919.

(b) This amendment has the effect of extending the period of existing patents from 14 to 16 years. It also makes necessary provision for the protection of licences and other parties who might be adversely affected by the change.

Clause 10(a).—The advertisement of a petition for extension of a patent before actually filing it as provided in section 15(1) of the Act is unnecessary. The amendment will make it possible to call on the patentee to advertise his application after filing his petition.

(b) Fees are already charged for opposition to grants, amendments or restoration of patents, and it is desirable that a fee should be levied for opposition to an extension of a patent. A fee is levied in similar cases in the United Kingdom.

(c) In view of the enlargement of the original period of patents from 14 to 16 years, it is proposed following the British Act of 1919, to reduce the terms for which extensions can be granted.

Clause 11.—This amendment introduces a new provision which will enable a patentee to add to his original patent improvements having the same term as the original patent without incurring the expense involved in taking out separate patents.

Clause 12.—Under section 18 a Court can permit a patentee to amend his specification only by way of disclaimer. It is proposed to extend the power of the Court so as to permit it to allow a patentee to amend his specification also by way of correction or explanation.

Clause 13.—This is a verbal amendment which follows the British Act, and makes the time for the grant of relief under section 19 of the Act more precise.

Clause 14.—The words deleted appear in a modified form in the proposed new sub-section (4) of section 63 (see clause 26.)

Clause 15.—Under the existing Act Government have the right to use any invention either without payment or on such terms as they may consider reasonable. The new provision maintains the existing position where the patentees are Government Servants and the patent is related to their official work, but gives patentees in other cases the right of reference to a Court of law for the settlement of the terms that are to be applicable when the Government use their patent.

A new section has been introduced on the lines of section 30 of the United Kingdom Act of 1907 for the assignment of inventions relating to instruments, or munitions of war to Government, and for the maintenance of secrecy where necessary in respect of inventions and patents so assigned.

Clause 16.—The object of the first amendment is to make the main ground of application for the grant of compulsory licence or the revocation of a patent more clear.

The amendment to section 22(4) and the first two amendments to section 22(5) are consequential to the amendment to section 22(1).

As the present Act came into force in 1912, the words "before or after the commencement of the Act" in section 22(5) are no longer necessary.

It is proposed to delete sub-section (6) of section 22 and add a new section in similar terms but applicable both to sections 22 and 23; *vide* clause 18.

Clause 17.—Under section 23(2) if the Governor-General-in-Council is satisfied that the allegations contained in an application for the revocation of a patent are correct, he can make an order revoking the patent. The amendment is intended to empower him to grant a licence or an exclusive licence to the applicant if such remedies are justified in the circumstances of the case. The British Act also provides for such remedies.

Clause 18.—The amendments to section 23(2) necessitate the enlargement of the provision at present contained in section 22(6) so as to apply also to the grant of licences under section 23.

Clause 19.—This is a drafting amendment.

Clause 20.—Under the existing law the Court is required in a suit for infringement to call in the aid of an assessor on the request of either of the parties to the proceedings. The effect of the amendment will be that the Court will not be required to call in assessors unless all the parties agree, but it may if it thinks fit call in an assessor on the application of either party or without any application.

Clause 21.—The amendment provides for the possibility of granting relief in infringement actions in respect of valid claims in spite of the inclusions in the patent of invalid claims. The object is to prevent patentees from being penalised for *bona fide* mistakes. The amendment follows the provisions of the British Act of 1919.

Clause 22.—The object of these amendments is to extend the liability imposed on patentees to persons who have a beneficial interest in patents. The amendments follow the English law.

Clause 23.—The amendment to clause (a) of section 44 brings the section into line with section 43(1).

The existing section 44 can be used to extend the copyright of a design if supplementary registration is effected in another class for the same design. This was obviously not the intention. The duration of the supplementary registration of a design should not exceed that of the original design, and the amendment to clause (b) of section 44 provides for this.

Clause 24.—The existing law is obscure as to the extent to which parties are entitled to secure cancellation of designs. The proposed section 51A, which is based on the analogy of patents, will make the position clear.

The object of the new section 51B is to bring the law relating to designs in so far as rights against the Crown are concerned into line with the law relating to patents.

Clause 25.—This is consequential on the insertion of the new section 51A.

Clause 26(a).—The alterations in sub-sections (1) and (2) of section 63 are essentially of a drafting character.

The object of the new sub-section (4) of section 64 is to prevent the admission in evidence, save in exceptional circumstances, in proof of the title to a patent or design, of a document or instrument not entered in the register of the Patent Office. This sub-section follows the provisions of the English Law of 1919 and replaces the provision at present contained in section 20(4) (see note on clause 14).

Clause 27.—The object of the amendment is to make it clear that the section provides only for applications which relate to the rectification of errors in the register and that questions regarding the merits of patents or designs cannot be raised in connection with applications under it. It is undesirable that applications of this character should go before the High Court in the first instance, and it is proposed to make the Controller the competent authority to dispose of them, an appeal lying from his order to the High Court.

Clause 28.—This is based on the British Act and provides for an appeal to the Governor-General-in-Council against the Controller's decision.

Clause 29.—Under section 65 of the Act the Controller has power to award costs in any proceedings before him. The clause will enable the Controller or the Court dealing with parties offering opposition or applying for revocation or preferring appeals to require security for the cost of proceedings, where they do not reside or carry on business in British India.

Clause 30(1).—Under the existing Act fees are payable in cash. The clause will enable fees to be paid through treasuries or the Imperial Bank, if necessary.

The new sub-clause (*ccc*) is consequential on the insertion of the new section 21A; *vide* clause 15.

(2) Under section 77(2) of the Act all rules are made after previous publication. This is not considered desirable in the case of rules made for ensuring secrecy of patents relating to munitions of war. The new provision follows the British Act.

Clause 31.—The first amendment which extends the period for applications under reciprocal arrangements in the case of designs is based on a recommendation made by the last International Conference at The Hague. A similar change has recently been made in Great Britain.

The second amendment will enable reciprocal arrangements to be made between British India and Indian States.

Clause 32.—The existing scale of fees has remained unchanged since 1912. Only valuable patents are kept on for a long number of years, and in such cases the amount of the fees is normally small compared with the profits earned. A slight increase in the fees has been proposed for the 9th, 13th and 14th year of a patent. It is proposed to fix the fees for the 15th and 16th year of patents at Rs. 150 (*vide* clause 9). A similar rate has been prescribed for extended patents and for new patents granted after the original patents have expired.

Sd. A. C. McWATTERS;

L. GRAHAM,

12th September, 1928.

Secy. to the Government of India.

## REPORT OF THE SELECT COMMITTEE ON THE BILL CULMINATING IN ACT VII OF 1930.

Extracts from the "Gazette of India," Part V, dated 28th September, 1929.

Bills introduced in the Council of State and Legislative Assembly, Reports of Select Committees presented to the Council and Assembly and Bills published under Rule 18 of the Indian Legislative Rules.

### GOVERNMENT OF INDIA.

#### Legislative Assembly Department.

The following Report of the Select Committee on the Bill further to amend the Indian Patents and Designs Act, 1911, for certain purposes, was presented to the Legislative Assembly on 25th September, 1929.

**Paper Nos. I-IV.**—We, the undersigned Members of the Select Committee to which the Bill further to amend the Indian Patents and Designs Act, 1911, for certain purposes was referred, have considered the Bill and the papers noted in the margin, and have now the honour to submit this our Report, with the Bill as amended by us annexed thereto.

Clause (3) (a) (iii).—In the new proviso we have substituted the word "other" for the word "additional" to make the meaning clear.

We have also made an amendment of substance, designed to avoid hardship to applicants. Unless the Controller has power to fix later dates, as proposed by us, it may happen that the time for acceptance of additional applications prescribed in sub-section (4) of section 5 will be over before these applications can be properly examined and accepted. We have further provided that the date borne by the application shall for all purposes be deemed to be the date on which it was made. The amendment follows the English practice. At the same time, we consider it advisable that the Controller's discretion in fixing dates should be curtailed, and we recommend that a rule should be made under section 77 restricting the fixing of the date of an additional application to within one month of the date of the original application. If this is found to be insufficient in practice, the period may be extended.

Clause 3(b).—It has been held that an application under section 5(4) for extension of time made after the expiry of twelve months from the date of the application cannot be granted inasmuch as the application will already have become void. We understand that it is convenient from the administrative point of view that such applications should be granted, and this sub-clause is designed to permit of this.

Clause 5.—We felt that there was substance in the criticisms of clause 5 on the ground of vagueness, and have preferred simply to substitute an extension from three to four months for the more intricate provision relating to the time requisite for obtaining copies of the specification. We are of opinion that that time is fairly represented by one month but hope that the operation of this new provision will be carefully watched with a view to ascertaining its adequacy.

Clause 6(1).—We have introduced some drafting amendments designed to indicate that a direction by the Controller is not a "decision" such as is referred to in section 9(3) of the Act.

Clause 6(2) (ii).—We have made an addition necessitated by the fact that various provisions of section 10 of the Act allow various periods for sealing a patent.

Clause 9(c) is designed to achieve, *mutatis mutandis*, an object similar to that mentioned above in connection with clause 3(b).

Clause 15.—Opinions received on proposed section 21 disclose some apprehension that irresponsible persons may be permitted to issue written authorisations on behalf of Government departments. We have preferred to revert to the precise wording of the proviso to existing section 21, which does not appear to have caused any inconvenience in practice.

We have also, in deference to opinion received, provided in sub-sections (2) and (3) of proposed section 21 that notice should be given to the inventor or patentee.

The other changes in this clause are of a drafting nature.

Clauses 24 and 27(c).—We do not consider that the interposition of the Governor-General-in-Council between the Controller and the High Court in the matter of references under proposed section 51A(2) and proposed sub-section (3) of existing section 64 serves any useful purpose. We have therefore omitted this provision in each case.

Clause 28A.—We have extended the period of limitation for appeals under section 70 from two to three months. The shorter period has in practice been found too short for appeals in India and *a fortiori* for overseas appeals.

2. Our attention has been directed by the opinions received to the fact that section 7 of the Statute 7 Edward VII c. 29 contains more elaborate provisions for preliminary examination of an application than those contained in the Indian Act. We have reason to believe that an amplification of the Indian Act on the lines of the British Statute would be conducive to the interests of applicants, who, in existing conditions, possibly suffer loss by being encouraged to expend money on inventions when applications for patents in respect of them have not been summarily rejected. We desire to place on record our opinion that this question deserves careful examination by Government.

3. Opinions received also disclose a considerable volume of opinion in favour of registration of trade marks. We understand that the absence of such registration is one of the reasons which prevent India participating in the International Convention for the Protection of Industrial Property and we have reason to believe that India's want of participation in this Convention affects prejudicially the interests of Indian inventors in foreign countries in certain matters. We feel, however, that this subject is not strictly germane to the present Bill and content ourselves with the suggestion that it be examined by Government.

4. The Bill was published as follows:—

#### IN ENGLISH.

Gazette.			Date.
Gazette of India	...	...	17th September, 1928
Fort Saint George Gazette	...	...	2nd October, 1928
Bombay Government Gazette	...	...	1st November, 1928
Calcutta Gazette	...	...	25th October, 1928
United Provinces Gazette	...	...	3rd November, 1928
Punjab Government Gazette	...	...	23rd November, 1928
Burma Gazette	...	...	3rd November, 1928
Central Provinces Gazette	...	...	6th October, 1928
Assam Gazette	...	...	3rd October, 1928
Bihar & Orissa Gazette	...	...	10th October, 1928
Coorg District Gazette	...	...	1st November, 1928
North West Frontier Gazette	...	...	2nd November, 1928

#### IN THE VERNACULARS.

Province.	Language.	Date.
Madras	Tamil	1st January, 1929
	Telugu	8th January, 1929
	Hindustani	8th January, 1929
	Kanarese	11th December, 1928
	Malayalam	8th January, 1929
Bombay	Marathi	6th November, 1928
	Gujrathi	6th November, 1928
	Kanarese	6th November, 1928
Coorg	Kanarese	2nd January, 1929

5. We think that the Bill has not been so altered as to require re-publication, and we recommend that it be passed as now amended.

PURSHOTAMDAS THAKURDAS.  
B. N. MITRA.  
LALCHAND NAVALRAI.  
GANGANAND SINGHA.  
M. ANWAR-UL-AZIM.

The 21st September, 1929.

## ACT NO. VII OF 1930.

[Passed by the Indian Legislature.]

(Received the assent of the Governor-General on the 16th March, 1930).

**AN ACT FURTHER TO AMEND THE INDIAN PATENTS AND DESIGNS ACT, 1911, FOR CERTAIN PURPOSES.**

Whereas it is expedient further to amend the Indian Patents and Designs Act, 1911, for the purposes hereinafter appearing: It is hereby enacted as follows:—

1. **Short title and commencement.**—(1) This Act may be called the Indian Patents and Designs (Amendment) Act, 1930.

(2) It shall come into force on the 1st day of July, 1930.

2. **Amendment of section 2, Act II of 1911.**—In section 2 of the Indian Patents and Designs Act, 1911 (hereinafter referred to as the said Act),—

(a) for clause (5) the following clause shall be substituted, namely:—

“(5) ‘design’ means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in section 478, or property mark as defined in section 479, of the Indian Penal Code;”;

(b) for clause (12) the following clause shall be substituted, namely:—

“(12) ‘patentee’ means the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent;”;

(c) in clause (14), for the words “new and original” the words “new or original” shall be substituted.

3. **Amendment of section 5, Act II of 1911.**—In section 5 of the said Act,—

(a) in sub-section (1),—

(i) in clause (b), the words “or relate to more than one invention” shall be omitted;

(ii) after clause (c) the following shall be inserted, namely:—

“or

(f) the specification relates to more than one invention;”;

(iii) the following proviso shall be added to the sub-section, namely:—

“Provided that, when a specification comprises more than one invention, the application shall, if the Controller or the applicant so requires, be restricted to one invention and the other inventions may be made the subject-matter of fresh applications; and any such fresh application shall be proceeded with as a substantive application, but the Controller may, in his discretion, direct that any such fresh application made before the acceptance of the original application shall bear the date of the original application or such later date as he may fix, and the fresh application shall be deemed, for the purposes of this Act, to have been made on the date which it bears in accordance with such direction.”;

(b) in sub-section (4), for the proviso the following proviso shall be substituted, namely:—

“Provided that where, before, or within three months after, the expiration of the said period of twelve months, a request is made to the Controller for an extension of time by any period not exceeding three months, the application shall, on payment of the prescribed fee, be continued or revived, as the case may be, during, but not beyond, the period of extension so requested.”

4. **Omission of section 8 from Act II of 1911.**—Section 8 of the said Act shall be omitted.

**5. Amendment of section 9, Act II of 1911.**—In sub-section (1) of section 9 of the said Act, for the word “three” the word “four” shall be substituted.

**6. Amendment of section 10, Act II of 1911.**—(1) After sub-section (1) of section 10 of the said Act the following sub-section shall be inserted, namely:—

“(1A) Notwithstanding anything contained in sub-section (1), where—

(a) an applicant has agreed in writing that on the grant to him of a patent he will assign it to another party or to a joint applicant and refuses to proceed with the application, or

(b) disputes arise between joint applicants as to proceeding with an application,

the Controller, if he is satisfied of the existence of such agreement or, in any other case, that any joint applicant or applicants ought to be allowed to proceed alone, may direct that such other party or joint applicant or applicants may proceed with the application accordingly and may grant a patent to him or them, as the case may be:

Provided that—

(i) the Controller shall not give any such direction until every party interested has had an opportunity of being heard by him, and

(ii) an appeal from any such direction shall lie to the Governor-General-in-Council.”

(2) In sub-section (2) of the same section.—

(i) in clause (b) of the proviso, the words “or by a reference under section 8,” shall be omitted; and

(ii) in clause (d), for the words “in consequence of the neglect or failure of the applicant to pay any fee” the words “for any reason” shall be substituted; after the words “allowed by” the words “any of the foregoing provisions of” shall be inserted; and for the words “to such an extent as may be prescribed” the words “to the extent applied for but not exceeding three months” shall be substituted.

**7. Amendment of section 11, Act II of 1911.**—In section 11 of the said Act, for the words “publication of the specification” the words “advertisement of the acceptance of the application” shall be substituted.

**8. Amendment of section 13, Act II of 1911.**—For sub-section (2) of section 13 of the said Act the following sub-section shall be substituted, namely:—

“(2) Where a patent has been revoked by the High Court on the ground that it has been obtained in fraud of the true and first inventor, or where the grant of a patent has been refused by the Controller under section 9 on the ground stated in clause (a) of sub-section (1) of that section, the Controller may, on the application of the true inventor or his legal representative or assign made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention and the patent so granted shall bear the same date as the patent so revoked or, in the case of a patent the grant of which has been refused, the same date as would have been borne by the patent if it had been granted:

Provided that no suit shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.”

**9. Amendment of section 14, Act II of 1911.**—In section 14 of the said Act,—

(a) in sub-section (1), for the word “fourteen” the word “sixteen” shall be substituted;

(b) after the same sub-section the following sub-sections shall be inserted, namely:—

“(1A) Any patent the original term of which had not expired on or before the 1st day of July, 1930, shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, and any licence existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires.



- (1B) Where any party to a contract with the patentee or any other person entered into before the 1st day of January, 1930, is subjected to loss or liability by reason of the extension of the term of any patent under this section, any District Court having jurisdiction may determine in what manner and by which parties such loss or liability shall be borne;" and
- (c) in sub-section (2), for the proviso the following proviso shall be substituted, namely:—

" Provided that where the patentee, before, or within three months after, the expiration of the time for payment, applies to the Controller for an extension of time by any period not exceeding three months, the patent shall, on payment of such additional fee as may be prescribed, be continued or revived, as the case may be, during, but not beyond, the period of extension applied for."

**10. Amendment of section 15, Act II of 1911.**—In section 15 of the said Act,—

- (a) in sub-section (1), the words " after advertising in the prescribed manner his intention to do so," shall be omitted; and after the words " prescribed fee " the following shall be added, namely:—
- " and must be advertised by the patentee within the prescribed time and in the prescribed manner;"
- (b) in sub-section (2), after the word " may " the words " within such time as may be prescribed and on payment of the prescribed fee," shall be inserted; and
- (c) in sub-section (6), for the words " seven " and " fourteen " the words " five " and " ten " shall be substituted, respectively.

**11. Insertion of new section 15A in Act II of 1911.**—After section 15 of the said Act the following section shall be inserted, namely:—

" **15A. Patents of addition.**—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may in his application for the further patent request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired, and, if he does so, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(2) Save as otherwise expressly provided by this Act, a patent of addition shall remain in force as long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal:

Provided that if the patent for the original invention is revoked, then the patent of addition shall, if the authority by which it is revoked so orders, become an independent patent, and the fees payable, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(3) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent."

**12. Amendment of section 18, Act II of 1911.**—In section 18 of the said Act, after the word " disclaimer " the words " correction or explanation " shall be inserted.

**13. Amendment of section 19, Act II of 1911.**—In section 19 of the said Act, for the words " before the disclaimer, correction or explanation " the words " before the date of the decision allowing the amendment " shall be substituted.

**14. Amendment of section 20, Act II of 1911.**—In sub-section (4) of section 20 of the said Act, the words " and, unless such copies have been so supplied, such deeds, licences or other documents shall not be received as evidence of any transaction affecting a patent " shall be omitted.

15. **Substitution of new sections for section 21, Act II of 1911.**—For section 21 of the said Act the following sections shall be substituted, namely:—

“21. **Patent to bind Crown.**—(1) Subject to the other provisions of this section, a patent shall have to all intents the like effect as against His Majesty the King as it has against a subject.

(2) The officers or authorities administering any department of the service of His Majesty may, by themselves or by such of their agents, contractors or others as may be authorised in writing by them, at any time after the application, and after giving notice to the applicant or patentee, make, use or exercise the invention for the service of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Governor-General-in-Council, between such officers or authorities and the applicant or patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or licence concluded between the applicant or patentee and any person other than such officers or authorities, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown.

(3) Where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, the officers or authorities administering any department of the service of His Majesty (such invention not having been communicated directly or indirectly by the applicant or patentee), such officers or authorities, or such of their agents, contractors, or others, as may be authorised in writing by them, may, after giving notice to the applicant or patentee, make, use or exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the applicant or patentee, notwithstanding the existence of the patent. If, in the opinion of such officers or authorities, the disclosure to the applicant or patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(4) In the event of any dispute as to the making, use or exercise of an invention under this section, or the terms thereof, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the High Court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The Court, referee or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant or patentee and such officers or authorities. The Court, referee or arbitrator, further, in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the applicant or patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from such officers or authorities in respect of such patent.

Provided that, if the inventor or patentee is a Government servant and the subject-matter of the invention is certified by the Governor-General-in-Council or Local Government to be connected with work done in the course of such service, any such dispute shall be settled by the Governor-General-in-Council after hearing the applicant or patentee and any other person having an interest in the invention or patent.

(5) The right to use an invention for the services of the Crown under the provisions of this section, or any provisions for which this section is substituted, shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown.

(6) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under any law for the time being in force relating to customs or excise.

21A. **Assignment of patent to the Secretary of State for India in Council.**—(1) The inventor of any improvement in instruments or munitions

of war may (either for or without valuable consideration) assign to the Secretary of State for India in Council on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State for India in Council may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for India in Council on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by or on behalf of the Secretary of State for India in Council.

(3) Where any such assignment has been made, the Governor-General-in-Council may, at any time before the publication of the specification, certify to the Controller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Governor-General-in-Council so certify, the application and specifications, with the drawings (if any) and any amendment of the specification and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Controller in a packet sealed by authority of the Governor-General-in-Council.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Controller, and shall not be opened save under the authority of an order of the Governor-General-in-Council.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by the Governor-General-in-Council to receive it, and shall, if returned to the Controller, be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Governor-General-in-Council.

(8) Where the Governor-General-in-Council certifies as aforesaid after an application for a patent has been left at the Patent Office but before the publication of the specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Controller; and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Governor-General-in-Council.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Governor-General-in-Council as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as otherwise provided in this section, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Governor-General-in-Council may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State for India in Council or the Governor-General-in-Council or to any person or persons authorised by the Secretary of State for India in Council or the Governor-General-in-Council to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same."

**16. Amendment of section 22, Act II of 1911.**—In section 22 of the said Act,—

(a) in sub-section (1), for the words "the reasonable requirements of the public with respect to a patented invention have not been satisfied" the words "the demand for a patented article in British India is not being met to an adequate extent and on reasonable terms" shall be substituted;

(b) in sub-section (4), for the words "the reasonable requirements of the public with reference to the patented invention have not been satisfied" the words "the demand for the patented article in British India is not being met to

an adequate extent and on reasonable terms" shall be substituted; and for the words "the reasonable requirements of the public will not be satisfied" the words "the demand will not be adequately met" shall be substituted;

(c) in sub-section (5),—

(i) for the words "the reasonable requirements of the public shall not be deemed to have been satisfied" the words "the demand for a patented article shall not be deemed to have been met to an adequate extent and on reasonable terms" shall be substituted;

(ii) in clause (a), the words "or the demand for the patented article or the article produced by the patented process is not reasonably met" shall be omitted; and

(iii) in clause (b), the words "before or after the commencement of this Act" shall be omitted; and

(d) sub-section (6) shall be omitted.

**17. Amendment of section 23, Act II of 1911.**—In section 23 of the said Act,—

(a) in sub-section (1), for the words "for the revocation of the patent" the words "for relief under this section" shall be substituted; and

(b) in sub-section (2), after the words "may make an order" the letter and brackets "(a)" shall be inserted, and after clause (ii) the following shall be added, namely:—

"or

(b) ordering the patentee to grant a licence to the applicant which may be a licence exclusive to him or otherwise as the Governor-General-in-Council may direct."

**18. Insertion of new section 23A in Act II of 1911.**—After section 23 of the said Act the following section shall be inserted, namely:

"23A. **Operation of order under section 22 or section 23.**—An order of the High Court under section 22 or of the Governor-General-in-Council under section 22 or section 23, directing the grant of any licence, shall, without prejudices to any other method of enforcement, operate as if were embodied in a deed granting a licence and executed by the patentee and all other necessary parties."

**19. Amendment of section 26, Act II of 1911.**—In clause (g) of sub-section (1) of section 26 of the said Act, for the words "a part," in both places where they occur, the words "the whole or a part" shall be substituted.

**20. Amendment of section 35, Act II of 1911.**—In sub-section (1) of section 35 of the said Act, for the words "either of" the word "all" shall be substituted.

**21. Insertion of new section 35A in Act II of 1911.**—After section 35 of the said Act the following section shall be inserted, namely:—

"35A. **Grant of relief in respect of particular claims.**—Notwithstanding anything contained in section 19, if the Court in any action for infringement of a patent finds that any one or more of the claims in the specification in respect of which the infringement is alleged are valid, it may, subject to its discretion as to costs and as to the date from which damages should be reckoned and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion the Court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there."

**22. Amendment of section 36, Act II of 1911.**—In section 36 of the said Act,—

(1) for the words "to be the patentee of an invention" the words "to have an interest in a patent" shall be substituted;

(2) for the words "any legal rights of the person making such threats" the words "the patent" shall be substituted; and

(3) for the proviso the following shall be substituted, namely:—

"Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence."

**23. Amendment of section 44, Act II of 1911.**—In section 44 of the said Act,—

(1) in clause (a), for the words “new and original design” the words “new or original design” shall be substituted; and

(2) after clause (b) the following proviso shall be added, namely:—

“Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.”

**24. Insertion of new sections 51A and 51B in Act II of 1911.**—After section 51 of the said Act the following sections shall be inserted, namely:—

“51A. **Cancellation of registration.**—(1) Any person interested may present a petition for the cancellation of the registration of a design—

(a) at any time after the registration of the design, to the High Court on any of the following grounds, namely:—

(i) that the design has been previously registered in British India; or

(ii) that it has been published in British India prior to the date of registration; or

(iii) that the design is not a new or original design; or

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).

(2) An appeal shall lie from any order of the Controller under this section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

51B. **Registration of designs to bind the Crown.**—The provisions of section 21 shall apply to registered designs as if those provisions were re-enacted herein and in terms made applicable to registered designs.”

**25. Amendment of section 62, Act II of 1911.**—In section 62 of the said Act, clause (b) shall be omitted.

**26. Amendment of section 63, Act II of 1911.**—In section 63 of the said Act,—

(a) for sub-sections (1) and (2) the following sub-sections shall be substituted, namely:—

“ (1) Where a person becomes entitled by assignment, transmission or other operation of law to a patent or to the copyright in a registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design, and shall cause an entry to be made in the prescribed manner in the register of the assignment, transmission or other instrument affecting the title.

(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a patent or registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest”; and

(b) after sub-section (3) the following sub-section shall be added, namely:—

“ (4) Except in the case of an application made under section 64, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) shall not be admitted in evidence in any Court in proof of the title to a patent or to copyright in a design or to any interest therein, unless the Court, for reasons to be recorded in writing, otherwise directs.”

**27. Amendment of section 64, Act II of 1911.**—In section 64 of the said Act,—

(a) in sub-section (1), for the words “A High Court” the words “The Controller” and for the words “as it may think fit” the

words "as he thinks fit and rectify the register accordingly" shall be substituted, respectively;

(b) in sub-section (2), for the word "Court" the word "Controller" shall be substituted;

(c) for sub-section (3) the following sub-section shall be substituted, namely:—

"(3) An appeal shall lie to the High Court from any order of the Controller under this section; and the Controller may refer any application under this section to the High Court for decision, and the High Court shall dispose of any application so referred."; and

(d) for sub-section (5) the following sub-section shall be substituted, namely:—

"(5) Nothing in this section shall be deemed to empower the Controller—

(a) to rectify the register of patents, or to decide any question relating to a patent, otherwise than for the purpose of correcting a mistake of fact apparent from a reference either to the patent itself or to some order of a competent authority made under any other provision of this Act, or

(b) to make any such order cancelling the registration of a design as is provided for in section 51A."

28. **Amendment of section 69, Act II of 1911.**—Section 69 of the said Act shall be re-numbered as sub-section (1) of that section, and to that section as so re-numbered the following sub-section shall be added, namely:—

"(2) An appeal shall lie to the Governor-General-in-Council from an order of the Controller under this section."

29. **Amendment of section 70, Act II of 1911.**—In section 70 of the said Act, for the word "two" in both places where it occurs, the word "three" shall be substituted.

30. **Insertion of new section 74A in Act II of 1911.**—After section 74 of the said Act the following section shall be inserted, namely:—

"74A. **Security for costs.**—Where a person giving notice of any opposition under this Act or giving notice to the Court of Appeal from any decision of the Controller under this Act, neither resides nor carries on business in British India, the Controller or the Court, as the case may be, may require such person to give security for the payment of all costs incurred and likely to be incurred in the proceedings or appeal, as the case may be, and, in default of such security being given, may disallow the opposition or dismiss the appeal."

31. **Amendment of section 77, Act II of 1911.**—In section 77 of the said Act,—

(1) after clause (e) of sub-section (1) the following clauses shall be inserted, namely:—

"(ee) for the manner in which fees leviable under this Act may be paid;

(eee) for ensuring secrecy with respect to patents to which section 21A applies,"; and

(2) after sub-section (2) the following sub-section shall be inserted, namely:—

"(2A) Nothing in sub-section (2) shall apply in the case of rules made for the purpose specified in clause (eee) of sub-section (1); and any such rules may modify any of the provisions of this Act so far as may be necessary for that purpose."

32. **Amendment of section 78A, Act II of 1911.**—In section 78A of the said Act,—

(1) in clause (a) of the proviso to sub-section (1), for the word "four" the word "six" shall be substituted; and

(2) in sub-section (4), after the words "His Majesty's dominions," where they first occur, the words "or of any State in India," and after those words where they occur for the second time, the words "or in that State, as the case may be," shall be inserted.

33. **Amendment of the Schedule to Act II of 1911.**—In the Schedule to the said Act, in the entry specifying the fee payable before the expiration of the 8th year from the date of a patent, for the figures “50” the figures “100” shall be substituted, and for the last five entries the following shall be substituted, namely:—

	Rs.
“ Before the expiration of the 12th year from the date of the patent ... ..	150
Before the expiration of the 13th year from the date of the patent ... ..	150
Before the expiration of the 14th year from the date of the patent ... ..	150
Before the expiration of the 15th year from the date of the patent ... ..	150
Provided that the fees for two or more years may be paid in advance.	
On application to extend the term of a patent ...	50
Before the expiration of each year of the extended term of a patent or of a new patent granted under section 15 ...	150
On application for registration of a design ...	3”

## A NOTE REGARDING STAMP DUTY PAYABLE IN BRITISH INDIA IN RESPECT OF THE ASSIGNMENT OF A PATENT.

(N.B.—See page 590 above).

The following are certain relevant provisions of the Indian Stamp Act, 1899:—

### THE INDIAN STAMP ACT, 1899.

(Act II of 1899.)

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## CHAPTER II.

### STAMP DUTIES.

#### A.—Of the Liability of Instruments to Duty.

Section 3. **Instruments chargeable with duty.**—Subject to the provisions of this Act and the exemptions contained in Schedule 1, the following instruments shall be chargeable with duty of the amount indicated in that schedule as the proper duty therefor, respectively, that is to say

- (a) every instrument mentioned in that schedule which, not having been previously executed by any person, is executed in British India on or after the first day of July 1899;
- (b) every bill of exchange (payable otherwise than on demand) or promissory note drawn or made out of British India on or after that day and accepted or paid, or presented for acceptance or payment, or endorsed, transferred or otherwise negotiated, in British India; and
- (c) every instrument (other than a bill of exchange, or promissory note) mentioned in that schedule, which not having been previously executed by any person, is executed out of British India on or after that day, relates to any property situate, or to any matter or thing done or to be done, in British India and is received in British India:

Provided that no duty shall be chargeable in respect of—

- (1) any instrument executed by, or on behalf of, or in favour of, the Government in cases where, but for this exemption, the Government would be liable to pay the duty chargeable in respect of such instrument;
- (2) any instrument for the sale, transfer or other disposition, either absolutely or by way of mortgage, of any ship or vessel, or any part, interest, share or property of or in any ship or vessel registered under the Merchant Shipping Act, 1894, or under Act XIX of 1838, or the Indian Registration of Ships Act, 1841, as amended by subsequent Acts.

*[For the provisions of the relevant Article 23, in which are specified the rates of stamp duty payable in specific instances on conveyances, see, further, below.]*

\* \* \* \*

#### D.—Of Valuation for Duty.

Section 20. **Conversion of amount expressed in foreign currencies.**—(1) Where an instrument is chargeable with *ad valorem* duty in respect of any money expressed in any currency other than that of British India, such duty shall be calculated on the value of such money in the currency of British India according to the current rate of exchange on the day of the date of the instrument.

(2) The Governor-General-in-Council may, from time to time, by notification in the "Gazette of India," prescribe a rate of exchange for the conversion of



British or any foreign currency into the currency of British India for the purposes of calculating stamp duty, and such rate shall be deemed to be the current rate for the purposes of sub-section (1).

\* \* \* \*

[N. B. By a Notification No. 8 dated 7th November 1931 a rate of exchange was duly prescribed as follows:—

(a) Where the consideration in a document is expressed in sterling:—  
£1 to be equivalent to Rs. 15-5-4.

(b) In cases of exchange monies other than sterling:—Rates of exchange to be taken at the current Bank rate.

Where an assignment of a Patent has been executed in England but is nevertheless liable to Indian stamp duty on being received in India, or where the consideration of an assignment which has been executed in India is expressed in an amount in sterling or in other non-Indian currency, the amount upon which the stamp duty is payable may be calculated under the provisions of the above-mentioned Sec. 20 and of the above-mentioned Notification.]

\* \* \* \*

### SCHEDULE 1.

#### STAMP DUTY ON INSTRUMENTS.

(See Section 3.)

Article 23. CONVEYANCE (as defined by section 2(10) not being a Transfer charged or exempted under No. 62.)

Where the amount or value of the consideration for such convey-

ance as set forth therein does not exceed Rs.	50 ...	Eight annas.
where it exceeds Rs. 50 but does not exceed Rs.	100 ...	One rupee.
where it exceeds Rs. 100 but does not exceed Rs.	200 ...	Two rupees.
where it exceeds Rs. 200 but does not exceed Rs.	300 ...	Three rupees.
where it exceeds Rs. 300 but does not exceed Rs.	400 ...	Four rupees.
where it exceeds Rs. 400 but does not exceed Rs.	500 ...	Five rupees.
where it exceeds Rs. 500 but does not exceed Rs.	600 ...	Six rupees.
where it exceeds Rs. 600 but does not exceed Rs.	700 ...	Seven rupees.
where it exceeds Rs. 700 but does not exceed Rs.	800 ...	Eight rupees.
where it exceeds Rs. 800 but does not exceed Rs.	900 ...	Nine rupees.
where it exceeds Rs. 900 but does not exceed Rs.	1,000 ...	Ten rupees.
and for every Rs. 500 or part thereof in excess of Rs. 1,000 ...		Five rupees.

[The amounts stated above for stamp duty payable for conveyances of the various differing values stated are the amounts payable throughout British India under the Indian Stamp Act of 1899. For Bengal and other Provinces there are certain high rates of stamp duty imposed under certain local provincial Acts to which reference is made below.]

The following are the relevant provisions of the Bengal Stamp Amendment Act (Bengal Act III of 1922) by which the above-mentioned provisions of the Indian Stamp Act are in certain respects modified for the Presidency (or Province) of Bengal and by which the rate of stamp duty payable is in certain cases increased for documents requiring to be stamped in the Presidency (or Province) of Bengal:—

#### THE BENGAL STAMP AMENDMENT ACT, 1922.

(Bengal Act III of 1922.)

Section 4. Amendment of section 3.—In section 3 of the said Act,—

(1) after clause (c) the following shall be inserted, namely:—

“ Provided that except as otherwise expressly provided in this

Act, and notwithstanding anything contained in clauses (a), (b) or (c) of this section or in Schedule 1, the amount indicated in Schedule 1A to this Act shall, subject to the exemptions contained in that schedule, be the duty chargeable under this Act on the following instruments, mentioned in clauses (aa) and (bb) of this proviso, as the proper duty therefor respectively—

- (aa) Every instrument, mentioned in Schedule 1A as chargeable with duty under that schedule, which, not having been previously executed by any person, is executed in Bengal on or after the first day of April, 1922; and
  - (bb) Every instrument mentioned in Schedule 1A as chargeable with duty under that schedule which, not having been previously executed by any person, is executed out of Bengal on or after the first day of April, 1922, and relates to any property situated, or to any matter or thing done or to be done in Bengal, and is received in Bengal";
- (2) after the word " Provided " the word " also," shall be inserted.

\* \* \* \*

Section 8. After section 19 of the said Act the following shall be inserted, namely:—

**" 19A. Payment of duty on certain instruments liable to increased duty in Bengal under clause (bb) of section 3.**—Where any instrument has become chargeable in any part of British India other than Bengal with duty under this Act or under any other law for the time being in force in any part of British India and thereafter becomes chargeable with a higher rate of duty in Bengal under clause (bb) of the first proviso to section 3—

- (i) notwithstanding anything contained in the first proviso to section 3, the amount of duty chargeable on such instrument shall be the amount chargeable on it under Schedule 1A less the amount of duty, if any, already paid on it in British India;
- (ii) in addition to the stamps, if any, already affixed thereto, such instrument shall be stamped with the stamps necessary for the payment of the amount of duty chargeable on it under clause (i) in the same manner and at the same time and by the same persons as though such instrument were an instrument received in British India for the first time at the time when it became chargeable with the higher duty."

\* \* \* \*

Section 13. **New Schedule 1A.**—After Schedule 1 to the said Act the following shall be inserted, namely:—

#### " SCHEDULE 1A.

**Stamp duty on certain instruments under the Bengal Stamp (Amendment) Act, 1922.**

(See section 3, first proviso).

{*Note.*—The articles in Schedule 1A are numbered so as to correspond with similar articles in Schedule 1).

Article 23. CONVEYANCE (as defined by section 2(10), not being a Transfer charged or exempted under No. 62.)

Where the amount or value of the consideration for such conveyance as set forth therein does not exceed Rs. 50	...	Twelve annas.
where it exceeds Rs. 50 but does not exceed Rs. 100	...	One rupee eight annas.
where it exceeds Rs. 100 but does not exceed Rs. 200	...	Three rupees.
where it exceeds Rs. 200 but does not exceed Rs. 300	...	Four rupees eight annas.
where it exceeds Rs. 300 but does not exceed Rs. 400	...	Six rupees.
where it exceeds Rs. 400 but does not exceed Rs. 500	...	Seven rupees eight annas.
where it exceeds Rs. 500 but does not exceed Rs. 600	...	Nine rupees.
where it exceeds Rs. 600 but does not exceed Rs. 700	...	Ten rupees eight annas.
where it exceeds Rs. 700 but does not exceed Rs. 800	...	Twelve rupees.
where it exceeds Rs. 800 but does not exceed Rs. 900	...	Thirteen rupees eight annas.
where it exceeds Rs. 900 but does not exceed Rs. 1,000	...	Fifteen rupees.
and for every Rs. 500 or part thereof in excess of Rs. 1,000	...	Seven rupees eight annas

#### Exemption.

Assignment of copyright under the Indian Copyright Act, 1914, section 5."

The recent Bengal Act of 1935, the Indian Stamp (Bengal Amendment) Act, which in certain other respects made certain further amendments regarding the amount of stamp duty payable in certain other cases in Bengal, does not affect in any respect the rate of duty payable in respect of conveyances; and consequently does not appear to affect at all the question of the stamp duty payable on an assignment of a Patent.

For certain other Provinces also, certain higher rates of stamp duty have from time to time been imposed by various local provincial Acts.

As to these:

For Assam, see:—

Assam Act 3 of 1922 (effective for a period of three years).

Assam Act 2 of 1925 (effective for a renewed period of another three years which expired on 30th April, 1928.)

For Bombay, see:—

Bombay Act 2 of 1922 (effective for a period of four years).

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Bombay Act 1 of 1930.

Bombay Act 2 of 1931.

The Bombay Finance Act 2 of 1932 (Part IV).

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Bombay Act 6 of 1932.

Bombay Act 1 of 1933.

Bombay Act 1 of 1934.

For the Central Provinces, see:—

Central Provinces Act 2 of 1923 (effective for a period of three years which expired on 31st March, 1926).

For Madras, see:—

Madras Act 6 of 1922.

Madras Act 6 of 1923 (current and in force).

For the Punjab, see:—

Punjab Act 8 of 1922.

Punjab Act 1 of 1923 (current and in force).

For the United Provinces, see:—

United Provinces Act 5 of 1923 (effective for one year).

United Provinces Act 2 of 1924 (effective so as to extend the period to a period of two years only).

United Provinces Act 4 of 1932 (effective for two years).

United Provinces Act II of 1934 (effective for an extended period which expired on 30th June, 1934).

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See also Mulla and Pratt's Indian Stamp Act (3rd Edn., 1935) at p. 221 and at p. 302.

**CALCUTTA HIGH COURT (JURISDICTION LIMITS) ACT.****ACT NO. XV OF 1919.**

(See page 684 above.)

**AN ACT TO DECLARE AND PRESCRIBE THE LIMITS OF THE ORDINARY ORIGINAL CIVIL JURISDICTION OF THE HIGH COURT OF JUDICATURE AT FORT WILLIAM IN BENGAL.**

Whereas clause 11 of the Letters Patent for the High Court of Judicature at Fort William in Bengal dated the 28th December 1865, provides that the said High Court shall have and exercise ordinary original civil jurisdiction within such local limits as may from time to time be declared and prescribed by any law made by competent legislative authority for India:

And whereas it is expedient so to declare and prescribe the local limits of the ordinary original civil jurisdiction of the said High Court;

It is hereby enacted as follows:—

1. **Limits of original civil jurisdiction.**—This Act may be called the Calcutta High Court (Jurisdictional Limits) Act, 1919.

2. The ordinary original civil jurisdiction of the High Court of Judicature at Fort William in Bengal shall be exercised within the limits set out in the Schedule.

Provided that nothing in this Act shall affect any suit or other legal proceeding, pending in any Court at the date of the commencement of this Act.

**THE SCHEDULE.**

(See Section 2.)

1. The limits within which the ordinary original civil jurisdiction of the High Court shall be exercised are as follows:—

**North.**—A line commencing on the western side of the river Hooghly at a point where the straight line joining reference pillar No. I (in a compound on the river side of the Ghusri Cotton Mills, Howrah) and reference pillar No. II (near the south-western end on Chitpur Toll Bridge) meets the western water-line of the river Hooghly, and thence along the said line to the point where it meets the eastern water-line of the river Hooghly near the south bank of the opening of Circular Canal; thence along the water-line of the south bank of Circular Canal passing under the Chitpur Toll Bridge, the Chitpur or Baghbazar Bridge to boundary pillar A on the eastern side of the southern pile of Barrackpore Bridge.

**East.**—A line commencing from the said boundary pillar A following the eastern edge of the steps of the bridge to a point near the south-eastern corner of the immediate approach to the bridge marked by reference pillar III, which is on the boundary; thence by a straight line to boundary pillar B on the south-eastern corner of the junction of Cornwallis Street and Galif Street (now marked with a Public Works Department stone); thence along the eastern side and the eastern side of the eastern pavement of Cornwallis Street in a series of regular links joining points marked by posts 1—3 to boundary pillar C at the north corner of the junction of Shambazar Street with Cornwallis Street; thence by a straight line to boundary pillar D on the solid south corner of the said junction; thence in an approximately straight line along the solid eastern side of Upper Circular Road marked by posts 4—9; thence eastward following the corner round to boundary pillar E on the north corner of the junction of the unnamed road (which runs into Jadu Nath Mitra Lane) with Upper Circular Road; and thence by a straight line to boundary pillar F at the solid south corner of the junction of Jadu Nath Mitra Lane with Upper Circular Road; thence by posts 10—13 to boundary pillar G on the solid south corner of the junction of Ultadingi Road with Upper Circular Road; thence along the solid south side of Ultadingi Road in a series of continuous and approximately straight lines joining points marked by posts 14—16 to boundary pillar H at the solid western corner of the junction of Ultadingi Road and Gauribere Lane; thence by the solid western side of Gauribere Lane marked by posts 17—21; thence by a straight line

crossing the road diagonally to boundary pillar I on the solid south-eastern corner of the junction of Gauribere Lane and Ultadingi Junction Lane; thence along the solid eastern side of Ultadingi Junction Lane marked by posts 22—24 to boundary pillar J on the solid eastern corner of the junction of Ultadingi Junction Lane with Halsibagan Road; thence by a straight line to post 25 at the solid western corner of the said junction; thence along the solid north side of Halsibagan Road marked by post 26 to boundary pillar K on the north side of Halsibagan Road directly opposite the solid eastern side of Upper Circular Road south of it; thence by a straight line to post 27 at the solid south corner of the junction of Halsibagan Road with Upper Circular Road; thence by the solid eastern side of Upper Circular Road marked by posts 28—34 to post 35; thence turning east to boundary pillar L on the north side of Maniktola Road; thence by a straight line to post 36 at the south corner of the junction of Maniktola Road with Upper Circular Road; at the north-western corner of the garden of Kali Pada Barik; thence along the eastern side of the line on the eastern side of the raised platform road and marked by posts 37—49 to boundary pillar M at the solid north corner of the junction of Gas Street and Upper Circular Road; thence by a straight line to boundary pillar N at the solid south corner of the said junction; thence keeping again to the eastern side of the lane on the eastern side of the raised platform road along a line marked by posts 50—61 excluding the recently-made Ladies' Park to boundary pillar O near the north pillar of the north entrance to North Station, Sealdah; thence by a straight line to boundary pillar P at the south corner of that entrance; thence by the comparatively straight lines from pillar to pillar connecting boundary pillars P, Q, R, S, and T, adjacent to the pillars forming the corners of the various approaches to Sealdah Station; thence among the solid eastern side of Lower Circular Road marked by posts 62—64 to pillar 65; thence turning west to boundary pillar U at the north-western corner of the out-patients' department of the Campbell Hospital; thence by a straight line marked by posts 66—68 to boundary pillar V on the corner of the platform to the right of the north entrance to the Calcutta Corporation Central Stores; thence by post 69 turning east to post 70; thence by posts 71—76, boundary pillars W and X at the solid corners of the southern junction of Police Hospital Road with Lower Circular Road; thence by posts 77—80, to boundary pillars Y and Z on the solid corners of the junction of Beniapukur Lane with Lower Circular Road, by posts 81—86 to boundary pillars A, and B, at the solid corners of the junction of Nonapukur or Bijli Road and Lower Circular Road, posts 87, 88, to boundary pillar C(1), near the south-western corner of the Circular Road burial ground; thence by a straight line to boundary pillar D(1) on the other side of the tramway lines; thence post 89 eastward to post 90; thence to boundary pillars E(1) and F(1) at the solid corners of the junction of Karaya Bazar Road and Lower Circular Road, posts 91, 92 to boundary pillar G(1) opposite to Theatre Road, posts 93, 94 to boundary pillar H(1), a few feet south of the point directly opposite the junction of Auckland Place and Lower Circular Road, and following the curve of the road by posts 95 and 96 to reference pillar IV (which is on the boundary) on the eastern side of the junction of Beck Bagan Lane with Lower Circular Road.

**South.**—A line commencing from the said reference pillar (V) in a straight line to boundary pillar I(1) on the western corner of the junction of Beck Bagan Lane with Lower Circular Road; thence along the solid south side of Lower Circular Road to boundary pillars J(1) and K(1) at the solid corners of the junction of Ballyganj Circular Road and Lower Circular Road; thence by the solid south side of Lower Circular Road marked by posts 97, 98, boundary pillars L(1), M(1), at the solid corners of the junction of Lansdowne Road with Lower Circular Road, post 99 southward to post 100, westward to post 101, northward to post 102 and westward to post 103, boundary pillars N(1) and O(1) at the solid corners of the junction of Woodburn Road with Lower Circular Road, posts 104, 105, boundary pillars P(1) and Q(1) at the solid corners of the junction of Lee Road with Lower Circular Road; thence by the straight line links but broken boundary line formed by posts 106—113, boundary pillar R(1) on the south-eastern corner of the junction of Chowringhee with Lower Circular Road; thence by an oblique straight line to boundary pillar S(1) on the south-western corner of the said junction (near a stone marked F. W. B-26); thence by a line representing the present limits of the holdings

on the south Circular Road and marked by posts 114—116, boundary pillars T(1) and U(1) at the solid corners of the junction of Haris Chandra Mukherji Road and Lower Circular Road posts 117—121; thence to boundary pillar V(1) near the north corner of the junction of Bhowanipore Road and Lower Circular Road; thence following the curve of the corner and the eastern side of Bhowanipore Road and the surplus lands attached thereto by a series of straight line links joining points marked by posts 122—124, boundary pillars W(1) and X(1) at the junction of Shambhunath Pandit Street and Bhowanipore Road, posts 125—128 turning eastward to boundary pillar Y(1) on the north side of Sankaripara Road, posts 129, 130, to boundary pillars Z(1) and A(2) across the entrance of Ketrapati Road into Bhowanipore Road; thence by posts 131, 132 to boundary pillar B(2) on the north-eastern side of Alipore Bridge; thence along a straight line joining the said boundary pillar B(2) with subsidiary reference pillar VII on the south-eastern side of the said bridge to a point where that straight line meets the water-line of Tolly's Nala; thence along the water-line of Tolly's Nala to the north-eastern corner of the District Magistrate's compound, near which is boundary pillar C(2); thence along the irregular northern boundary of the Magistrate's compound marked by posts 133—141 to boundary pillar D(2) at the south corner of the entrance to the Civil Surgeon's house from Thackeray Road; thence southward along the western boundary of the Magistrate's compound by posts 142—145 and along the southern boundary of that compound marked by posts 147, 148 to boundary pillar E(2) on the bank of Tolly's Nala; thence continuing the straight line from post 148 to boundary pillar F(2) till it meets the water-line of Tolly's Nala; thence along the water-line of Tolly's Nala to a point in a direct line with the north side of the masonry drain running outside the Jail Garden near which is boundary pillar F(2); thence along the north side of the said drain in a straight line across Motee Jheel to post 149 against the boundary of the compound of the Magistrate's Court; thence northward along that boundary to post 150 and westward to post 151 and northward again along the boundary of the Army Clothing Agency to post 152; thence westward on the south side of the lane to boundary pillar G(2) at the north-western corner of the Police Hospital compound; thence along the wall of the Alipore Central Jail facing Belvedere Road and marked by pillars 153—157 to the north-western corner of the junction of Belvedere Road and Jail Lane following the corner eastward to post 158 and continuing along the south side of Jail Lane to post 159; thence by a straight line to boundary pillar H(2) at the acute corner of the junction of Reformatory Street with Jail Lane; thence to boundary pillar I(2) on the north-western side of Alipore Bridge; thence to boundary pillar J(2) on the north-eastern side of the said Bridge; thence by the solid south-western and western side of Bhowanipore Road marked by posts 160—167; thence following the western corner of the junction of Bhowanipore Road and Lower Circular Road to boundary pillar K(2) thence along the solid south side of Lower Circular Road following the sweep of the railings and marked by posts 168—172 to boundary pillar L(2) on the Lower Circular Road and east of its junction with Belvedere Road; thence following the natural bends of the corner marked by posts 173 and 174 to boundary pillar M(2) on the eastern side of Belvedere Road; thence along the eastern side of Belvedere Road now indicated by wooden railings and marked by posts 175 to boundary pillar N(2) on the north-eastern side of Zeerut Bridge; thence along the railings of the footpath on the eastern side of the bridge to boundary pillar O(2) near its south-eastern end; thence along a bent line following the shape of the bridge and marked by posts 176, 177 to post 178 on the eastern side of the south extremity of the immediate approach to the bridge; thence by a straight line to boundary pillar P(2) on the western side of the said extremity; thence turning north along the railings of the footpath on the western side of the bridge till it meets the water-line underneath the bridge; thence along the water-line of the south or Alipore Bank of Tolly's Nala trending northwards under Hastings Bridge to a point where a straight line joining reference pillar V (near the south-western end of Hastings Bridge), to reference pillar VI (on the Howrah side of the river in a line with the northern wall of the Bengal-Nagpur Railway Goods Yard) meets the water-line of the south bank of the bend of the Hooghly River, near the western side of the opening of Tolly's Nala; thence continuing the said straight line till that said straight line meets the water-line of the Howrah side of the river Hooghly.

**West.**—A line commencing from the point last defined along the water-line of the Howrah side of the river Hooghly to the western extremity of the northern boundary.

2. (a) When the expression "water-line" is used in this schedule all pucca ghats and other objects permanently attached to the bank and in contact with the water shall be deemed to appertain to the area to which the land on that bank appertains, and the water in contact with such objects shall be deemed to appertain to the other side of the boundary. In the places in the schedule where the boundary is thus described the boundary line shall be the moving edge of the water wherever it may be at any time. In the case of bridges, however, the supporting pile in contact with the bank only shall be deemed to be permanently attached to the bank and the boundary line across the bridge to be immediately above the water-line so described.

(b) The expression "solid side" or "solid corner" means the line or spot marked out by solid objects, such as a pucca wall or the face of a house, the wayside lands and pavements thus being all included in the adjacent road, street or lane.

H. M. SMITH,

Offg. Secretary to the Government of India.



**MADRAS ACT NO. IV OF 1927.****The Madras High Court (Jurisdictional Limits) Act.**

Whereas clause 11 of the Letters Patent for the High Court of Judicature at Madras, dated the 28th December, 1865, provides that the said High Court shall have and exercise ordinary original civil jurisdiction within such local limits as may from time to time be declared and prescribed by any law made by the Governor-in-Council.

And Whereas it is expedient so to declare and prescribe the local limits of the ordinary original civil jurisdiction of the said High Court;

And Whereas the previous sanction of His Excellency the Governor-General has been obtained; it is hereby enacted as follows:—

1. **Short Title.**—This Act may be called the Madras High Court (Jurisdictional Limits) Act, 1907.

2. **Limits of ordinary original civil jurisdiction of Madras High Court.**—The ordinary original civil jurisdiction of the High Court of Judicature at Madras shall be exercised within the limits set out in the schedule.

Provided that nothing in this Act shall affect any suit or other legal proceeding pending in any Court at the date of the commencement of this Act.

**THE SCHEDULE.**

The limits within which the ordinary original civil jurisdiction of the High Court shall be exercised are as follows:—

**North.**—Commencing from the point where the boundary line between Tiruvottiyur village and Tondiarpet village meets the sea, along the boundary line between Tondiarpet village and Tiruvottiyur and Sattankadu villages to the point where Sattankadu, Kodumgiyur and Tondiarpet villages meet; thence in a south-westerly direction along the boundary line between Kodumgiyur and Tondiarpet so as to include the whole of Tondiarpet village; thence in a westerly direction along the boundary line between the villages of Perambur and Erukkanjeri to the point where Perambur, Erukkanjeri and Sembiam villages meet.

**West.**—From the said point in a southerly direction along the western boundary of Perambur village and the eastern boundary of Sembiam, Siruvallur and Sinna Sembarampakkam villages to the south-west corner of Perambur village and thence in an easterly direction along the southern boundary of Perambur village to the point where the villages of Perambur, Purasawakam and Ayanapuram shrotriyam meet so as to include the whole of Perambur village; thence along the boundary line between Purasawakam and Ayanapuram shrotriyam so as to include the whole of Purasawakam village; thence along the boundary line between Egmore village and the villages of Ayanapuram shrotriyam, Amanjikarai shrotriyam and Agaramvada so as to include the whole of Egmore village; thence along the boundary line between Nungambakam village and Puliur shrotriyam to the point where the South Indian Railway line enters Nungambakam; thence along the eastern side of the South Indian Railway boundary to the point where it intersects the boundary between Survey No. 170-1 and 2; thence eastwards in a straight line through Survey Nos. 170, 171, 172 and 173 to the junction of Survey Nos. 165, 172 and 173 and continued to meet the south-eastern boundary of Survey No. 173; thence north-westwards along the boundary between Survey No. 173 and Government Farm Survey No. 4 to its intersection with Survey No. 25; thence northwards fifty feet along the calingula and thence eastwards to a point in Survey No. 20 (2) of Mambalam zamindari situated 415 feet from the furlong stone 4-5 on Mount Road on the continuation of the straight line joining the survey stone next the northernmost stone on the north-western side of Survey No. 1 of 179 Government Farm and furlong stone 4-5 on Mount Road; and thence from the said point in Survey No. 20 (2) south-eastward 500 feet along the above line to the survey stone (above mentioned) and eastward along the northern boundary of Survey No. 1 of 179 Government Farm to the Municipal boundary stone No. 242; thence southward along the western boundary of Survey No. 3885 (channel) to the Municipal boundary stone No. 244; thence in a south-westerly direction to the Municipal boundary stone No. 246; thence across the river Adyar to the Municipal boundary stone No. 247.

**South.**—From the said point along the southern bank of the river Adyar to the sea.

**East.**—The sea.

**THE INDIAN PATENTS AND DESIGNS ACT OF 1911.**  
**(ACT 2 OF 1911.)**

*[N. B. The Act is here set out in its current form after giving effect to the various amendments which have been made up to 31st October 1936 by the amending Acts.]*

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**ACT NO. II OF 1911**

[*The 2nd March, 1911.*]

**An Act to amend the law relating to the protection of  
Inventions and Designs.**

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Whereas it is expedient to amend the law relating to the protection of inventions and designs; It is hereby enacted as follows:—

**PRELIMINARY**

1. **Short title, extent and commencement.**—(1) This Act may be called the Indian Patents and Designs Act, 1911.

(2) It extends to the whole of British India, including British Baluchistan and the Santhal Parganas; and

[As to the form of the grant of Indian Letters Patent see page 31. As to the territory over which the Patent is effective, see

page 33. Compare Sec. 99 of the corresponding English Statute being the *English Patents and Designs Acts, 1907 to 1932.*]

(3) It shall come into force on the first day of January, 1912.

2. **Definitions.**—In this Act, unless there is anything repugnant in the subject or context,—

(1) “Advocate General” includes a Government Advocate :

[For proceedings on an application to obtain the fiat of the Advocate General under Section 26(2)(a) see page 441 and Chapter XI generally.]

(2) “article” means (as respects designs) any article of manufacture and any substance, artificial or natural, or partly artificial and partly natural :

(3) “Controller” means the Controller of Patents and Designs appointed under this Act :

(4) “copyright” means the exclusive right to apply a design to any article in any class in which the design is registered :

(5) “design” means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye ; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in Section 478, or property mark as defined in Section 479 of the Indian Penal Code :

(6) “District Court” has the meaning assigned to that expression by the Code of Civil Procedure, 1908 :

[See Chapter VII Part II. As to the various District Courts in British India see page 690. As to the transfer of an infringement suit from a District Court proper to a High Court see page 671.]

(7) “High Court” has the meaning assigned to that expression by the Code of Criminal Procedure, 1898, in reference to the proceedings against European British subjects :

(8) “invention” means any manner of new manufacture and includes an improvement and an alleged invention :

[Regarding want of subject matter see Chapter VI Part II : as to inventive step see from page 144. Regarding want of novelty see Chapter VI Part III.]

(9) "legal representative" means a person who in law represents the estate of a deceased person :

[Regarding application for a Patent by a legal representative of the true and first inventor, see page 338.]

(10) "manufacture" includes any art, process or manner of producing, preparing or making an article, and also any article prepared or produced by manufacture :

[As to the meaning of the words "manner of manufacture", see Chapter VI Part II : and from page 122.]

(11) "patent" means a patent granted under the provisions of this Act :

(12) "patentee" means the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent :

[See also Section 29(1) and Section 20. As to the effect of registration, see Section 63. And see pages 582 and 588.]

(13) "prescribed" includes prescribed by rules under this Act : and

(14) "proprietor of a new or original design,"—

(a) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed ; and

(b) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and

(c) in any other case, means the author of the design ; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

[Compare Secs. 92 and 93 for the definitions in the English Act.]

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## PART I

### PATENTS

#### Application for and Grant of Patent.

**3. Application.**—(1) An application for a patent may be made by any person whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor or the legal representative or assign of such inventor and for which he desires to obtain a patent, and must be accompanied by a specification and by the prescribed fee.

(4) Where the true and first inventor is not a party to the application, the application must contain a statement of his name, and such particulars for his identification as may be prescribed, and the applicant must show that he is the legal representative or assign of such inventor.

[Regarding the procedure for application for a Patent and the various modes of application see Chapter IX. Compare Sec. 1 of the English Act.]

**4. Specification.**—(1) The specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(2) Where the Controller deems it desirable, he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the application, and such drawings shall be deemed to form part of the specification.

(3) The specification must commence with the title, and must end with a distinct statement of the invention claimed.

(4) If in any particular case the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished

before the acceptance of the application, but such model or sample shall not be deemed to form part of the specification.

[Compare Sec. 2 of the English Patents and Designs Acts 1907 to 1932.]

**5. Proceedings upon application.**—(1) The Controller shall examine every application, and if he considers that—

- (a) the nature of the invention is not fairly described, or
- (b) the application, specification and drawings have not been prepared in the prescribed manner, or
- (c) the title does not sufficiently indicate the subject-matter of the invention, or
- (d) the statement of claim does not sufficiently define the invention, or
- (e) the invention as described and claimed is *prima facie* not a new manufacture or improvement, or
- (f) the specification relates to more than one invention,

he may refuse to accept the application or require that the application, specification or drawings be amended before he proceeds with the application ; and in the latter case the application shall, if the Controller so directs, bear date as from the time when the requirement is complied with :

Provided that, when a specification comprises more than one invention, the application shall, if the Controller or the applicant so requires, be restricted to one invention and the other inventions may be made the subject-matter of fresh applications ; and any such fresh application shall be proceeded with as a substantive application, but the Controller may, in his discretion, direct that any such fresh application made before the acceptance of the original application shall bear the date of the original application or such later date as he may fix, and the fresh application shall be deemed, for the purposes of this Act, to have been made on the date which it bears in accordance with such direction.

(2) Where the Controller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the Governor General in Council.

(3) The investigations required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Governor General in Council or any

officer by reason of, or in connection with, any such investigation, or any proceeding consequent thereon.

(4) Unless an application is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void.

Provided that where, before, or within three months after, the expiration of the said period of twelve months, a request is made to the Controller for an extension of time by any period not exceeding three months, the application shall, on payment of the prescribed fee, be continued or revived, as the case may be, during, but not beyond, the period of extension so requested.

[Regarding the nature of the examination at this stage and the objections to the application which may be taken by the Patent Office, see Chapter IX from page 366. Compare Sec. 3 of the English Act.]

**6. Advertisement on acceptance of application.**—On the acceptance of an application the Controller shall give notice thereof to the applicant and shall advertise the acceptance; and the application and specification with the drawings (if any) shall be open to public inspection.

[Compare Sec. 9 of the English Act.]

**7. Use of invention on acceptance of application.**—Where an application for a patent in respect of an invention has been accepted, any use or publication of the invention during the period between the date of application and the date of sealing such patent shall not prejudice the patent to be granted for the invention:

Provided that an applicant shall not be entitled to institute any proceedings for infringement unless and until a patent for the invention has been granted to him.

[Regarding the effect of proviso, see pages 548-550. Compare Sec. 10 of the English Act.]

8. ...(Repealed).

**9. Opposition to grant of patent.**—(1) Any person may, on payment of prescribed fee, at any time within four months from the date of the advertisement of the acceptance of an application, give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds, namely:—

(a) that the applicant obtained the invention from him, or

from a person of whom he is the legal representative or assign ; or

- (b) that the invention has been claimed in any specification filed in British India which is or will be of prior date to the patent, the grant of which is opposed ; or
- (c) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the specification ; or
- (d) that the invention has been publicly used in any part of British India or has been made publicly known in any part of British India ;

but on no other ground.

(2) Where such notice is given, the Controller shall give notice of the opposition to the applicant, and shall, on the expiration of those (four) months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the Controller shall be subject to appeal to the Governor General in Council.

[For the practice and procedure on opposition proceedings see Chapter X. Regarding the grounds of opposition for invalidity see page 410. Compare Sec. 11 of the English Act.]

**10. Grant and sealing of patent.**—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted subject to such conditions (if any) as the Governor General in Council thinks expedient, to the applicant, or in the case of a joint application to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the Patent Office.

(1A) Notwithstanding anything contained in sub-section (1), where—

- (a) an applicant has agreed in writing that on the grant to him of a patent he will assign it to another party or to a joint applicant and refuses to proceed with the application, or
- (b) disputes arise between joint applicants as to proceeding with an application,

the controller, if he is satisfied of the existence of such agreement or, in any other case, that any joint applicant or applicants ought to be allowed to proceed alone, may direct that such other party or joint applicant or applicants may proceed with the application accordingly and may grant a patent to him or them, as the case may be :

Provided that—

- (i) the Controller shall not give any such direction until every party interested has had an opportunity of being heard by him, and
- (ii) an appeal from any such direction shall lie to the Governor General in Council.

(2) A patent shall be sealed as soon as may be, and not after the expiration of eighteen months from the date of application :

Provided that,—

- (a) where the Controller has allowed an extension of the time within which an application may be accepted, a further extension of four months after the said eighteen months shall be allowed for the sealing of the patent ;
- (b) where the sealing is delayed by an appeal to the Governor General in Council or by opposition to the grant of the patent, the patent may be sealed at such time as the Controller may direct ;
- (c) where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death ;
- (d) where for any reason a patent cannot be sealed within the period allowed by any of the foregoing provisions of this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to the extent applied for but not exceeding three months.

[Compare Sec. 12 of the English Act.]

11. **Date of patent.**—Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application :

Provided that no proceedings shall be taken in respect of an infringement committed before the advertisement of the acceptance of the application.

[Regarding the effect of the proviso see pages 548 to 550. Compare Sec. 13 of the English Act.]

**12. Effect, extent and form of patent.**—(1) A patent sealed with the seal of the Patent Office shall, subject to the other provisions of this Act, confer on the patentee the exclusive privilege of making, selling and using the invention throughout British India and of authorizing others so to do.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim ; and it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

[Regarding the question what constitutes infringement in relation to the grant see Chapter XIV to page 542 (particularly No. 14) and Chapter XV from page 553. Compare Sec. 14 of the English Act.]

**13. Fraudulent applications for patents.**—(1) A patent granted to the true and first inventor or his legal representative or assign shall not be invalidated by an application in fraud of him, or by protection obtained thereon or by any use or publication of the invention subsequent to that fraudulent application during the period of protection.

(2) Where a patent has been revoked by the High Court on the ground that it has been obtained in fraud of the true and first inventor, or where the grant of a patent has been refused by the Controller under section 9 on the ground stated in clause (a) of subsection (1) of that section, the Controller may, on the application of the true inventor or his legal representative or assign made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention, and the patent so granted shall bear the same date as the patent so revoked or, in the case of a patent the grant of which has been refused, the same date as would have been borne by the patent if it had been granted :

Provided that no suit shall be brought for any infringement of

the patent so granted committed before the actual date when such patent was granted.

[Regarding the ground of "obtaining", see Chapter VII part III and pages 263 to 267 ; also page 412. The power to make the substituted grant referred to in this section is of great value to an opponent to the grant. Compare Sec. 15 of the English Act.]

### **Term of Patent.**

14. **Term of Patent.**—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be sixteen years from its date.

(1A) Any patent the original term of which had not expired on or before the 1st day of July, 1930, shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, and any license existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires.

(1B) Where any party to a contract with the patentee or any other person entered into before the 1st day of January, 1930, is subjected to loss or liability by reason of the extension of the term of any patent under this section, any District Court having jurisdiction may determine in what manner and by which parties such loss or liability shall be borne.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times :

Provided that where the patentee, before, or within three months after, the expiration of the time for payment, applies to the Controller for an extension of time by any period not exceeding three months, the patent shall, on payment of such additional fee as may be prescribed, be continued or revived, as the case may be, during, but not beyond, the period of extension applied for.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the Court before which the proceeding is taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

[Regarding the term of a Patent see page 31. As to extension

see Chapter XIII. Regarding renewal fees see Chapter II and page 41 and, as to a defence to an infringement suit see Chapter XIV page 540 (No. 4), Compare Sec. 17 of the English Act.]

**15. Extension of term of Patent.**—(1) A patentee may, present a petition to the Governor General in Council praying that his patent may be extended for a further term ; but such petition must be left at the Patent Office at least six months before the time limited for the expiration of the patent and must be accompanied by the prescribed fee and must be advertised by the patentee within the prescribed time and in the prescribed manner.

(2) Any person may within such time as may be proscribed and on payment of the prescribed fee give notice to the Controller of objection to the extension.

(3) Where a petition is presented under sub-section (1), the Governor General in Council may, as he thinks fit, dispose of the petition himself or refer it to a High Court for decision.

(4) If the petition be referred to a High Court, then on the hearing of such petition under this section the patentee, and any person who has given notice under sub-section (2) of objection, shall be made parties to the proceeding, and the Controller shall be entitled to appear and be heard.

(5) The Court to which the petition is referred shall, in considering its decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(6) If it appears to the Governor General in Council, or to the High Court when the petition has been referred to it, that the patentee has been adequately remunerated by his patent, the Governor General in Council or the High Court, as the case may be, may by order extend the term of the patent for a further term not exceeding five or, in exceptional cases, ten years, or may order the grant of a new patent for such term as may be specified in the order and subject to the payment of such fees as may be prescribed and containing any restriction, conditions and provisions which the Governor General in Council or the High Court, as the case may be, may think fit :

Provided that any patent so extended or granted shall, not-



withstanding anything therein, or in this Act, cease if the inventor fails to pay before the expiration of each year the prescribed fee.

[Regarding extension see Chapter XIII, Part I. Compare sec. 18 of the English Act.]

**15A. Patents of addition.**—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may in his application for the further patent request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired, and, if he does so, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(2) Save as otherwise expressly provided by this Act, a patent of addition shall remain in force as long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal :

Provided that if the patent for the original invention is revoked, then the patent of addition shall, if the authority by which it is revoked so orders, become an independent patent, and the fees payable, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(3) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

[Regarding application for a Patent of Addition see page 365. Compare Sec. 19 of the English Act.]

**16. Restoration of lapsed patent.**—(1) Where any patent has ceased owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Controller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional or unavoidable and that no undue delay has occurred in the making of the application, the Controller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the Controller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Controller shall hear the case and, subject to an appeal to the Governor General in Council, issue an order either restoring the patent subject to any conditions and restrictions deemed to be advisable or dismissing the application :

Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased.

[Regarding restoration of a lapsed Patent see Chapter XIII, Part II. Compare Sec. 20 of the English Act.]

#### **Amendment of Application or Specification.**

##### **17. Amendment of application or specification by Controller.**

—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office and accompanied by the prescribed fee, seek leave to amend his application or specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) If the application for a patent has not been accepted, the Controller shall determine whether and subject to what conditions (if any) the amendment shall be allowed.

(3) In any other case the request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within three months from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(4) Where such a notice is given the Controller shall give

notice of the opposition to the person making the request, and shall hear and decide the case.

(5) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Controller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6) The decision of the Controller in either case shall be subject to an appeal to the Governor General in Council.

(7) No amendment shall be allowed that would make the application or specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before amendment.

(8) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the application or specification.

(9) This section shall not apply when and so long as any suit for infringement or proceeding before a Court for the revocation of the patent is pending.

[Regarding amendment of an application for Patent or of a Specification, see Chapter XII. Compare Sec. 21 of the English Act.]

**18. Amendment of specification by the Court.**—In any suit for infringement of a patent or proceeding before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit :

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Controller, and the Controller shall have the right to appear and be heard.

[Regarding an application to the Court for an order allowing

an amendment of a specification see Chapter XII Parts I & III. Compare Sec 22 of the English Act.]

**19. Restriction on recovery of damages.**—Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act, no damages shall be given in any suit in respect of the use of the invention before the date of the decision allowing the amendment unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

[As to a defence to a suit for infringement based on this section see Chapter XIV (No. 43). Compare Sec. 23 of the English Act.]

### Register of Patents.

**20. (1) Register of Patents.**—There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of inventions and address book existing at the commencement of this Act shall be incorporated with, and form part of, the register of patents under this Act.

(3) The register of patents shall be *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licenses and any other documents affecting the proprietorship in any patent or in any license thereunder, must be supplied to the Controller in the prescribed manner for filing in the Patent Office.

[As to the effect of registration see Section 63. Also see pages 582 and 588. Compare Section 2(12), also Section 29 (1). Compare Sec. 28 of the English Act.]

### Crown.

**21. Patent to bind Crown.**—(1) Subject to the other provisions of this section, a patent shall have to all intents the like effect as against His Majesty the King as it has against a subject.

(2) The officers or authorities administering any department of the service of His Majesty may, by themselves or by such of their agents, contractors or others as may be authorised in writing by them, at any time after the application, and after giving notice to the applicant or patentee, make, use or exercise the invention for the service of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Governor General in Council, between such officers or authorities and the applicant or patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or license concluded between the applicant or patentee and any person other than such officers or authorities, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown.

(3) Where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, the officers or authorities administering any department of the service of His Majesty (such invention not having been communicated directly or indirectly by the applicant or patentee), such officers or authorities, or such of their agents, contractors, or others, as may be authorised in writing by them, may, after giving notice to the applicant or patentee, make, use or exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the applicant or patentee, notwithstanding the existence of the patent. If, in the opinion of such officers or authorities, the disclosure to the applicant or patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(4) In the event of any dispute as to the making, use or exercise of an invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the High Court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The Court,

referee or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant or patentee and such officers or authorities. The Court, referee or arbitrator, further, in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the applicant or patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from such officers or authorities in respect of such patent :

Provided that, if the inventor or patentee is a Government servant and the subject-matter of the invention is certified by the Governor General in Council or Local Government to be connected with work done in the course of such service, any such dispute shall be settled by the Governor General in Council after hearing the applicant or patentee and any other person having an interest in the invention or patent.

(5) The right to use an invention for the services of the Crown under the provisions of this section, or any provisions for which this section is substituted, shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown.

(6) Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under any law for the time being in force relating to customs or excise.

[Compare Sec. 29 of the English Act.]

**21A. Assignment of patent to the Secretary of State for India in Council.**—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for India in Council on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention ; and the Secretary of State for India in Council may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for India in Council

on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by or on behalf of the Secretary of State for India in Council.

(3) Where any such assignment has been made, the Governor General in Council may, at any time before the publication of the specification, certify to the Controller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Governor General in Council so certify, the application and specifications, with the drawings (if any), and any amendment of the specification and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Controller in a packet sealed by authority of the Governor General in Council.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Controller, and shall not be opened save under the authority of an order of the Governor General in Council.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Governor General in Council to receive it, and shall, if returned to the Controller, be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Governor General in Council.

(8) Where the Governor General in Council certifies as aforesaid after an application for a patent has been left at the Patent Office but before the publication of the specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Controller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Governor General in Council.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Governor General in Council as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as otherwise provided in this section, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Governor General in Council may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State for India in Council or the Governor General in Council or to any person or persons authorised by the Secretary of State for India in Council or the Governor General in Council to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

[Compare Sec. 30 of the English Act.]

### **Compulsory Licenses and Revocation.**

22. **Compulsory licenses and revocation.**—(1) Any person interested may present a petition to the Governor General in Council, which shall be left at the Patent Office, together with the prescribed fee, alleging that the demand for a patented article in British India is not being met to an adequate extent and on reasonable terms and praying for the grant of a compulsory license, or, in the alternative, for the revocation of the patent.

(2) The Governor General in Council shall consider the petition, and if the parties do not come to an arrangement between themselves the Governor General in Council may, as he thinks fit, either dispose of the petition himself or refer it to a High Court for decision.

(3) The provisions of sub-section (4) of section 15, prescribing the procedure to be followed in the case of references to the Court under that section, shall apply in the case of references made to the Court under this section.



(4) If the Governor General in Council is of opinion, or, where a reference has been made under sub-section (2) to a High Court that Court, finds that the demand for the patented article in British India is not being met to an adequate extent and on reasonable terms, the patentee may be ordered to grant licenses on such terms as the Governor General in Council or the High Court, as the case may be, may think just, or, if the Governor General in Council or the High Court is of opinion that the demand will not be adequately met by the grant of licenses, the patent may be revoked by order of the Governor General in Council or the High Court :

Provided that an order of revocation shall not be made before the expiration of four years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(5) For the purposes of this section the demand for a patented article shall not be deemed to have been met to an adequate extent and on reasonable terms—

- (a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licenses on reasonable terms, any existing trade or industry or the establishment of any new trade or industry in British India is unfairly prejudiced, or,
- (b) if any trade or industry in British India is unfairly prejudiced by the conditions attached by the patentee to the purchase, hire or use of the patented article or to the using or working of the patented process.

[See Sec. 27 of the English Act.]

### 23. Revocation of patents worked outside British India.—

(1) At any time not less than four years after the date of a patent granted under this Act, any person may apply to the Governor General in Council for relief under this section on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside British India.

(2) The Governor General in Council shall consider the application, and, if after inquiry, he is satisfied—

- (a) that the allegations contained therein are correct ; and
- (b) that the applicant is prepared, and is in a position, to manufacture or carry on the patented article or process in British India ; and
- (c) that the patentee refuses to grant a license on reasonable terms,

then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in British India, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Governor General in Council may make an order—

- (a) revoking the patent either—
  - (i) forthwith ; or
  - (ii) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within British India to an adequate extent, or
- (b) ordering the patentee to grant a license to the applicant which may be a license exclusive to him or otherwise as the Governor General in Council may direct.

(3) No order revoking a patent shall be made under the last sub-section which is at variance with any treaty, convention, arrangement or engagement with any foreign country or British possession.

(4) The Governor General in Council may, on the application of the patentee, extend the time limited in any order made under sub-section (2), clause (ii), for such period not exceeding two years as he may specify in a subsequent order, or revoke any order made under sub-section (2), clause (ii), or any subsequent order if sufficient cause is in his opinion shown by the patentee.

[Regarding the abuse of a monopoly and the objections on the grounds of inadequate supply or of manufacture outside British India which are mentioned in Sections 22 and 23 and the remedies available therefor, see Chapter VIII. See Sec. 27 of the English Act.]

**23A. Operation of order under section 22 or section 23.**—An order of the High Court under section 22 or of the Governor General in Council under section 22 or section 23, directing the grant of any license shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and executed by the patentee and all other necessary parties.

[Compare sec. 83A of the English Act.]

**24. Power of Controller to revoke surrendered patent.**—A patentee may at any time, by giving notice in the prescribed manner to the Controller, offer to surrender his patent, and the Controller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

[For termination of a Patent by surrender see page 472. Compare sec. 26 (3) of the English Act.]

**25. Revocation of patent on public grounds.**—A patent shall be deemed to be revoked if the Governor General in Council declares, by notification in the *Gazette of India*, the patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public.

[See page 473.]

### Legal Proceedings

**26. Petition for revocation of patent.**—(1) Revocation of a patent in whole or in part may be obtained on petition to a High Court on all or any of the following grounds, namely :—

- (a) that any invention included in the statement of claim is of no utility ;
- (b) that any invention included in the statement of claim was not, at the date of the application for a patent, a new invention within the meaning of this Act ;
- (c) that the applicant was not the true and first inventor thereof or the assign or legal representative of such inventor thereof ;
- (d) that the original or any amended application or specification does not fulfil the requirements of this Act ;
- (e) that the applicant has knowingly or fraudulently included

in the application for a patent or in the original or any amended specification, as his invention, something which was not new or whereof he was neither the inventor nor the assign nor the legal representative of such inventor ;

(f) that the original or any subsequent application relating to the invention, or the original or any amended specification, contains a wilful or fraudulent mis-statement ;

(g) that the whole or a part of the invention or the manner in which the whole or a part is to be made and used as described in the original or any amended specification, is not thereby sufficiently described, and that this insufficiency was fraudulent or is injurious to the public.

(2) A petition for revocation of a patent may be presented—

(a) by the Advocate General or any person authorized by him;  
or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ; or

(ii) that he, or any person under or through whom he claims, was the true and first inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within British India, before the date of the patent, anything claimed by the patentee as his invention.

(3) The High Court may, irrespective of any provisions of the Code of Civil Procedure, 1908, in this behalf, require any person, other than the Advocate General or any person authorized by him, applying for the revocation of a patent to give security for the payment of all costs incurred or likely to be incurred by any person appearing to oppose the petition.

[As to grounds of invalidity in general see Chapters VI, VII, and VIII. As to the grounds covered by this section see page 451 : and pages 595 to 601. As to revocation proceedings on Petition to a High Court see Chapter XI. Compare sec. 25 of the English Act.]

**27. Notice of proceedings to persons interested.**—(1) Notice of any petition for revocation of a patent under section 26 shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein, and it shall not be necessary to serve the notice on any other person.

(2) The notice shall be deemed to be sufficiently served if a copy thereof is sent by post in a registered letter directed to the person and place for the time being stated in the register.

**28. Framing issue for trial before other Courts.**—(1) A High Court may, if it thinks fit, direct an issue for the trial, before itself or any other High Court, or any District Court, of any question arising upon a petition to itself under section 26, and the issue shall be tried accordingly.

(2) If the issue is directed to another High Court, the finding shall be certified by that Court to the High Court directing the issue.

(3) If the issue is directed to a District Court, the finding of that Court shall not be subject to appeal, but the evidence taken upon the trial shall be recorded and a copy thereof, certified by the Judge of the Court, shall be transmitted, together with any remarks which he may think fit to make thereon, to the High Court directing the issue, and the High Court may thereupon act upon the finding of the District Court, or dispose of the petition upon the evidence recorded, or direct a new trial, as the justice of the case may require.

**29. Suits for infringement of patents.**—(1) A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells or uses the invention without his license, or counterfeits it, or imitates it.

(2) Every ground on which a patent may be revoked under this Act shall be available by way of defence to a suit for infringement.

[As to proceedings in an infringement suit, see Chapter XVII. As to grounds of invalidity open to a Defendant, see pages 595 et seq. As to what constitutes infringement see Chapters XIV and

XV. As to defences open to a Defendant in an infringement suit see Chapters XIV, XV and XVI. Compare Sec. 32 of the English Act.]

**30. Exemption of innocent infringer from liability for damages.**—A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and marking of an article with the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent :

Provided that nothing in this section shall affect any proceedings for an injunction.

[Regarding this particular defence see page 541 (No. 20) and page 578. Compare Sec. 33 of the English Act.]

**31. Order for inspection, etc., in suit.**—In a suit for infringement of a patent, the Court may, on the application of either party, make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit.

[See Chapter XVII, Part V. Compare Sec. 34 of the English Act.]

**32. Certificate of validity questioned and costs thereon.**—In a suit for infringement of a patent the Court may certify that the validity of the patent came in question, and if the Court so certifies, then in any subsequent suit in that Court for infringement of the same patent the plaintiff, on obtaining a final order or judgment in his favour, shall, unless the Court trying the suit otherwise directs, have his full costs, charges and expenses of and incidental to the said suit properly incurred,

[See Chapter XVII, Part V. Compare sec. 35 of the English Act.]

**33. Transmission of decrees and orders to the Controller.**—A Court making a decree in a suit under section 29 or an order on a

petition under section 26 shall send a copy of the decree or order, as the case may be, to the Controller, who shall cause an entry thereof and reference thereto to be made in the register of patents.

**34. Power of High Court to stay proceedings, etc.**—A High Court to which a petition has been presented under section 26 may stay proceedings on or dismiss the petition if in its opinion the petition would be disposed of more justly or conveniently by another High Court.

**35. Hearing with assessor.**—(1) In a suit or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall on the request of all the parties to the proceedings, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance.

(2) A Court exercising appellate jurisdiction in respect of such suit or proceeding may, if it thinks fit, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall in every case be determined by the Court and be paid by it as part of the expenses of the execution of this Act.

[See Chapter XVII, Part III. Compare Sec. 31 of the English Act.]

**35A. Grant of relief in respect of particular claims.**—Notwithstanding anything contained in section 19, if the Court in any action for infringement of a patent finds that any one or more of the claims in the specification in respect of which the infringement is alleged are valid, it may, subject to its discretion as to costs and as to the date from which damages should be reckoned and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion the Court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

[See Chapter XVII, Part V. Compare Sec. 32A of the English Act.]

**36. Remedy in case of groundless threats of legal proceedings.**—Where any person claiming to have an interest in a patent by

circulars, advertisements or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring a suit against him in a District Court having jurisdiction to try the suit, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of the patent :

Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence.

[For proceedings on a suit for threats, see Chapter XIX. Compare Sec. 36 of the English Act.]

#### Miscellaneous.

37. **Grant of patents to two or more persons.**—Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his legal representatives.

[On the point whether all co-patentees must join as Plaintiffs in a suit for infringement see Chapter XVII, Part II. As to the defence of a Co-patentee in regard to an infringement suit sought to be brought against him by another co-patentee, see page 541 (No. 17) and page 578. Compare Sec. 37 of the English Act.]

38. **Novelty of invention.**—(1) An invention shall be deemed a new invention within the meaning of this Act—

(a) if it has not, before the date of the application for a patent thereon, been publicly used in any part of British India, or been made publicly known in any part of British India, and

(b) if the inventor has not by secret or experimental user



made direct or indirect profits from his invention in excess of such an amount as the Court or the Governor General in Council, as the case may be, may, in consideration of all the circumstances of the case, deem reasonable.

(2) The public use or knowledge of an invention before the date of the application for a patent thereon shall not be deemed a public use or knowledge within the meaning of this Act if the knowledge has been obtained surreptitiously or in fraud of the true and first inventor or has been communicated to the public in fraud of such inventor or in breach of confidence :

Provided that such inventor has not acquiesced in the public use of his invention, and that, within six months after the commencement of that use, he applies for a patent.

[Regarding want of novelty see Chapter VI Part III. As to prior user see page 174 et. seq. As to prior documentary publication see pages 194 to 217. As to prior oral publication see page 204. As to secret or experimental user without unreasonable profit see pages 190 to 193. Compare Sec. 41 of the English Act.]

39. **Loss or destruction of patent.**—If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on payment of the prescribed fee, seal a duplicate thereof.

[Compare Sec. 44 of the English Act.]

40. **Provisions as to exhibitions.**—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Governor General in Council, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition, in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application :

Provided that—

(a) the exhibitor, before exhibiting the invention, gives the

Controller the prescribed notice of his intention to do so ; and

- (b) the application for a patent is made before or within six months from the date of the opening of the exhibition.

(2) The Governor General in Council may, by notification in the Gazette of India, apply this section to any exhibition mentioned in the notification in like manner as if it were an industrial or international exhibition certified as such by the Governor General in Council, and any such notification may provide that the exhibitor shall be relieved from the condition of giving notice to the Controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the notification.

[See Page 19. Compare Sec. 45 of the English Act.]

41. **Models to be furnished to Indian Museum.**—The trustees of the Indian Museum may at any time require a patentee to furnish them with a model or sample of his invention on payment to the patentee of the cost of the manufacture of the model or sample, the amount to be settled, in case of dispute, by the Governor General in Council.

[Compare Sec. 47 (2) of the English Act.]

42. **Foreign vessels in British Indian waters.**—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any Court in British India, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from British India.

(2) This section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that State or in the waters within the jurisdiction of its Courts.

[See page 551. Compare Sec. 48 of the English Act.]

## PART II

### DESIGNS

*[N. B. Sections 43 to 54 comprising Part II, since these relate exclusively to Designs, have here been omitted.]*

## PART III

### GENERAL

#### **Patent Office and Proceedings thereat.**

55. **Patent office.**—(1) The Governor General in Council may provide, for the purposes of this Act, an office which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the Controller of Patents and Designs, who shall act under the superintendence and direction of the Governor General in Council.

(3) There shall be a seal for the Patent Office.

(4) Any act or thing directed to be done by or to the Controller may be done by or to any officer authorized by the Governor General in Council.

[Regarding the Indian Patent office and its functions in the system of Patent administration in British India see Chapter V. As to the powers and duties of the Controller of Patents see pages 71 to 85. Compare Sec. 62 and Sec. 64 of the English Act.]

56. **Officers and clerks.**—The Governor General in Council may appoint the Controller, and so many officers and clerks, with such designations and duties, as he thinks fit.

[Compare Sec. 63 of the English Act.]

#### **Fees.**

57. **Fees.**—(1) There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to the patents and designs under this Act, such fees as may be prescribed by the Governor General in Council, so however that the fees prescribed in respect of the instruments and matters mentioned in the schedule shall not exceed those there specified.

(2) A proceeding in respect of which a fee is payable under

this Act or the rules made thereunder shall be of no effect unless the fee has been paid.

[Regarding renewal fees see Chapter III. Compare Sec. 65 of the English Act.]

**Provisions as to Registers and other Documents in the  
Patent Office.**

**58. Notice of trust not to be entered in registers.**—There shall not be entered in any register kept under this Act, or be receivable by the Controller, any notice of any trust, expressed, implied or constructive.

[Sec. 66 of the English Act.]

**59. Inspection of and extracts from registers.**—Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

[Compare Sec. 67 of the English Act.]

**60. Privilege of reports of Controller.**—Reports of or to the Controller made under this Act shall not in any case be published or be open to public inspection.

[See pages 397 & 398. Compare Sec. 68 of the English Act.]

**61. Prohibition of publication of specification, drawings, etc., where application abandoned, etc.**—(1) Where an application for a patent has been abandoned or become void, the specifications and drawings (if any), accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Controller.

(2) Where an application for a design has been abandoned or refused, the application and any drawings, photographs, tracings, representations or specimens left in connection with the application shall not at any time be open to public inspection or be published by the Controller.

[Compare Sec. 69 of the English Act.]

**62. Power for Controller to correct clerical errors.**—The

Controller may, on request in writing accompanied by the prescribed fee,—

- (a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification ;
- (b) ...(*repealed*)
- (c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

[See page 493 ; also page 494 et seq. Compare Sec. 70 of the English Act.]

**63. Entry of assignments and transmissions in registers.—**

(1) Where a person becomes entitled by assignment, transmission or other operation of law to a patent or to the copyright in a registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design, and shall cause an entry to be made in the prescribed manner in the register of the assignment, transmission or other instrument affecting the title.

(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a patent or registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, license or dealing :

Provided that any equities in respect of the patent or design

may be enforced in like manner as in respect of any other moveable property.

(4) Except in the case of an application made under section 64, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsections (1) and (2) shall not be admitted in evidence in any Court in proof of the title to a patent or to copyright in a design or to any interest therein, unless the Court, for reasons to be recorded in writing, otherwise directs.

[See also Section 20 and Section 29(1). And see page 582 and page 588. Compare Sec. 71 of the English Act.]

64. **Rectification of register by Court.**—(1) The Controller may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging or varying such entry as he thinks fit and rectify the register accordingly.

(2) The Controller may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) An appeal shall lie to the High Court from any order of the Controller under this section ; and the Controller may refer any application under this section to the High Court for decision, and the High Court shall dispose of any application so referred.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Controller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

(5) Nothing in this section shall be deemed to empower the Controller—

- (a) to rectify the register of patents, or to decide any question relating to a patent, otherwise than for the purpose of correcting a mistake of fact apparent from a reference either to the patent itself or to some order of a

competent authority made under any other provision of this Act, or

- (b) to make any such order cancelling the registration of a design as is provided for in section 51A.

[See also Section 20 and Section 29(1) also page 582 and page 588. Compare Sec. 72 of the English Act.]

### **Powers and Duties of Controller.**

**65. Powers of Controller in proceedings under Act.**—Subject to any rules in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a Civil Court for the purpose of receiving evidence and administering oaths and enforcing the attendance of witnesses and compelling the production of documents and awarding costs.

[Regarding the powers and duties of the Controller of Patents see page 71. Compare Sec. 77 of the English Act.]

**66. Publication of patented inventions.**—The Controller shall issue periodically a publication of patented inventions containing such information as the Governor General in Council may direct.

[As to publications issued by and kept at the Indian Patent Office see page 65 et. seq. And as to how far such publications constitute public knowledge see Chapter VI at page 205 et. seq. Compare Sec. 76 of the English Act.]

**67. Exercise of discretionary power by Controller.**—Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of an application or of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

[See page 76. Sec. 73 of the English Act.]

**68. Power of Controller to take directions of Governor General in Council.**—The Controller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Governor General in Council for directions in the matter.

[See page 80. Compare Sec. 74, since repealed, of the English Act.]

**69. Refusal to grant patent, etc., in certain cases.**—(1) The Controller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

(2) An appeal shall lie to the Governor General in Council from an order of the Controller under this section.

[See pages 119, 161, 162, 165 and 166. Compare Sec. 75 of the English Act.]

**70. Appeals to the Governor General in Council.**—(1) Where an appeal is declared by this Act to lie from the Controller to the Governor General in Council, the appeal shall be made within three months of the date of the order passed by the Controller, and shall be in writing, and accompanied by the prescribed fee.

(2) In calculating the said period of three months the time (if any) occupied in granting a copy of the order appealed against shall be excluded.

(3) The Governor General in Council may, if he thinks fit, obtain the assistance of an expert in deciding such appeals, and the decision of the Governor General in Council shall be final.

[See Chapter XX.]

### **Evidence, etc.**

**71. Certificate of Controller to be evidence.**—A certificate purporting to be under the hand of the Controller as to any entry, matter or thing which he is authorized by this Act, or any rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

[Sec. 78 of the English Act.]

**72. Transmission of certified printed copies of specifications, etc.**—Copies of all specifications, drawings and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted as soon as may be, after they have been accepted or allowed at the Patent Office, to the Governor of Fort St. George in Council, the Governor of Bombay in Council, the Lieutenant-Governor of Burma and to such other authorities as the Governor General in Council may



appoint in this behalf, and shall be open to the inspection of any person at all reasonable times at places to be appointed by those authorities.

[Compare Sec. 80, since repealed, of the English Act.]

**73. Applications and notices by post.**—Any application, notice or other document authorized or required to be left, made or given at the Patent Office or to the Controller, or to any other person under this Act, may be sent by post.

[Sec. 81 of the English Act.]

**74. Declaration by infant, lunatic, etc.**—(1) If any person is, by reason of infancy, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

[Compare Sec. 83 of the English Act.]

**74A. Security for costs.**—Where a person giving notice of any opposition under this Act or giving notice to the Court of appeal from any decision of the Controller under this Act, neither resides nor carries on business in British India, the Controller or the Court, as the case may be, may require such person to give security for the payment of all costs incurred and likely to be incurred in the proceedings or appeal, as the case may be, and, in default of such security being given, may disallow the opposition or dismiss the appeal.

[See page 81. Compare Sec. 73A of the English Act.]

#### **Agency.**

**75. Subscription and verification of certain documents.**—The following documents, namely,—

- (1) applications for a patent,

- (2) notices of opposition,
- (3) applications for extension of term of a patent,
- (4) applications for the restoration of lapsed patents,
- (5) applications for leave to amend,
- (6) applications for compulsory license or revocation, and
- (7) notices of surrenders of patent.

shall be signed and verified, in the manner prescribed, by the person making such applications or giving such notices :

Provided that, if such person is absent from British India, they may be signed and verified on his behalf by an agent resident in British India authorized by him in writing in that behalf.

[See page 90.]

**76. Agency.**—(1) All other applications and communications to the Controller under this Act may be signed by, and all attendances upon the Controller may be made by or through a legal practitioner or by or through an agent authorized to the satisfaction of the Controller.

(2) The Controller may, if he sees fit, require—

- (a) any such agent to be resident in British India ;
- (b) any person not residing in British India to employ an agent residing in British India ;
- (c) the personal signature or presence of any applicant, opponent or other person.

[Regarding the authority requisite for an agent within this section, see page 107. As to Patent Agents generally see Chapter V from page 90.]

#### **Powers, etc., of Governor General in Council.**

**77. Power for Governor General in Council to make rules.**—

(1) The Governor General in Council may make such rules, as he thinks expedient, subject to the provisions of this Act—

- (a) for regulating the practice of registration under this Act ;
- (b) for classifying goods for the purposes of designs ;
- (c) for making or requiring duplicates of specifications, drawings and other documents ;
- (d) for securing and regulating the publishing and selling

of copies, at such prices and in such manner as the Governor General in Council thinks fit, of specifications, drawings and other documents ;

- (e) for securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents ;
- (ee) for the manner in which fees leviable under this Act may be paid ;
- (eee) for ensuring secrecy with respect to patents to which section 21A applies ;
- (f) generally for regulating the business of the Patent Office, the conduct of proceedings before the Controller, and all things by this act placed under the direction or control of the Controller or of the Governor General in Council ; and
- (g) generally for the purpose of carrying into effect the provisions of this Act.

(2). The power to make rules under this section shall be subject to the condition of the rules being made after previous publication.

(2A) Nothing in sub-section (2) shall apply in the case of rules made for the purpose specified in clause (eee) of sub-section (1) ; and any such rules may modify any of the provisions of this Act so far as may be necessary for that purpose.

(3) All rules made under this section shall be published in the Gazette of India, and on such publication shall have effect as is enacted in this Act.

[See pages 21 & 22. Compare Sec. 86 of the English Act.]

### Offences.

78. **Wrongful use of words "Patent Office".**—If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be punishable with fine which may extend to

two hundred rupees, and, in the case of a continuing offence, with further fine of twenty rupees for each day on which the offence is continued after conviction therefor.

[Compare Sec. 89(5) of the English Act.]

**Reciprocal arrangements with the United Kingdom and other parts of His Majesty's dominions.**

**78A. Reciprocal arrangements with the United Kingdom and other parts of His Majesty's dominions :** 7 Edw. VII, c. 29.—(1) If His Majesty is pleased by Order in Council to apply such of the provisions of Section 91 of the Patents and Designs Act, 1907, as relate to inventions or designs, to British India, then any person who has applied for protection for any invention or design in the United Kingdom, or his legal representative or assignee, shall be entitled to a patent for his invention or to registration of his design under this Act, in priority to other applicants ; and the patent or registration shall have the same date as the date of the application in the United Kingdom :

Provided that—

- (a) the application is made in the case of a patent within twelve months, and, in the case of a design, within six months from the application for protection in the United Kingdom ; and
  - (b) nothing in this section shall entitle the patentee or the proprietor of the design to recover damages for infringements happening prior to the actual date on which, in the case of a patent, his application is accepted, or, in the case of a design, the design is registered, in British India.
- (2) The patent granted for an invention or the registration of a design shall not be invalidated—
- (a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention, or
  - (b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design,
- in British India during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent or the registration of a design under this section must be made in the same manner as an ordinary application under this Act :

Provided that in the case of a patent, if the application is not accepted within twelve months from the date of the application for protection in the United Kingdom, the specification and the drawings (if any) supplied therewith shall be open to public inspection at the expiration of that period.

(4) Where it is made to appear to the Governor General in Council that the legislature of any other part of His Majesty's dominions or of any State in India has made satisfactory provision for the protection of inventions or designs, patented or registered in British India, the Governor General in Council may, by notification in the Gazette of India, direct that the provisions of this section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of inventions or designs patented or registered in that part of His Majesty's dominions or that State, as the case may be.

[Regarding the reciprocal arrangements referred to in this section, see Chapter IX from page 352 to 365. Compare Sec. 91 of the English Act.]

### Savings and Repeal.

79. **Savings for prerogative.**—Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

[See page 16. Sec. 97 of the English Act.]

80. [*Repealed by the Repealing Act, 1927 (Act 12 of 1927).*]

81. [*Repealed by the Repealing and Amending Act, 1920 (Act 31 of 1920).*]

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## THE SCHEDULE.

(SEE SECTION 57.)

### Fees.

					Rs.
On application for a patent	...	...	...	...	10
Before sealing a patent	...	...	...	...	30
Before the expiration of the 4th year from the date of the patent	...	...	...	...	50
Before the expiration of the 5th year from the date of the patent	...	...	...	...	50
Before the expiration of the 6th year from the date of the patent	...	...	...	...	50
Before the expiration of the 7th year from the date of the patent	...	...	...	...	50
Before the expiration of the 8th year from the date of the patent	...	...	...	...	100
Before the expiration of the 9th year from the date of the patent	...	...	...	...	100
Before the expiration of the 10th year from the date of the patent	...	...	...	...	100
Before the expiration of the 11th year from the date of the patent	...	...	...	...	100
Before the expiration of the 12th year from the date of the patent	...	...	...	...	150
Before the expiration of the 13th year from the date of the patent	...	...	...	...	150
Before the expiration of the 14th year from the date of the patent	...	...	...	...	150
Before the expiration of the 15th year from the date of the patent	...	...	...	...	150

Provided that the fees for two or more years may be paid in advance.			Rs.
On application to extend the term of a patent	...	...	50
Before the expiration of each year of the extended term of a patent or of a new patent granted under section 15	...	...	150
On application for registration of a design	...	...	3

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*[The following Rules were passed under the powers conferred by Section 57(i) (as to fees) and by Section 77 (i) (generally) of the foregoing Act.]*





## INDIAN PATENTS AND DESIGNS RULES, 1933.

[N.B.—These rules were published in the "Gazette of India," dated 2nd April 1932, Part II, and finally in the "Gazette of India," dated 11th February 1933, Part II. They superseded the previous Indian Patents and Designs Rules of 1912; and came into force on 1st April 1933. They are here printed in the form in which they are current with all amendments up to date (i.e., as on 31st October 1936).]

**Notification No. A197, dated the 2nd February 1933.**—In exercise of the powers conferred by sub-section (1) of section 57 and sub-section (1) of section 77 of the Indian Patents and Designs Act, 1911 (II of 1911), the Governor-General-in-Council is pleased to make the following rules, the same having been previously published as required by sub-section (2) of the last named section, namely:—

### CHAPTER I.

#### PRELIMINARY.

1. **Short title and commencement.**—(1) These rules may be called the Indian Patents and Designs Rules, 1933.

(2) They shall come into force on the 1st April 1933.

[Compare Rule 1 of the English Patents Rules, 1932.]

2. **Definitions.**—In these rules, unless there is anything repugnant in the subject or context,—

(a) "Act" means the Indian Patents and Designs Act, 1911;

(b) "British Application" means an application by any person for the protection, in any part of His Majesty's dominions or in any State in India, of an invention, for the protection of which in British India the provisions of section 78A of the Act are for the time being applicable;

(c) "Controller" means the Controller of Patents and Designs appointed under section 56 of the Act, and includes any officer appointed to act for him;

(d) "Office" means the Patent Office provided under section 55 of the Act;

(e) "Reciprocity Application" means an application in British India under section 78A of the Act;

(f) "Set" means a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications not sufficient to alter the character or substantially to affect the identity thereof.

[Compare Rule 2 of the English Patents Rules, 1932.]

3. **Communications to the Office.**—Any application, notice, or other document authorised or required to be left, made or given at the Office, or to the Controller, may be sent by hand, or by a prepaid letter through the post, addressed to the Controller of Patents and Designs, 1, Council House Street, Calcutta, and, if sent by a prepaid letter, shall be deemed to have been left, made or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

[Compare Rule 6 of the English Patents Rules, 1932.]

**4. Address for service.**—Every applicant or opponent in any proceeding under the Act or these rules, and every person who shall hereafter become a patentee or a registered proprietor of a design, shall give an address for service in British India, and such address may be treated, for all purposes connected with the patent or the design, as the actual address of such applicant, opponent, patentee or registered proprietor. Unless such an address is given, the Controller shall be under no obligation either to proceed with the application or the opposition, or to send any notice that may be required by the Act or these rules.

[Compare Rule 7 of the English Patents Rules, 1932.]

**5. Fees.**—(1) The fees to be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under the Act, shall be those specified in the First Schedule to these rules, hereinafter referred to as the prescribed fees:

Provided that no fees shall be payable in respect of any secret patent, and every such patent notwithstanding the non-payment of such fees shall remain in force for the full period of 16 years from its date.

(2) Fees may be paid in cash at the Office, or may be sent by money order or postal order or cheque payable to the Controller at Calcutta. Cheques not carrying the correct addition for commission, and other cheques on which the full value cannot be collected in cash within the time allowed for payment of the fee, shall be accepted only at the discretion of the Controller. Stamps shall not be received in payment of fees.

[Compare Rules 3, 58 to 60, and 101 of the English Patents Rules, 1932.]

**6. Forms.**—The forms set forth in the Second Schedule, with such variations as the circumstances of each case require, shall be used for the respective purposes therein mentioned, and if used, shall be sufficient:

Provided that the Controller may, if he thinks fit, dispense with the use of Form 4 in the case of an application for extension of time under sub-section (2) of section 14 of the Act.

[Compare Rules 4 and 9 of the English Patents Rules, 1932.]

**7. Size, etc., of documents.**—(1) All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Controller, shall be written, typewritten, lithographed, or printed in the English language (unless otherwise directed), in large and legible characters with deep permanent ink upon one side only of strong white paper of a size of approximately 13 inches by 8 inches, with a margin of at least one inch and a half on the left-hand part thereof. Signatures thereto shall be written in a large and legible hand, and a vernacular signature shall be accompanied by a transliteration in English.

(2) Duplicate documents shall be filed at the Office, if at any time required by the Controller.

(3) Names and addresses of applicants and other persons shall be given in full, together with their nationality and such other particulars, if any, of caste or calling as are necessary for identification.

[Compare Rule 5 of the English Patents Rules, 1932.]

**8. Signature and verification of documents specified in section 75 of the Act.**—The documents specified in section 75 of the Act shall be dated and signed

at the foot, and shall contain a statement that the facts and matters stated therein are true to the best of the knowledge, information and belief of the person signing them.

[Compare Rule 8 of the English Patents Rules, 1932.]

**9. Agency.** For all matters falling under the provisions of section 76 of the Act, any person may, unless otherwise directed by the Controller, authorise, under his personal signature, any other person to act as his agent and to receive all notices, requisitions and communications. The authority may be given on Form 31.

[Compare Rule 8 of the English Patents Rules, 1932.]

## CHAPTER II.

### PATENTS.

#### Applications for Grant of Patents.

**10. Application.**—(1) If the true and first inventor or any applicant for a patent is in the service of the Crown, he shall disclose that fact in the application and shall state the office which he holds.

(2) If the true and first inventor is not a party to an application for a patent, the applicant shall, except in the case of reciprocity applications, produce the original deed of assignment or other document from such true and first inventor, under which he is enabled to apply for a patent, unless the application itself is endorsed by the true and first inventor in the presence of two witnesses with a statement that the said inventor agrees that the application shall be made without his name as an applicant for a patent.

(3) If an application for a patent is made by the legal representative of a deceased inventor, the legal representative shall produce for inspection the probate of the will or the letters of administration of the estate of the inventor or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require.

[Compare Rules 9, 10 and 12—13 of the English Patents Rules, 1932.]

**11. Reciprocity application.**—(1) Every reciprocity application shall contain a declaration that a British application has been made for protection of the invention to which such reciprocity application relates, and shall specify every part of His Majesty's dominions and every State in India in which any such British application has been made and the official date or dates thereof, respectively. The application shall be made within twelve months from the date of the first British application, and shall be signed by the person by whom such first British application was made or by his legal representative or assignee or by an agent resident in British India authorised in that behalf.

(2) If a reciprocity application is made by an assignee of the person who made the British application the applicant shall produce the original deed of assignment or other document from such person, under which he is enabled to apply for a patent, unless the application itself is endorsed in the presence of two witnesses by the person who made the British application with a statement to the effect that the applicant is his assignee.

(3) If a reciprocity application is made by the legal representative of a deceased person who made the British application, the legal representative shall produce for inspection the probate of the will or the letters of administration of

the estate of the deceased person or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require.

(4) In addition to the specification left with every reciprocity application, a copy or copies of the specification or specifications, and drawings or documents filed or deposited by the applicant or his predecessor in title, as the case may be, in respect of the first British application, duly certified by the official chief or head of the Patent Office in which they were filed or deposited, or otherwise verified to the satisfaction of the Controller, shall be left at the Office at the same time as the reciprocity application or within such further time, not exceeding three months, as the Controller may allow.

(5) If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and shall be verified to the satisfaction of the Controller.

(6) Save as aforesaid and as provided by Rule 50, all proceedings in connection with a reciprocity application shall be taken within the time and in the manner required by the Act or prescribed by these rules for ordinary applications.

[Compare Rules 14—17 of the English Patents Rules, 1932.]

**12. Order of recording applications.**—Applications shall, on receipt by the Controller, be numbered in the order of their receipt.

[Compare Rule 11 of the English Patents Rules, 1932.]

### SPECIFICATIONS.

**13. Specification.**—(1) The specification shall commence with the title of the invention and the name of the applicant as in the application. It shall terminate with a clear and succinct statement of the invention claimed, distinct from the body of the specification, and claims shall be signed and dated by the applicant or his agent.

(2) The specification in respect of a patent of addition shall contain a specific reference to the number of the main patent, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent.

(3) Where the invention is capable of representation by drawings, such drawings shall be prepared in accordance with Rules 15 to 18 and shall be supplied with, and referred to in detail in, the specification.

(4) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.

[Regarding claims, Rule 13 of the English Patents Rules, 1932.]

**14. Amendments how to be made.**—(1) When the specification, or any drawing accompanying it, is defective and requires amendment, one copy shall be returned to the applicant or his agent and all alterations shall be made thereon as far as possible. Additional matter may be interpolated, if necessary, by rewriting such pages as are required to form a continuous document. Amendments shall not be made by slips pasted on, or as footnotes, or by writing in the margin.

(2) The amended documents shall be returned to the Controller together with the superseded pages or drawings, if any, duly marked, cancelled and initialled by the applicant or his agent, and with a duplicate of any pages that have been retyped or added and of any drawings that have been added or

substantially amended. Amendments, alterations or additions shall be initialled in the margin by the applicant or his agent.

(3) No amendments, alterations or additions shall be made in a document returned for amendment, beyond those necessary to comply with the requirements of the Controller.

**15. General.**—(1) Drawings, when furnished, shall accompany the specification to which they refer. No drawing or sketch, such as would require the preparation for the printer of a special illustration for use in the letter-press of the specification when printed, shall appear in the specification itself.

(2) Drawings shall be delivered flat or so rolled as to be free from creases.

(3) At least one copy of the drawings shall be suitable for reproduction, and for that purpose, shall be prepared on tracing cloth or on smooth white paper which is not opaque.

**16. Size of drawings and arrangement of figures.**—(1) Drawings shall be on sheets which measure 13 inches from top to bottom and are either from 8 inches to  $8\frac{1}{4}$  inches or from 16 inches to  $16\frac{1}{4}$  inches wide, the narrower sheets being preferable. A clear margin shall be left half an inch from the edges of the sheet.

(2) If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets shall be used in preference to employing the larger size. When an exceptionally large figure is required, it shall be continued on subsequent sheets, of which any number that are required but not more than are required, may be employed. The figures shall be numbered consecutively throughout and without regard to the number of sheets. They shall be separated by a sufficient space to keep them distinct.

**17. Drawings to be suitable for reproduction.** Drawings shall be prepared in accordance with the following requirements:—

- (a) They shall be executed with absolutely black ink.
- (b) Each line shall be firmly and evenly drawn, sharply defined and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines shall be as few as possible, and shall not be closely drawn.
- (d) Shading lines shall not contrast too much in thickness with the general lines of the drawings.
- (e) Sections and shading shall not be represented by solid black or washes.
- (f) They shall be on a scale sufficiently large to show the inventions clearly, and only so much of the apparatus, machine, etc., shall appear as effects this purpose. If the scale is given, it shall be drawn and not denoted by words. No dimensions shall be marked on the drawings.
- (g) The figures shall be drawn in an upright position in regard to the top and bottom of the sheet.
- (h) Reference letters and numerals, and index letters and numerals used in conjunction therewith, shall be bold, distinct and not less than one-eighth of an inch in height. The same letters or numerals shall be used to indicate the same parts in different views. Where the reference letters or numerals are shown outside the figure, they shall be connected by fine lines with the parts to which they refer.

**18. Drawings to bear name of applicant, etc., but no descriptive matter.—**

(1) Drawings shall bear:—

- (i) in the left hand top corner, the name of the applicant and the words "No. of 19";
- (ii) in the right hand top corner, the number of the sheets of drawings sent and a consecutive number of each sheet;
- (iii) in the right hand bottom corner, the signature of the applicant or his agent.

(2) Neither the title of the invention nor any descriptive matter shall appear on drawings.

[Regarding Rules 15—18 above, compare Rules 18—25 of the English Patents Rules, 1932.]

**19. The Controller shall advertise the acceptance of every application in the "Gazette of India."**

[Compare Rule 40 of the English Patents Rules, 1932.]

**OPPOSITIONS TO GRANT OR AMENDMENT, ETC.**

**20. Notice of Opposition.**—Notice of opposition to the grant, or to the amendment, etc., of a patent shall be given in duplicate. One copy of the notice shall be sent by the Controller to the applicant or his agent.

**21. Filing of statements.**—(1) Within 14 days of giving notice of opposition, the opponent shall leave at the Office a full written statement in duplicate, setting out fully the nature of the opponent's interests, the facts upon which he bases his case and the relief which he seeks.

(2) The Controller shall furnish the applicant or his agent with one copy of the statement referred to in sub-rule (1), and the applicant or his agent may leave at the Office a reply in writing within a time to be specified by the Controller. Such reply shall deal in full with the statement of the opponent and shall be in duplicate.

(3) If the reply referred to in sub-rule (2) is supplied by the applicant, the Controller shall furnish the opponent or his agent with one copy thereof, and the opponent or his agent may again leave at the Office a rejoinder in writing within a time to be specified by the Controller. Such rejoinder shall be confined strictly to matters in the reply, and shall be in duplicate. One copy of the rejoinder shall be sent by the Controller to the applicant or his agent.

(4) The Controller may require at any time that any written statement, reply or rejoinder shall be in the form of an affidavit.

(5) The time allowed for filing a reply or rejoinder shall ordinarily be one month.

[Compare Rules 43 and 44 of the English Patents Rules, 1932.]

**22. Hearing.**—(1) On completion of these proceedings or at such other time as he may see fit, the Controller shall appoint a time for the hearing of the case, and shall give the parties not less than ten days' notice of such hearing.

(2) If either party desires to be heard, he shall leave Form 7 at the Office.

(3) The Controller may refuse to hear any party who has not left Form 7 prior to the date of hearing.

(4) If either party intends to refer at the hearing to any publication other than a specification already mentioned in the proceedings, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of each publication to which he intends to refer.

(5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, the Controller shall decide the case and notify his decision to the parties.

[Compare Rule 49 of the English Patents Rules, 1932.]

### SEALING.

**23. Sealing.**—(1) If an applicant desires to have a patent sealed on his application, he shall, within the period allowed by sub-section (2) of section 10 of the Act, leave at the Office an application on Form 8.

(2) Where for any reason a patent cannot be sealed within the period allowed, the applicant may apply to the Controller for an extension of the period not exceeding three months. An application for such an extension shall be accompanied by a fee of Rs. 10, Rs. 20 or Rs. 30 for an extension of one, two or three months, respectively.

[Compare Rules 51—53 of the English Patents Rules, 1932.]

**24. Form of patent.**—The patent shall be in the form given in the Third Schedule to these rules, with such modifications as the circumstances of each case may require.

[Compare Rules 55—57 of the English Patents Rules, 1932.]

### EXTENSION.

**25. Extension of term of patent.**—(1) A petition for the extension of the term of a patent shall set forth clearly the nature and merits of the invention in relation to the public, the profits made by the patentee as such and all the circumstances of the case.

(2) The Controller shall advertise every such petition in the "Gazette of India."

(3) Every such advertisement shall state the object of the petition and the address within British India for service on the patentee of any document requiring service under this rule. It shall also specify that notices of objections shall be lodged on Form 6 within two months from the date of the notification.

(4) Every such petition shall also be advertised by the patentee, in not less than two newspapers named by the Controller, within 14 days from the date of the notification in the Gazette and in the manner described in sub-rule (3). Copies of the newspapers containing these advertisements shall be supplied to the Controller.

(5) The petitioner shall, within three weeks of filing the petition, lodge a duplicate of the petition with two copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts shall be proved on oath. He shall also, upon receiving two days' notice, give the Controller or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of accounts, by reference to which he proposes to verify the said balance sheet or from which the materials for making up the said balance sheet have been derived.

(6) Any person desirous of opposing the prayer of the petition shall lodge with the Controller a notice on Form 6 accompanied by a fee of Rs. 5. Such person shall at the same time serve a copy of such notice upon the petitioner. Such notices shall be lodged and served within two months from the date of the notification of the petition in the "Gazette of India."



(7) The petitioner shall, within one week of the receipt of such notice, serve a copy of his petition upon each person giving such notice.

(8) Every person giving such notice as aforesaid shall, within 14 days from the service of the petition upon him, serve upon the petitioner one copy and lodge with the Controller two copies of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.

(9) Any person who shall not, within the said 14 days, lodge and serve such particulars of objections as aforesaid shall be deemed to have abandoned his opposition.

(10) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

(11) Any person who has delivered particulars of objections shall be entitled, at his own expense, to obtain copies of the accounts which have been lodged by the petitioner.

(12) The Controller may excuse petitioners and opponents from compliance with any of the requirements of sub-rules (5), (7), (8) and (10) and may give such directions in matters of procedure and practice as he shall consider to be just and expedient.

(13) Service of any document requiring service under this rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.

(14) On completion of these proceedings, if any, or at such other time as he may see fit, the Controller shall forward one copy of the documents left by the party or parties to the Governor-General-in-Council through the Secretary in the Department of Industries and Labour.

### RESTORATION.

**26. Restoration of lapsed patent.** If the Controller entertains an application under section 16 of the Act for the restoration of a lapsed patent, he shall advertise it in the "Gazette of India."

**27. Opposition.**—Notice of opposition to the restoration may be given within six weeks of the advertisement, and the procedure for the disposal of such opposition shall be regulated by the provisions of Rules 20, 21 and 22.

[Regarding Rules 26 and 27 above, compare Rules 61–64 of the English Patents Rules, 1932.]

**28. Conditions on Restoration.**—(1) In every order of the Controller restoring a patent, provisions shall be inserted for restraining the patentee from commencing or prosecuting any action or other proceeding, and from recovering damage—

(a) in respect of making, selling or using the invention, or

(b) in respect of selling or using at any time thereafter any article made, in infringement of the patent between the date of the lapsing of the patent and the date of the order of restoration.

(2) The order shall further provide that if any person within one year after the date thereof makes an application to the Controller for compensation in respect of money, time, or labour expended by the applicant upon the subject matter of the patent, in the *bona fide* belief that such patent had become and continued to be void, it shall be lawful for the Controller, after hearing the parties concerned, and subject to an appeal to the Governor-General-in-Council, to assess the amount of such compensation, if in his opinion the application

ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid; and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

[Compare Rules 65 and 66 of the English Patents Rules, 1932.]

### AMENDMENT OF APPLICATION OR SPECIFICATION.

**29. Amendment.**—A request under section 17 of the Act for the amendment of an application, or a specification including drawings shall be accompanied by a copy of the application, specification, or drawings showing in red ink the proposed amendment in such a manner as to indicate clearly the alteration desired.

**30. Procedure when application for a patent has been accepted.**—If the request relates to an application for a patent which has been accepted, the request and the nature of the proposed amendment shall be advertised by notification in the "Gazette of India" and in such other manner, if any, as the Controller may in each case direct. The Controller shall also notify all persons whose names, at the time of the request, are entered on the register as claiming an interest in the patent.

**31. Opposition.**—Rules 20, 21 and 22 shall be applicable to the disposal of any opposition to the amendment, of which notice may be given in accordance with sub-section (3) of section 17 of the Act.

[Regarding Rules 29—31 above, compare Rules 67—69 and Rules 72—73 of the English Patents Rules, 1932.]

**32. Requirements on amendment.**—(1) Where leave to amend is given, the applicant shall, if the Controller so requires, and within a time to be specified by him, leave at the Office a new specification and amended drawings which shall be prepared in the manner prescribed in Rules 15 to 18.

(2) Amendments allowed by the Controller, after an application for a patent has been accepted, shall be advertised by him in the "Gazette of India."

[Compare Rules 70 and 71 of the English Patents Rules, 1932.]

### SURRENDER.

**33. Surrender of patents.**—(1) If an offer is made for the surrender of a patent under section 24 of the Act, the Controller shall advertise it in the "Gazette of India" and shall notify all persons whose names, at the time of the offer, are entered on the register as claiming an interest in the patent.

(2) Notice of opposition to the revocation of a patent offered for surrender shall be given within six weeks of the advertisement, and the procedure for the disposal of such opposition shall be regulated by the provisions of Rules 20, 21 and 22.

[Compare Rule 83 of the English Patents Rules, 1932.]

**CHAPTER III.****Designs.**

*[N.B.—Rules 34 to 48 comprising Chapter III, since they relate exclusively to Designs, have been here omitted.]*

**CHAPTER IV.****General.****REGISTER OF PATENTS AND DESIGNS.**

**49. Entry of grant.**—Upon the sealing of a patent, the Controller shall cause to be entered in the Register of Patents the name, address and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

*[Compare Rule 93 of the English Patents Rules, 1932.]*

**50. Entry in respect of reciprocity application.**—The patent granted on any reciprocity application shall be entered in the register as dated of the official date of the first British application in respect of which the reciprocity application was made, and the payment of renewal fees and the expiration of the patent shall be reckoned as from that date. The date of the reciprocity application shall also be entered in the register.

*[Compare Rule 94 of the English Patents Rules, 1932.]*

**51. Entry of renewal fee.**—Upon payment of the fee prescribed for the continuance of a patent, the Controller shall cause to be entered in the Register of Patents a record of the date of payment of such fee.

*[Compare Rule 101 of the English Patents Rules, 1932.]*

**52. Registering designs.**—When a design is accepted, there shall be entered in the Register of Designs, in addition to the particulars required by the Act, the number of the design, the class in which it is registered, the date of filing the application for registration in this country, the reciprocity date, if any, claimed for the registration, and such other matters as would affect the validity or proprietorship of the design.

**53. Alteration of address.** If a patentee or a proprietor of a registered design sends to the Controller notice in respect of an alteration in his name, or address, or addresses for service, the Controller shall cause the register to be altered accordingly.

*[Compare Rule 95 of the English Patents Rules, 1932.]*

**54. Application for entry of subsequent proprietorship.**—Where a person becomes entitled, by assignment, transmission, or other operation of law, to a patent, or to a copyright in a registered design, or to any interest therein, as mortgagee or licensee, application shall be made to the Controller for the entry in the register, of his name as proprietor or part proprietor of the patent, or design, or of a notice of such interest, as the case may be.

**55. Particulars in applications.**—An application under Rule 54 shall contain the name, address and nationality of the person claiming to be entitled, together with full particulars of the instrument, if any, under which he claims.

*[Regarding Rules 54 and 55 above, compare Rule 96 of the English Patents Rules, 1932.]*

**56. Production of documents of title and other proof.**—Every assignment, and every other document containing, giving effect to or being evidence of the transmission of a patent or of copyright in a registered design or affecting the proprietorship thereof as claimed by such application, shall, unless the Controller otherwise directs, be presented to him together with the application, and he may call for such other proof of title or written consent as he may require for his satisfaction:

Provided that in the case of a document which is a public document an official or certified copy thereof may be presented.

[Compare Rule 97 of the English Patents Rules, 1932.]

**57. Form of entry.**—The entry to be made in the registers on a request under Rule 54 shall be in the following form:—

“ In pursuance of an application received on the \_\_\_\_\_,

registered as	<u>proprietors</u> <u>licensees</u> <u>mortgagees</u> etc.	by virtue of	<u>assignment</u> <u>licence</u> <u>mortgage deed</u> etc.
dated _____ and made between _____			
of the one part and _____ of the other part.”			

**58. Entry of notification of documents.**—An application for entry in the registers of notification of any document (not already provided for), purporting to affect the proprietorship of a patent, or of a registered design, shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Controller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

[Compare Rule 100 of the English Patents Rules, 1932.]

**59. Hours of inspection of registers.**—The Registers of Patents and Designs shall be open to the inspection of the public at all times on which the Office is open to the public, except at times when they are required for actual official use.

**60. Rectification of registers.**—If an application is made for the rectification of the Register of Patents or Designs under section 64 of the Act, the Controller shall notify all persons whose names, at the time of the application, are entered on the register as claiming an interest in the patent or design, and shall advertise the application in the “Gazette of India.”

**61. Opposition to rectification.**—Notice of opposition to any rectification of the Register of Patents or the Register of Designs may be given within six weeks of the advertisement of the application for rectification and the procedure for the disposal of such opposition shall be regulated by the provisions of Rules 20, 21 and 22.

### APPEALS.

**62. Appeals to the Governor-General-in-Council.**—(1) An appeal to the Governor-General-in-Council under any provision of the Act from a decision of the Controller shall be lodged with the Controller in duplicate and shall state fully the reasons for appealing.

(2) The Controller shall forward one copy of the appeal to the Governor-General-in-Council, who shall notify the appellant of its receipt.

(3) In appeals under sections 9, 10 (1A), 16 and 17 of the Act, the Governor-General-in-Council may either dismiss the appeal summarily or call upon the appellant or his agent to serve a copy of the appeal on the respondent or his agent.

(4) When so required by the Governor-General-in-Council, the appellant or his agent shall forthwith furnish the respondent or his agent with a copy of the appeal and intimate to the Controller the date of supply of the copy.

(5) If a copy of the appeal is supplied to the respondent or his agent, the respondent or his agent may leave at the Office a reply in writing within one month of the date of receipt of a copy of the appeal. Every such reply shall deal in full with the statement of the appeal, and shall be in triplicate.

(6) If a reply is supplied under sub-rule (5), the Controller shall furnish the appellant or his agent with one copy thereof and forward one copy to the Governor-General-in-Council.

(7) After considering the appeal and the reply, if any, the Governor-General-in-Council may either allow the appeal or call upon the appellant or his agent to furnish a rejoinder and, if so called upon, the appellant or his agent shall leave at the Office a rejoinder in writing within one month of the date of such requisition. The rejoinder shall be confined strictly to matters in reply and shall be in triplicate. One copy of the rejoinder shall be sent by the Controller to the respondent or his agent and one copy to the Governor-General-in-Council.

(8) On completion of these proceedings, if any, or at such other time as he may see fit, the Governor-General-in-Council shall consider the appeal together with the reply and the rejoinder, if any, and decide the case. The decision of the Governor-General-in-Council shall be communicated to the Controller and to the parties or their agents.

### CERTIFICATES.

**63. Certified copies of documents.**—Certified copies of any entry in the registers or certified copies of, or extracts from patents, specifications, disclaimers, affidavits, declarations and other public documents in the Office, or of or from registers and other books kept there, shall be furnished by the Controller on payment of the prescribed fee.

[Compare Rule 104, also Rule 105, of the English Patents Rules, 1932.]

### MISCELLANEOUS POWERS OF THE CONTROLLER.

**64. Exercise of discretionary power of Controller.**—The time within which a person entitled under section 67 of the Act to an opportunity of being heard shall exercise his option of requiring to be heard shall be one month from the date of a notice which the Controller shall give to such person or his agent before determining the matter with reference to which such person is entitled to be heard. If within that month such person or his agent requires to be heard, the Controller shall appoint a date for the hearing and shall give ten days' notice thereof:

Provided that if the giving of ten days' notice would cause an application for a patent or for the registration of a design to become void before the hearing the Controller may curtail the period of notice.

[Compare Rules 112 and 113 of the English Patents Rules, 1932.]

**65. Controller may require statement.**—Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a time to be notified by the Controller, or to attend before him and make explanations with respect to such matters as the Controller may require.

[Compare Rule 114 of the English Patents Rules, 1932.]

**66. General powers of amendment.**—Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure which, in the opinion of the Controller, may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit, and upon such terms as he may direct.

[Compare Rule 118 of the English Patents Rules, 1932.]

**67. General power to enlarge time.**—The time prescribed by these rules for doing any act or taking any proceeding thereunder may be enlarged by the Controller, if he thinks fit, and upon such terms as he may direct.

[Compare Rule 119 of the English Patents Rules, 1932.]

### REPEAL.

**68. Repeal.**—(1) The Indian Patents and Designs Rules, 1912, are hereby superseded, provided that any application or other matter pending under those rules on the date of the coming into force of these rules shall be disposed of under those rules.

(2) The notifications of the Government of India in the Department of Industries and Labour, No. A197, dated the 17th July, 1930, and the 4th November, 1932, are hereby superseded.

[Compare Rule 124 of the English Patents Rules, 1932.]

## THE FIRST SCHEDULE.

(See Section 57.)

### FEES.

Number of entry.	On what payable.	Number of form.	Proper fee.
			Rs. A. P.
1	On application for a patent under Section 3, 15A, or 78A.	1, 1A, 1B, 1C, 1AC, 1BC, 1CC, 2, 2A, 2C, 2AC.	10 0 0
2	On application for extension of time for filing documents under Rule 11 ..	4	10 0 0
	One month .. ..	....	20 0 0
	Two months .. ..	....	30 0 0
	Three months .. ..	....	
3	On application for extension of time to accept application under Section 5 (j).	4	20 0 0
4	On notice of opposition under Section 9 (i) .. ..	6	5 0 0

Number of entry.	On what payable.	Number of form.	Proper fee.
5	On notice of intention to attend hearing under Section 9 (2). By applicant and opponent respectively ..	7	Rs. A. P. 10 0 0
6	On request for sealing under Section 10 (1) .. ..	8	30 0 0
7	On notice of intention to attend hearing under Section 10 (1A) by each party.	7	10 0 0
8	On application for extension of time under Section 10 (2)(d) ..	4	....
	One month .. ..	....	10 0 0
	Two months .. ..	....	20 0 0
	Three months .. ..	....	30 0 0
9	For renewal under Section 14— <i>(a) In respect of patents the application for which was made before the 1st July 1930.</i>		
	Before expiration of 4th year in respect of the 5th year .. ..	....	50 0 0
	Before expiration of 5th year in respect of the 6th year .. ..	....	50 0 0
	Before expiration of 6th year in respect of the 7th year .. ..	....	50 0 0
	Before expiration of 7th year in respect of the 8th year .. ..	....	50 0 0
	Before expiration of 8th year in respect of the 9th year .. ..	....	50 0 0
	Before expiration of 9th year in respect of the 10th year .. ..	....	100 0 0
	Before expiration of 10th year in respect of the 11th year .. ..	....	100 0 0
	Before expiration of 11th year in respect of the 12th year .. ..	....	100 0 0
	Before expiration of 12th year in respect of the 13th year .. ..	....	100 0 0
	Before expiration of 13th year in respect of the 14th year .. ..	....	100 0 0
	Before expiration of 14th year in respect of the 15th year .. ..	....	150 0 0
	Before expiration of 15th year in respect of the 16th year .. ..	....	150 0 0

Number of entry.	On what payable.	Number of form.	Proper fee.
	For renewal under Section 14— <i>contd.</i>		Rs. A. P.
	<i>(b) In respect of patents the application for which was made on or after the 1st July 1930.</i>		
	Before expiration of 4th year in respect of the 5th year .. ..	....	50 0 0
	Before expiration of 5th year in respect of the 6th year .. ..	....	50 0 0
	Before expiration of 6th year in respect of the 7th year .. ..	....	50 0 0
	Before expiration of 7th year in respect of the 8th year .. ..	....	50 0 0
	Before expiration of 8th year in respect of the 9th year .. ..	....	100 0 0
	Before expiration of 9th year in respect of the 10th year .. ..	....	100 0 0
	Before expiration of 10th year in respect of the 11th year .. ..	....	100 0 0
	Before expiration of 11th year in respect of the 12th year .. ..	....	100 0 0
	Before expiration of 12th year in respect of the 13th year .. ..	....	150 0 0
	Before expiration of 13th year in respect of the 14th year .. ..	....	150 0 0
	Before expiration of 14th year in respect of the 15th year .. ..	....	150 0 0
	Before expiration of 15th year in respect of the 16th year .. ..	....	150 0 0
	<i>Note—The fees for two or more years may be paid in advance.</i>		
10	On application for extension of time for payment of renewal fees under Section 14 (2) .. ..	4	....
	One month .. ..	....	10 0 0
	Two months .. ..	....	20 0 0
	Three months .. ..	....	30 0 0
11	On petition for extension of term of patent under Section 15 ..	9	50 0 0



Number of entry.	On what payable.	Number of form.	Proper fee.
12	On notice of opposition to extension of term of patent under Section 15 (2) .. ..	6	Rs. A. P. 5 0 0
13	On certificate of renewal in respect of each year, on patents extended or a new patent granted under Section 15.	....	150 0 0
14	On application for restoration of lapsed patents under Section 16 ..	10	100 0 0
15	On notice of opposition to restoration under Section 16 .. ..	6	5 0 0
16	On notice of intention to attend bearing under Section 16. By applicant and opponent respectively ..	7	10 0 0
17	On application to amend under Section 17 .. ..	11	....
	Before acceptance .. ..	....	10 0 0
	After acceptance .. ..	....	20 0 0
18	On notice of opposition to amendment under Section 17 (3). .. ..	6	5 0 0
19	On notice of intention to attend hearing under Section 17 (4). By applicant and opponent respectively,	7	10 0 0
20	On petition for compulsory licence or revocation under Sections 22 and 25.	....	10 0 0
21	On offer to surrender a patent under Section 24 .. ..	12	10 0 0
22	On notice of opposition to the surrender of a patent under Rule 33 ..	6	5 0 0
23	On notice of intention to attend hearing under Section 24. By applicant and opponent respectively ..	7	10 0 0
24	For duplicate of a patent under Section 39 .. ..	13	10 0 0
25	On notice to Controller of intended exhibition of an invention or design under Section 40 or 52 ..	14	5 0 0
26	On request to register design under Section 43 or 78A .. ..	15, 16	....
	In Classes 1 to 12 .. ..	....	3 0 0
	In Classes 13 and 14 .. ..	....	0 8 0

Number of entry.	On what payable.	Number of form.	Proper fee.
			Rs. A. P.
27	On request to register design under Section 43 to be applied to a set in a Class .. ..	17	3 0 0
28	On request for written decision under Rule 41 .. ..	18	5 0 0
29	On request to extend copyright under Section 47 .. ..	19	10 0 0
	<i>Note.—This fee may be paid in advance.</i>		
30	On request to inspect under Section 50.	....	1 0 0
31	On request for information under Section 51 when registration number is supplied .. ..	20	2 0 0
32	On request for information under Section 51 when registration number is not supplied .. ..	21	10 0 0
33	On request for inspection of the register under Section 59 .. ..	....	1 0 0
34	On request for certificate under Section 59 .. ..	29	5 0 0
	An additional fee of 1 anna for every 100 words or part thereof will be charged for preparing copies of specifications, etc. Drawings will be charged according to agreement.		
35	For office copies of drawings ..	....	(cost according to agreement).
36	For certifying office copies, MSS. or printed, each .. ..	....	2 0 0
37	For office copy of design ..	....	(cost according to agreement)..
38	On request to correct under Section 62.	28	5 0 0
39	On application to the Controller for cancellation of registration of design under Section 51A .. ..	22	5 0 0
40	On notice of intention to attend hearing under Rule 48 .. ..	7	10 0 0

Number of entry.	On what payable.	Number of form.	Proper fee.
41	On application under Section 63 for entry of name of subsequent proprietor in the Register of Patents or of Designs, if made within six months from date of acquisition of proprietorship or of the coming into force of these Rules:—	25	Rs. A. P. ....
	In respect of one patent or design ..	....	5 0 0
	For each additional patent or design	....	2 0 0
42	On application under Section 63 for entry of name of subsequent proprietor in the Register of Patents or of Designs, if made after expiration of six months from date of acquisition of proprietorship and the coming into force of these Rules:—	25	....
	In respect of one patent or design	....	20 0 0
	For each additional patent or design	....	2 0 0
43	On application under Section 63 for entry of notice of a mortgage or licence in the Register of Patents or of Designs, if made within six months from date of acquisition of interest or the coming into force of these Rules:—	26	....
	In respect of one patent or design ..	....	5 0 0
	For each additional patent or design	....	2 0 0
44	On application under Section 63 for entry of notice of a mortgage or licence in the Register of Patents or of Designs, if made after expiration of six months from date of acquisition of interest and the coming into force of these Rules:—	26	....
	In respect of one patent or design ..	....	20 0 0
	For each additional patent or design	....	2 0 0
45	On application under Section 63 for entry of notification of a document in the Register of Patents or of Designs, if made within six months from date of documents, the grant of the patent, the registration of the design, or the coming into force of these Rules:—	27	....
	In respect of one patent or design ..	....	5 0 0
	For each additional patent or design	....	2 0 0

Number of entry.	On what payable.	Number of form.	Proper fee.
46	On application under Section 63 for entry of notification of a document in the Register of Patents or of Designs, if made after expiration of six months from date of document, the grant of the patent, the registration of the designs, and the coming into force of these Rules:—	27	Rs. A. P. ....
	In respect of one patent or design	....	20 0 0
	For each additional patent or design	....	2 0 0
47	On request to alter name, address or address for service in Register under Section 62 .. .. .	23	1 0 0
48	For entry of two addresses for service in Register under Section 20 or 46 ..	24	2 0 0
49	On application for rectification of Register under Section 64 ..	30	10 0 0
50	On notice of opposition to the rectification of the Register under Rule 61 ..	6	5 0 0
51	On notice of intention to attend hearing under Rule 61. By applicant and opponent respectively .. ..	7	10 0 0
52	On appeal from the Controller to the Governor-General-in-Council under Sections 5, 9, 10 (1A), 16, 17, 43 or 69 .. .. .	5	30 0 0

**THE SECOND SCHEDULE.****FORMS.****List of Forms.**

Form No.	Section of the Act	Title.
1	3	Application for patent when inventor is a sole or joint applicant.
1A	3	Application for patent by assignee or legal representative of inventor.
1B	3	Application for patent for invention "communicated" from abroad.
1C	15A	Application for patent of addition when inventor is a sole or joint applicant.
1AC	15A	Application for patent of addition by assignee or legal representative of inventor.
1BC	15A	Application for patent of addition for invention "communicated" from abroad.
1CC	15A	Application for second or subsequent patent of addition.
2	78A	Application for patent under reciprocal arrangement, by "British" applicant.
2A	78A	Application for patent under reciprocal arrangement, by assignee or legal representative of "British" applicant.
2C	15A, 78A	Application for patent of addition under reciprocal arrangement, by "British" applicant.
2AC	15A, 78A	Application for patent of addition under reciprocal arrangement, by assignee or legal representative of "British" applicant.
3	4	Specification.
4	5 (4), 10 (2), 14 (2), (Rule 11).	Application for extension of time.
5	5, 9, 10 (1A), 16, 17, 43, 69.	Appeal.
6	9 (1), 15, 16, 17, (Rule 25, 33 or 61).	Notice of opposition.
7	9 (2), 10 (1A), 16, 17, 24, (Rule 48 or 61).	Notice of intention to attend hearing.
8	10	Request for sealing.

Form No.	Section of the Act.	Title.
9	15	Petition for extension of patent.
10	16	Application for restoration of patent.
11	17	Application to amend.
12	24	Offer to surrender patent.
13	39	Application for duplicate patent.
14	40, 52	Notice of intended exhibition.
15	43	Application for registration of design.
16	78A	Application for registration of design under reciprocal arrangements.
17	43	Application for registration of design applicable to a set.
18	(Rule 41).	Request for grounds of decision.
19	47	Application for extension of copyright.
20	51	Request for information when registration number is furnished.
21	51	Request for information when registration number is not furnished.
22	51A	Application to the Controller to cancel registration of design.
23	62	Request to alter name or address or address for service in Register.
24	20, 46	Request for entry of two addresses in Register.
25	63	Application for entry in Register.
26	63	Application for entry in Register.
27	20, 63 (Rule 58).	Application for entry of notification of documents in Register.
28	62	Request for correction.
29	59 (Rule 63).	Request for certificate.
30	64	Application for rectification of Register.
31	76	Power of authority to agent.

[N.B.—Copies of the numerous forms here given in this Second Schedule have not been printed here, since actual forms as may be required are readily obtainable from the Indian Patent Office on an application accompanied by a stamped and addressed envelope. See also the Indian Patent Office Handbook, 5th Edn. at page 68.]

**THE THIRD SCHEDULE.****Model Form of Patent.****GOVERNMENT OF INDIA.**

The Patent Office.

No.            of 19     .

Whereas \_\_\_\_\_

\_\_\_\_\_ hath declared that he is in possession of an invention for \_\_\_\_\_

\_\_\_\_\_ and that he is the \_\_\_\_\_ true and first inventor thereof (or the legal representative or assign of the true and first inventor) and that the same is not in use in British India by any other person to the best of his knowledge, information and belief;

And whereas he hath humbly prayed that a patent might be granted to him for the said invention;

And whereas he hath by and in his specification (of which a printed copy is hereunto annexed) particularly described and ascertained the nature of the invention and the manner in which the same is to be performed;

The Governor-General-in-Council is pleased to order by these presents that the above said petitioner (including his legal representatives and assigns or any of them) shall, subject to the provisions of the Indian Patents and Designs Act, 1911, as patentee have the exclusive privilege of making, selling and using the invention throughout British India (including British Baluchistan, the Santhal Parganas and the Shan States) and of authorising others, so to do for the term of sixteen years from the \_\_\_\_\_ day of \_\_\_\_\_ 19     , subject to the conditions that the validity of this patent is not guaranteed by Government, and also provided that the fees prescribed for the continuation of this patent are duly paid.

In witness whereof the Governor-General-in-Council has caused this patent to be sealed as of the day of \_\_\_\_\_ 19     .

Signature of Controller \_\_\_\_\_

Date of Sealing \_\_\_\_\_

*Note.*—Renewal fees will be due on this patent, if it is to be maintained, on the \_\_\_\_\_ day of \_\_\_\_\_ 19     , and on the same day in each year thereafter.

**THE FOURTH SCHEDULE.****Classification of Goods.**

[N.B.—The contents of this Fourth Schedule comprising details of the descriptions of the various clauses in which goods are to be registered for the purpose of the Registration of Designs, since the Schedule relates exclusively to Designs, have here been omitted.]

**INDIAN SECRET PATENT RULES, 1933.**

[*N.B.—These rules were published in the "Gazette of India," dated 11th February 1933, Part II. There have been no amendments to these rules since that date. The following is accordingly the form in which these rules are current and effective up to date (i.e., as on 31st October, 1936).*]

**Notification No. A-197, dated the 3rd February 1933.**—In exercise of the powers conferred by clause (iii) of sub-section (1) and by sub-section 24 of section 77 of the Indian Patents and Designs Act, 1911 (II of 1911), the Governor-General-in-Council is pleased to make the following rules:—

1. **Short title.**—These rules may be called the Indian Secret Patent Rules, 1933.

2. **Definitions.**—In these rules, unless there is anything repugnant in the subject or context—

- (a) "Act" means the Indian Patents and Designs Act, 1911;
- (b) "Controller" means the Controller of Patents and Designs appointed under section 56 of the Act, and includes any officer appointed to act for him;
- (c) "Office" means the Patent Office provided under section 55 of the Act.

3. **Secret patents.** (1) When it has been decided by the Governor-General-in-Council that it is advisable to take out a secret patent for any invention assigned under section 21A of the Act to the Secretary of State for India in Council on behalf of His Majesty, and an application for such patent has been made on Form 1D annexed hereto accompanied by a certificate of the Governor-General-in-Council under the said section, the Controller shall not communicate the application or any documents relating thereto to any member of his staff other than an examiner or examiners specially authorised by him in this behalf who shall make the investigations required to be made under section 5 (1) of the Act in the case of other applications for patents.

(2) Unless and until such invention is re-assigned to the inventor by the Secretary of State for India in Council:—

- (a) the application for the patent and the acceptance of the same shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under section 9 of the Act; but the Controller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the application relating thereto;
- (b) every such secret patent shall be registered in a confidential register at the office and no details or particulars relating thereto shall at any time be published as required by the Act in the case of patents other than secret patents, nor shall any entry be made in the ordinary Register of Patents in respect of any such secret patent or any assignment thereof.



4. **Re-assignment.**—In the event of any secret patent being re-assigned to the inventor by the Secretary of State for India in Council—

- (a) an entry to that effect shall be made in the ordinary Register of Patents as well as in the confidential Register of Patents;
- (b) all fees that would have been thereafter payable if the patent had not been a secret patent shall be paid in respect thereof;
- (c) the patent shall remain in force only for the same term, and subject to the same conditions as to payments of fees and otherwise as if it had not been a secret patent.

Form 1D.

### INDIAN PATENTS AND DESIGNS ACT, 1911.

#### Application for a Secret Patent. Section 21A.

*(To be accompanied by the specification in duplicate on Form 3 prescribed by the Indian Patents and Designs Rules, 1933, and a certificate under section 21A.)*

I (or we)<sup>1</sup>\_\_\_\_\_ do hereby declare—

- (I) that I am (or we are) in possession of an invention for<sup>2</sup>\_\_\_\_\_
- (II) that<sup>3</sup>\_\_\_\_\_ claim to be the true and first inventor thereof;
- (III) that the invention is not in use in British India by any other person;
- (IV) that the specification filed with this application is, and any amended specification which may hereafter be filed in this behalf will be true of the invention to which this application relates;
- (V) that the facts and matters stated herein are true to the best of my (or our) knowledge, information and belief.

I (or we) humbly pray that a secret patent may be granted to me (or us) for the said invention.

Dated this<sup>4</sup>\_\_\_\_\_ day of \_\_\_\_\_ 19\_\_\_\_

(Signed)<sup>4</sup>\_\_\_\_\_

To

THE CONTROLLER OF PATENTS AND DESIGNS,

1, Council House Street, Calcutta.

<sup>1</sup>Insert (in full) name, address and nationality of applicant or applicants.

<sup>2</sup>Insert title of invention. <sup>3</sup>State who is or are the inventor or inventors. <sup>4</sup>To be dated and signed by applicant or applicants.

[Regarding corresponding English Rules concerning secret patents, compare Rules 106–108 of the English Patents Rules, 1932.]

## **APPENDIX VI.**

**INTERNATIONAL CONVENTION FOR THE PROTECTION OF  
INDUSTRIAL PROPERTY**

## **CONTENTS.**

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# INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

[Signed at the Hague, November 6, 1925.]

*Union Convention of Paris, March 20, 1883, for the Protection of Industrial Property, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, and at The Hague on November 6, 1925.*

[British ratification deposited, May 1, 1928.]

(Translation from the French text.)

THE President of the German Reich; the President of the Austrian Republic; His Majesty the King of the Belgians; the President of the United States of Brazil; the President of the Republic of Cuba; His Majesty the King of Denmark; the President of the Dominican Republic; His Majesty the King of Spain; the President of the Estonian Republic; the President of the United States of America; the President of the Republic of Finland; the President of the French Republic; His Majesty the King of the United Kingdom of Great Britain and Ireland and of British dominions beyond the Seas, Emperor of India; His Serene Highness the Governor of Hungary; His Majesty the King of Italy; His Majesty the Emperor of Japan; His Majesty the Sultan of Morocco; the President of the United States of Mexico; His Majesty the King of Norway; Her Majesty the Queen of the Netherlands; the President of the Polish Republic, in the name of Poland and of the Free City of Danzig; the President of the Portuguese Republic; His Majesty the King of the Serbs, Croats and Slovenes; His Majesty the King of Sweden; the Federal Council of the Swiss Confederation; the States of Syria and Grand Lebanon; the President of the Czechoslovak Republic; His Highness the Bey of Tunis; the President of the Turkish Republic,

Having deemed it expedient to make certain modifications in, and additions to, the International Convention of the 20th March, 1883, for the creation of an International Union for the Protection of Industrial Property, revised at Brussels on the 14th December, 1900, and at Washington on the 2nd June, 1911, have named as their Plenipotentiaries, that is to say:—

[Here followed all the names of the several representatives of the countries mentioned above.]

Who, after having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:—

## ARTICLE 1.

The contracting countries constitute themselves into a Union for the protection of industrial property.

The protection of industrial property is concerned with patents, utility models, industrial designs and models, trade marks, trade names and indications of source or appellations of origin, and the repression of unfair competition.

Industrial property is to be understood in the broadest sense and applies not only to industry and commerce properly so called, but likewise to agricultural industries (wines, corn, tobacco leaves, fruit, cattle, etc.) and extractive industries (minerals, mineral waters, etc.).

Under the term "patents" are included the various kinds of industrial patents recognised by the laws of the contracting countries, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

## ARTICLE 2.

Persons within the jurisdiction of each of the contracting countries shall, as regards the protection of industrial property, enjoy in all the other countries

of the Union the advantages that their respective laws now grant, or may hereafter grant, to their nationals, without prejudice to the rights specially provided by the present Convention. Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed on nationals.

Nevertheless, no condition as to the possession of a domicile or establishment in the country where protection is claimed may be required of persons entitled to the benefits of the Union for the enjoyment of any industrial property rights.

The provisions of the laws of each of the contracting countries relative to judicial and administrative procedure and competence, and to the choice of domicile or the authorisation of an agent which may be required by the laws of industrial property, are expressly reserved.

#### ARTICLE 3.

Persons within the jurisdiction of countries not forming part of the Union, who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union, are assimilated to persons within the jurisdiction of the contracting countries.

#### ARTICLE 4.

(a) Any person who has duly deposited an application for a patent, or for the registration of a utility model, industrial design or model or trade mark in one of the contracting countries, or his legal representative or assignee, shall enjoy, for the purposes of deposit in the other countries, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

(b) Consequently, a subsequent deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another deposit, by publication or exploitation of the invention, by the putting on sale of copies of the design or model, or by use of the mark.

(c) The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs and models and trade marks.

These periods start from the date of deposit of the first application in a country of the Union; the day of deposit is not included in the period.

If the last day of the period is a *dies non* in the country where protection is claimed, the period shall be extended until the first following working day.

(d) Any person desiring to take advantage of the priority of a previous deposit shall be bound to make a declaration giving particulars as to the date of such deposit and the country in which it was made. Each country will determine for itself the latest time at which such declaration must be made.

These particulars shall be mentioned in the publications issued by the competent authority, in particular on the patents and the specifications relating thereto.

The contracting countries may require any person making a declaration of priority to produce a copy of the application (with the specification, drawings, etc.) previously deposited. The copy, certified as correct by the authority by whom the application was received, shall not require any legal authentication, and may in any case be deposited at any time within three months from the deposit of the subsequent application. They may require it to be accompanied by a certificate from the proper authority showing the date of the deposit, and also by a translation.

No other formalities may be required for the declaration of priority at the time of depositing the application. Each of the contracting countries shall decide for itself what consequences shall follow the omission of the formalities prescribed by the present article, but such consequences shall in no case be more serious than the loss of the right of priority.

Subsequently, further proof in support of the declaration may be required.

(e) Where an application for the registration of an industrial design or model is deposited in a country in virtue of a right of priority based on a previous

deposit of an application for registration of a utility model, the period of priority shall only be that fixed for industrial designs and models.

Further, it is permissible to deposit in a country an application for the registration of a utility model in virtue of a right or priority based on the deposit of a patent application and *vice versa*.

(f) If an application for a patent contains multiple priority claims, or if examination reveals that an application contains more than one invention, the competent authority shall at least authorise the applicant to divide the application, subject to such conditions as may be imposed by domestic legislation, and preserving as the date of each part of the application the date of the initial application and, if necessary, the benefit of the right of priority.

#### ARTICLE 4bis.

Patents applied for in the various contracting countries by persons entitled to the benefits of the Union shall be independent of the patents obtained for the same invention in the other countries, whether members of the Union or not.

This stipulation must be strictly interpreted, for example, it shall be understood to mean that patents applied for during the period of priority are independent, in respect of the grounds for refusal and for revocation, as well as in respect of their normal duration.

The stipulation applies to all patents existing at the time when it comes into effect.

Similarly it shall apply, in the case of the accession of new countries, to patents in existence, either on one side or the other, at the time of accession.

#### ARTICLE 5.

The importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail revocation of the patent.

Nevertheless each of the contracting countries shall have the right to take the necessary legislative measures to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work.

These measures shall not provide for the revocation of the patent unless the grant of compulsory licences is insufficient to prevent such abuses.

In no case can the patent be made liable to such measures before the expiration of at least three years from the date of grant of the patent and then only if the patentee is unable to justify himself by legitimate reasons.

The protection of industrial designs and models may not, under any circumstances, be liable to revocation by reason of the importation of articles corresponding to those which are protected.

No sign or mention of registration shall be required on the goods in order to maintain recognition of the rights given by such registration.

If, in any country, the utilisation of a registered trade mark is compulsory, registration cannot be cancelled until after a reasonable period has elapsed, and then only if the person interested cannot justify the causes of his inaction.

#### ARTICLE 5bis.

An extension of time of not less than three months shall be allowed for the payment of the prescribed fees for the maintenance of industrial property rights, on condition (if the national legislation of a country so provides) of the payment of a supplementary fee.

In the case of patents, the contracting countries further undertake, either to increase the above-mentioned extension of time to not less than six months, or to provide for the restoration of a patent which has expired by reason of the non-payment of fees, subject in each case to the conditions prescribed by the domestic legislation.

#### ARTICLE 5ter.

In each of the contracting countries the following shall not be considered as infringements of the rights of a patentee.

1. The use on board vessels of other countries of the Union of a patented invention in the body of the vessel, in the machinery, tackle,

apparatus and other accessories, when such vessels penetrate temporarily or accidentally into the territorial waters of the country, provided that such invention is used exclusively for the actual needs of the vessel.

2. The use of a patented invention in the construction or working of aircraft or land vehicles of other countries of the Union, or of the accessories to such aircraft or vehicles, when such aircraft or vehicles penetrate temporarily or accidentally into the country.

#### ARTICLE 6.

Every trade mark duly registered in the country of origin shall be admitted for deposit and protected in its original form in the other countries of the Union.

Nevertheless, registration of the following may be refused or cancelled:—

1. Marks which are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed.
2. Marks which have no distinctive character, or which consist exclusively of signs or indications which serve in trade to designate the kind, quality, quantity, destination, value, place of origin of the goods or date of production, or which have become customary in the current language, or in the *bona fide* and recognised customs of the trade of the country where protection is claimed.

In arriving at a decision as to the distinctive character of a mark, all the circumstances of the case must be taken into account, including the length of time during which the mark has been in use.

3. Marks which are contrary to morality or public order.

It is understood that a mark cannot be considered as contrary to public order for the sole reason that it does not conform to some stipulation of the laws concerning marks, except where such stipulation itself relates to public order.

Shall be considered as the country of origin:

The country of the Union where the depositor has a real and effective industrial or commercial establishment; if he has not such an establishment, the country of the Union where he is domiciled, and if he is not domiciled in the Union the country of his nationality if he is a person within the jurisdiction of one of the countries of the Union.

In no case shall the renewal of the registration of a mark in the country of origin involve the obligation to renew the registration of the mark in other countries of the Union where it has been registered.

The benefits of priority shall be accorded to applications for the registration of marks deposited within the period fixed by Article 4, notwithstanding the fact that registration in the country of origin may not be completed until after the expiration of such period.

The stipulations of paragraph 1 do not exclude the right of requiring from a depositor a certificate of due registration, issued by the competent authority of the country of origin, but no legal authentication of such certificate shall be required.

#### ARTICLES 6bis.

The contracting countries undertake to refuse or to cancel, either administratively if their legislation so permits, or at the request of an interested party, the registration of any trade mark which is a reproduction of or an imitation capable of creating confusion with a mark considered by the competent authority of the country of registration to be well-known in that country as being already the mark of a person within the jurisdiction of another contracting country, and utilised for the same or similar classes of goods.

A period of at least three years shall be allowed for claiming the removal of such marks. This period shall run from the date of registration of the mark.

There shall be no limit to the period within which application may be made for the removal of marks registered in bad faith,

## ARTICLE 6ter.

The contracting countries agree to refuse or to cancel the registration, and to prohibit by appropriate measures the utilisation, without authorisation by the competent authorities, either as trade marks or as elements of trade marks, of armorial bearings, flags and other State emblems of the contracting countries, official signs and hall-marks indicating control or warranty adopted by them, and all imitations thereof from an heraldic point of view.

The prohibition of the utilisation of official signs and hall-marks indicating control or warranty shall apply solely in cases where the marks which contain them are intended to be utilised for the same or similar classes of goods.

For the application of these stipulations the contracting countries agree to communicate mutually through the medium of the International Bureau of Berne, the list of State emblems and official signs and hall-marks indicating control or warranty which they desire, or may hereafter desire, to place wholly or within certain limits, under the protection of the present Article, and all subsequent modifications of this list. Each contracting country shall forthwith make the lists so communicated available to the public.

Any contracting country may, within a period of twelve months from the receipt of the communication, transmit any objections which it may desire to offer to the country concerned through the medium of the International Bureau.

In the case of State emblems which are well-known the measures prescribed by paragraph I shall apply solely to marks registered after the signature of the present Convention.

As regards State emblems which are not well-known and official signs and hall-marks such stipulations shall be applicable only to marks registered more than two months after the receipt of the communication provided for in paragraph 3.

In cases of bad faith, however, each country shall be entitled to cause removal of marks, even though registered before the signature of the present Convention if they contain State emblems, signs or hall-marks.

The nationals of each country who have been authorised to make use of State emblems, signs or hall-marks of their country, may continue to use them even though they are similar to those of another country.

The contracting countries undertake to prohibit the unauthorised use in trade of the State armorial bearings of the other contracting countries, when such use is of a nature to cause deception as to the origin of the goods.

The above stipulations shall not prevent the countries from exercising the power given in the third subsection of paragraph 2 of Article 6, to refuse or to cancel the registration of marks containing, without authorisation, the armorial bearings, flags, decorations, and other State emblems or official signs or hall-marks adopted by a country of the Union.

## ARTICLE 7.

The nature of the goods to which the trade mark is to be applied can, in no case, form an obstacle to the registration of the mark.

## ARTICLE 7bis.

The contracting countries undertake to admit to deposit and to protect marks belonging to associations, the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

Nevertheless, each country shall be the sole judge of the particular conditions under which an association may be allowed to obtain protection for its marks.

## ARTICLE 8.

A trade name shall be protected in all the countries of the Union without necessity of deposit or registration, whether or not it forms part of a trade mark.

## ARTICLE 9.

All goods illegally bearing a trade mark or trade name shall be seized on importation into those countries of the Union where this mark or name has a right to legal protection.



Seizure shall be effected equally in the country where the mark or name was illegally applied, or in the country into which the goods bearing it may have been imported.

The seizure shall take place at the request either of the Public Prosecutor or of any other competent authority or of any interested party whether an individual or a body of persons corporate or unincorporate in conformity with the domestic law of each country.

The authorities shall not be bound to effect the seizure of goods in transit.

If the laws of a country do not admit of seizure on importation, such seizure shall be replaced by prohibition of importation or seizure within such country.

If the laws of any country do not admit either of seizure upon importation, or of prohibition of importation, or of seizure within the country, and pending the requisite modification of these laws, these measures shall be replaced by the remedies available in such cases to nationals.

#### ARTICLE 10.

The stipulations of the preceding Article shall be applicable to all goods which falsely bear as an indication of origin the name of a specified locality or country, when such indication is joined to a trade name of a fictitious character or used with fraudulent intention.

Any producer, manufacturer or trader, whether an individual or a body of persons, corporate or incorporate, engaged in the production, manufacture, or trade of such goods, and established either in the locality falsely indicated as the place of origin, in the district where the locality is situated, or in the country falsely indicated shall in any case be deemed a party interested.

#### ARTICLE 10bis.

The contracting countries are bound to assure to persons entitled to the benefits of the Union an effective protection against unfair competition.

Every act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

The following acts among others shall be prohibited:—

1. All manner of acts, of such a nature as to create confusion by any means whatsoever with the goods of a competitor;
2. False allegations, in the course of trade, of such a nature as to discredit the goods of a competitor.

#### ARTICLE 10 ter.

The contracting countries undertake to assure to persons within the jurisdiction of other countries of the Union appropriate legal remedies to repress effectively all acts referred to in Articles 9, 10 and 10bis.

They undertake, further, to provide measures to permit syndicates and associations which represent industries or trades interested, and of which the existence is not contrary to the laws of their country, to take proceedings in the Courts or before the administrative authorities with a view to securing repression of the acts referred to in Articles 9, 10 and 10bis so far as the law of the country in which protection is claimed permits such action to the syndicates and associations of that country.

#### ARTICLE 11.

The contracting countries shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs or models, and trade marks, in respect of goods exhibited at official, or officially recognised, international exhibitions held in the territory of one of them.

This temporary protection shall not prolong the periods of priority provided by Article 4. If, at a later date, the right of priority is invoked, the administration of each country may date the period of priority as from the date of introduction of the goods into the exhibition.

Each country may require, as proof of the identity of the object exhibited, and of the date of its introduction into the exhibition such evidence as it may consider necessary.

## ARTICLE 12.

Each of the contracting countries undertakes to establish a special Government department for industrial property, and a central office for communication to the public of patents, utility models, industrial designs or models, and trade marks.

This department shall publish an official periodical journal.

## ARTICLE 13.

The International Office, established at Berne under the name "Bureau international pour la Protection de la Propriété Industrielle" is placed under the high authority of the Government of the Swiss Confederation, which regulates its organisation and supervises its working.

The official language of the International Bureau is French.

The International Bureau centralises information of every kind relating to the protection of industrial property and collates and publishes it. It studies matters of general utility which interest the Union, and edits, with the help of documents supplied to it by the various Administrations, a periodical journal in French, dealing with questions concerning the object of the Union.

The numbers of this journal, as well as all the documents published by the International Bureau, are circulated among the Administrations of the countries of the Union in the proportion of the number of contributing units as mentioned below. Such further copies as may be desired, either by the said Administrations, or by societies or private persons, shall be paid for separately.

The International Bureau shall at all times hold itself at the service of countries of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property. The Director of the International Bureau will furnish an annual report on its working, which shall be communicated to all the countries of the Union.

The expenses of the International Bureau shall be borne by the contracting countries in common. Until fresh sanction is given, they must not exceed the sum of 120,000 Swiss francs per annum. This sum may be increased, in case of necessity, by a unanimous decision of one of the conferences referred to in Article 14.

To determine the quota which each country should contribute to this common total of expenses, the contracting countries and those which may afterwards join the Union are divided into six classes, each contributing in the proportion of a certain number of units, namely:—

1st class	25 units.
2nd "	20 "
3rd "	15 "
4th "	10 "
5th "	5 "
6th "	3 "

These co-efficients are multiplied by the number of countries in each class, and the sum of the products thus obtained gives the number of units by which the total expenses has to be divided. The quotient gives the amount of the unit of expense.

Each of the contracting countries will designate at the time of its accession the class in which it wishes to be placed.

The Government of the Swiss Confederation superintends the expenses of the International Bureau, advances the necessary funds and renders an annual account, which will be communicated to all the other Administrations.

## ARTICLE 14.

The present Convention shall be submitted to periodical revisions with a view to the introduction of amendments calculated to improve the system of the Union.

For this purpose, Conferences shall be held, successively in one of the contracting countries, among the delegates of the said countries.

The Administration of the country in which the Conference is to be held will make preparations for the work of that Conference, with the assistance of the International Bureau.

The Director of the International Bureau will be present at the meetings of the Conferences, and will take part in the discussions, but without the right of voting.

#### ARTICLE 15.

It is understood that the contracting countries respectively reserve to themselves the right to make separately, as between themselves, special agreements for the protection of industrial property, in so far as such agreements do not contravene the stipulations of the present Convention.

#### ARTICLE 16.

Countries which are not parties to the present Convention shall be allowed to accede to it upon their request.

This accession shall be notified through diplomatic channels to the Government of the Swiss Confederation, and by the latter to all the other countries.

It shall entail, as a matter of right, accession to all the clauses, and admission to all the advantages stipulated in the present Convention, and shall take effect one month after the dispatch of the notification by the Government of the Swiss Confederation to the other countries of the Union, unless a subsequent date has been indicated by the acceding country.

#### ARTICLE 16bis.

The contracting countries have the right of acceding to the present Convention at any time, on behalf of their Colonies, Possessions, Dependencies and Protectorates, or territories administered in virtue of a mandate from the League of Nations, or of any of them.

For this purpose they may either make a general declaration, including all their Colonies, Possessions, Dependencies and Protectorates, and the territories referred to in paragraph 1, in the accession, or may expressly name those which are included, or may confine themselves to indicating those which are excluded therefrom.

This declaration shall be notified in writing to the Government of the Swiss Confederation and by the latter to all the other countries.

Under the same conditions, the contracting countries may denounce the Convention on behalf of their Colonies, Possessions, Dependencies, and Protectorates, or the territories referred to in paragraph 1, or of any of them.

#### ARTICLE 17.

The carrying out of the reciprocal engagements contained in the present Convention is subject, so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the contracting countries which are bound to procure their application which they engage to do with as little delay as possible.

#### ARTICLE 17bis.

The Convention shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation.

This denunciation shall be addressed to the Government of the Swiss Confederation. It shall only affect the denouncing country, the Convention remaining in operation as regards the other contracting countries.

#### ARTICLE 18.

The present Act shall be ratified and the ratifications deposited at The Hague not later than the 1st May, 1928. It shall come into force, between the countries which shall have ratified it, one month after that date. Nevertheless, if before that date it has been ratified by at least six countries, it shall come into force, between those countries, one month after the deposit of the sixth ratification has been notified to them by the Government of the Swiss Confederation and, in the case of countries which may ratify at a later date, one month after the notification of each of such ratifications.

This Act shall, as regards the relations between the countries which ratify it, replace the Convention of Paris of 1883, revised at Washington on the 2nd June,

1911, and the Final Protocol, which shall, however, remain in force as regards relations with the countries which shall not have ratified the present Act.

## ARTICLE 19.

The present Act shall be signed in a single copy, which shall be deposited in the archives of the Government of the Netherlands. A certified copy shall be forwarded by the latter to each of the Governments of the contracting countries.

In witness whereof the respective Plenipotentiaries have signed the present Act.

Done at The Hague, in a single copy, the 6th November, 1925.

[Here followed the signatures of the various representatives of the several contracting countries.]

[*N.B.*—This International Convention was again further considered and discussed at the London Conference held at London on 2nd June 1934; when certain further amendments were proposed. Since such provisional amendments were subject to ratification, they have not been produced in this copy of the text here set out. The text here set out comprises the English translation (as presented by the Secretary of State for Foreign Affairs to Parliament) of the French text agreed at the Hague Conference held at the Hague on 6th November 1925 and ratified according to the British ratification deposited on 1st May 1928. For the results and recommendations of the London Conference held at London on 2nd June 1934, further reference may be made to the Circular issued by the Board of Trade in England and entitled "International Convention for the Protection of Industrial Property and International Agreement regarding False Indications of Origin; comparison of the Hague and London texts with explanatory notes by the British Delegates:" (Price 4 d: printed and published by H. M. Stationery Office, Adastral House, Kingsway, London, W.C. 2).]



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